

ESTTA Tracking number: **ESTTA656230**Filing date: **02/17/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Petition for Cancellation**

Notice is hereby given that the following party requests to cancel indicated registration.

**Petitioner Information**

Name	SIS RESOURCES LTD.		
Entity	Corporation	Citizenship	Israel
Address	P.O. Box 674 Bet Shemesh, 99000 ISRAEL		

Attorney information	Ann K. Ford DLA Piper LLP (US) 500 Eighth Street, NW Washington, DC 20004 UNITED STATES dctrade- marks@dlapiper.com,ann.ford@dlapiper.com,john.nading@dlapiper.com,ashley.joyce@dlapiper.com,alberto.zacapa@dlapiper.com Phone:2027994000
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**Registration Subject to Cancellation**

Registration No	3619407	Registration date	05/12/2009
Registrant	Starbuzz Tobacco, Inc. 10871 Forbes Ave Garden Grove, CA 92843 UNITED STATES		

**Goods/Services Subject to Cancellation**

Class 034. First Use: 2006/12/01 First Use In Commerce: 2006/12/01  
All goods and services in the class are cancelled, namely: Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco

**Grounds for Cancellation**

<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
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Related Proceedings	TTAB Opposition Proceeding No. 91213286, Federal Case No. 8:15-cv-00176 (Central District of California)
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Attachments	BLUE MIST Mark Petition for Cancellation.pdf(81268 bytes ) Cancellation Exhibits A-C.pdf(1141392 bytes ) Cancellation Exhibit D.pdf(2605465 bytes ) Cancellation Exhibit E.pdf(4701291 bytes ) Cancellation Exhibits F-I.pdf(622429 bytes )
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**Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Ann K. Ford/
Name	Ann K. Ford
Date	02/17/2015

In the matter of Trademark  
Registration No. 3619407  
Mark: BLUE MIST  
Filed: November 20, 2008  
Registered: May 12, 2009

Cancellation No. \_\_\_\_\_

Petitioner SIS Resources Ltd. (“Petitioner”) believes that it is and will be damaged by the continued presence on the Principal Register of Registration No. 3619407 owned by Starbuzz Tobacco, Inc. (“Registrant” or “Starbuzz”) for the trademark BLUE MIST registered in connection with “pipe tobacco, tobacco, smoking tobacco, flavored tobacco, molasses tobacco” in International Class 34 (“BLUE MIST Mark” or “Registration”). Petitioner hereby petitions to cancel said Registration under the provisions of Section 14 of the Trademark Act of 1946 (“Lanham Act”), 15 U.S.C. § 1064(3).

2. Upon information and belief, Registrant is a California corporation with an address at 10871 Forbes Avenue, Garden Grove, California 92843.

3. Petitioner is the owner of the trademark MOCHA MIST, U.S. Application Serial No. 85846992, for “electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges, cartomisers, and atomisers” in Class 34 (“MOCHA MIST Mark”).

4. On November 1, 2013, Registrant filed a Notice of Opposition against Petitioner’s MOCHA MIST Mark, alleging priority and likelihood of confusion under Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d), purportedly based on Registrant’s BLUE MIST Mark Reg. No. 3619407 and CITRUS MIST Mark Reg. No. 3695500, which was assigned Proceeding No. 91213286 (“Opposition Proceeding”). Petitioner filed its Answer in the Opposition Proceeding on December 11, 2013. Attached hereto as **Exhibit A** and made part of the record are true and correct copies of the United States Certificate of Registration and TSDR & TESS print-outs for the BLUE MIST Mark U.S. Reg. No. 3619407. Attached hereto as **Exhibit B** and made part of the record is a true and correct copy of the Notice of Opposition filed by Registrant against the MOCHA MIST Mark.

5. On February 4, 2015, Opposer filed a federal lawsuit against Petitioner and Nu Mark LLC in the Central District of California alleging claims for federal trademark infringement and false designation of origin, state unfair business practices, and common law trademark infringement and unfair competition, captioned *Starbuzz Tobacco, Inc. v. SIS Resources Ltd. and Nu Mark LLC*, C.D. Cal., Case No. 8:15-cv-00176 (“Civil Action”). Attached hereto as **Exhibit C** and made part of the record is a true and correct copy of the Complaint in the Civil Action. The alleged basis of Registrant’s claims are the BLUE MIST Mark Reg. No. 3619407 and CITRUS MIST Mark Reg. No. 3695500. Exh. C ¶¶ 15, 24. On



February 12, 2015, the United States Trademark Trial and Appeal Board (“Board” or “TTAB”) suspended the Opposition Proceeding during the pendency of the Civil Action.

6. In light of the Opposition Proceeding and the Civil Action, Petitioner believes it is and is likely to be damaged by the continued registration of U.S. Trademark Reg. No. 3619407.

7. Upon information and belief, Petitioner asserts that Registrant has no valid U.S. trademark rights in its alleged BLUE MIST Mark.

8. Upon information and belief, Petitioner asserts that Registrant’s Registration should be cancelled under Section 14 of the Lanham Act, 15 U.S.C. 1064(3), because the federal registration for the BLUE MIST Mark was maintained fraudulently.

**A. Pending Court Proceeding Involving BLUE MIST Mark Rights**

9. At the time Registrant filed its Combined Declaration of Use and Incontestability under Sections 8 & 15 on May 23, 2014, the BLUE MIST Mark was at issue in a pending federal court action for declaratory relief filed by Registrant and subject to counterclaims of trademark infringement and unfair competition.

10. Specifically, on March 8, 2013, Registrant filed a complaint for declaratory judgment of non-infringement of trademarks and non-dilution of trademarks against Lorillard, Inc. and Lorillard Technologies, Inc. regarding Registrant’s BLUE MIST Mark in the United States District Court for the Central District of California, captioned *Starbuzz Tobacco, Inc. v. LOEC, Inc.*, C.D. Cal., Case No. 8:13-cv-00411 (“Federal Court Action”). Registrant then filed a First Amended Complaint substituting LOEC, Inc. as defendant on October 9, 2013 (“FAC”). Attached hereto as **Exhibit D** and made part of the record is a true and correct copy of the FAC in the Federal Court Action.

11. In the FAC, Registrant pled its BLUE MIST Mark Reg. No. 3619407 (FAC ¶ 15 & Exh. A), defined “BLUE MIST Mark” to mean the Registration (FAC ¶ 15), and sought a declaration that Registrant’s BLUE MIST Mark for tobacco and related products has priority over BLU Marks for electronic cigarettes and that Registrant’s BLUE MIST Mark is not confusingly similar to LOEC’s BLU Marks (FAC Prayer for Relief ¶¶ 1-2). Exh. D. In particular, Registrant alleged:

- “At all times relevant herein, Starbuzz has been, and still is, the owner of the exclusive rights, title, and interest in the BLUE MIST Mark for tobacco and related products.” (FAC ¶ 17.)
- “Starbuzz is informed and believes, and on that basis alleges, that the date of first use of the BLUE MIST Mark in commerce predates the date of first use of the BLU Marks in commerce. Therefore, Starbuzz’s rights to use BLUE MIST on tobacco and related products have priority over any rights claimed by Defendants in their BLU Marks.” (FAC ¶ 40.)
- “Because no likelihood of confusion exists between ‘BLUE MIST’ and the BLU Marks, Starbuzz has not infringed upon the BLU Marks.” (FAC ¶ 50.)
- “Based upon the cease and desist letters, and since Starbuzz is making bona fide use of the ‘BLUE MIST’ mark in connection with its tobacco and electronic cigarette products, there is an actual controversy as to whether Plaintiff’s use of the ‘BLUE MIST’ mark infringes upon and dilutes Defendant’s BLU Marks.” (FAC ¶ 61.)
- “By this Complaint, Starbuzz seeks declaratory relief from this Court to clarify its rights to the ‘BLUE MIST’ mark and Defendant’s rights in the BLU Marks.” (FAC ¶ 62.)

Exh. D.

12. Registrant had filed the declaratory judgment in the Federal Court Action in response to a cease and desist letter from Lorillard, dated February 4, 2013, in which “Lorillard on behalf of Defendant claimed ownership of the BLU Marks and demanded that Starbuzz cease

and desist from all use of ‘BLUE MIST’, file an express abandonment of the Application, and enter into a settlement agreement with Defendant to resolve the matter” (FAC ¶ 55). Exh. D. In that same letter, “Lorillard, on behalf of Defendant, further accused Starbuzz of trademark infringement and dilution of the BLU Marks.” (FAC ¶ 56.) Registrant responded to the February 4 letter on February 15, 2013, “claiming that there is no likelihood of confusion between the parties’ respective marks.” (FAC ¶ 58.) In that letter, Registrant stated at the outset: “For the reasons that follow, we believe that there is no likelihood of confusion between Starbuzz’s BLUE MIST mark for tobacco products (Reg. No. 3619407) (the ‘BLUE MIST Mark’) and Lorillard’s ‘BLU’ family of marks (the ‘BLU Marks’).” Attached hereto as **Exhibit E** and made a part of the record is a true and correct copy of the Ans. to FAC & Counterclaims in the Federal Court Action (*see* Exh. H to same).

13. On January 13, 2014, LOEC filed its Answer to the FAC and Counterclaims in the Federal Court Action, alleging in its Answer, among other things:

- “In response to the allegations of paragraph 40 of the FAC, LOEC denies that Starbuzz’s rights, if any, to use ‘BLUE MIST’ on tobacco and related products have priority over LOEC’s rights in the BLU Marks in connection with electronic cigarettes and related products.” (Ans. to FAC ¶ 40.)
- “In response to the allegations of paragraph 61 of the FAC, LOEC admits that there is a current actual case or controversy regarding whether Plaintiff’s use of the ‘BLUE MIST’ mark infringes upon Defendant’s BLU Marks.” (Ans. to FAC ¶ 61.)
- “In response to the allegations of paragraph 62 of the FAC, LOEC admits that Starbuzz has filed an action for declaratory relief to clarify its rights to the ‘BLUE MIST’ mark and LOEC’s rights in the BLU Marks. LOEC denies that Starbuzz is entitled to any relief.” (Ans. to FAC ¶ 62.)
- “In response to the allegations of paragraph 68 of the FAC, LOEC admits that Starbuzz asserts that there is no likelihood of confusion between ‘BLUE MIST’ and the BLU Marks.” (Ans. to FAC ¶ 68.)

Exh. E.

14. In its three counterclaims for federal unfair competition under 15 U.S.C. § 1125(a), California common law trademark infringement, and California unfair competition under Cal. Bus. & Prof. Code § 17200, LOEC defined “BLUE MIST Mark” to mean Reg. No. 3619407 (Counterclaims ¶ 8), as Starbuzz had done in the FAC. Among other things, LOEC sought a judgment from the Court:

- “Dismissing all claims in Starbuzz’s First Amended Complaint with prejudice, finding that Starbuzz is not entitled to any of its requested relief, or any relief whatsoever, and denying with prejudice all relief requested by Starbuzz.” (Counterclaims Prayer for Relief ¶ 1.)
- “Adjudging that Starbuzz . . . be enjoined and restrained at first during the pendency of this action and thereafter permanently from: a. Manufacturing, producing, sourcing, importing, selling, offering for sale, distributing, advertising, or promoting any goods that display any words or symbols that so resemble the BLU Family of Marks as to be likely to cause confusion, mistake or deception, on or in connection with any product that is not authorized by or for LOEC; b. Using any word, term, symbol, device or combination thereof that causes or is likely to cause confusion, mistake or deception as to the affiliation or association of Starbuzz or its products with LOEC, or as to the origin of Starbuzz’s goods, or any false designation of origin, false or misleading description or representation of fact; c. Further infringing the rights of LOEC in and to the BLU Family of Marks or otherwise damaging LOEC’s goodwill or business reputation; d. Otherwise competing unfairly with LOEC in any manner . . . .” (Counterclaims Prayer for Relief ¶ 3.)
- “Adjudging that Starbuzz . . . be enjoined and restrained from applying to register any trademark applications with the USPTO that are likely to infringe on the BLU Family of Marks.” (Counterclaims Prayer for Relief ¶ 9.)

Exh. E.

15. On February 3, 2014, Starbuzz filed its Answer to the Counterclaims in the Federal Court Action, raising the following Affirmative Defenses:

- “LOEC’s claims are barred, in whole or in part, by Starbuzz’s prior use and/or registration of the BLUE MIST, MELON BLUE, and BLUE SURFER marks.” (Ans. to Counterclaims Eighth Aff. Defense Prior Use/Registration.)
- “LOEC’s trademark infringement claims fails since Starbuzz used its BLUE MIST and MELON BLUE marks in commerce before LOEC and its predecessor(s) in interest began using the BLU Marks in commerce. In addition, Starbuzz is informed and believes, and thereon alleges, that LOEC’s BLU Marks are descriptive and did not acquire distinctiveness, if any, until after Starbuzz began use of its BLUE MIST, MELON BLUE, and BLUE SURFER marks for tobacco products.” (Ans. to Counterclaims Twelfth Aff. Defense Priority and Non-Infringement of Trademark.)

Attached hereto as **Exhibit F** and made part of the record is a true and correct copy of the Ans. to Counterclaims in the Federal Court Action.

**B. Section 15 Declaration Filed During Pendency of Court Proceeding**

16. Thereafter, while the Federal Court Action was still pending, Starbuzz filed a Combined Declaration of Use and Incontestability under Sections 8 & 15 on May 23, 2014 in connection with the BLUE MIST Mark Registration No. 3619407, declaring: “There has been no final decision adverse to the owner’s claim of ownership of such mark for such goods/services, or to the owner’s right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the United States Patent and Trademark Office or in a court.” Attached hereto as **Exhibit G** and made part of the record is a true and correct copy of the Combined Declaration of Use and Incontestability under Sections 8 & 15 filed in connection with the Registration.

17. Martin Jerisat signed the Section 15 Declaration as counsel for Starbuzz under penalty of perjury; specifically:

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18

U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this submission, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Exh. G.

18. At the time Mr. Jerisat signed the Section 15 Declaration, he was an attorney for Starbuzz in the Federal Court Action, having filed a Notice of Appearance on November 4, 2013. Attached hereto as **Exhibit H** and made part of the record is a true and correct copy of the Notice of Appearance filed in the Federal Court Action. Thus, Mr. Jerisat clearly knew there was a “proceeding involving said rights pending . . . in a court and not finally disposed of.” 15 U.S.C. § 1065. Indeed, Mr. Jerisat is the former counsel of record in the Opposition Proceeding referenced above until the recent Notice of Appearance of Counsel for Starbuzz filed on January 16, 2015 by Natu J. Patel of The Patel Law Firm, P.C.

19. On June 10, 2014, the United States Patent and Trademark Office (“USPTO”) acknowledged the Section 15 Declaration filed in connection with the Registration. Attached hereto as **Exhibit I** and made part of the record is a true and correct copy of the Notice of Acknowledgment under Section 15 issued in connection with the Registration.

20. By signing the Section 15 Declaration, Mr. Jerisat committed a fraud on the USPTO; namely, a false representation regarding a material fact, the registrant’s knowledge or belief that the representation is false, the intent to induce reliance upon the misrepresentation and reasonable reliance thereon, and damages proximately resulting from the reliance. The Section 15 Declaration was materially false because of the pending Federal Court Action. Thus, Mr. Jerisat’s statements that “there is no proceeding involving said rights pending and not disposed of in . . . a court” was false and Mr. Jerisat knew those statements were false.

21. Furthermore, at the time the Section 15 Declaration was signed and filed, eight Notices of Suits were lodged in connection with this Registration reflecting unique cases filed by Registrant, five of which were still pending, including the Federal Court Action. *See* TSDR printout at Exh. A. After the USPTO acknowledged the Section 15 Declaration, three more Notices of Suit were lodged in connection with this Registration reflecting new cases filed by Registrant. Upon information and belief, Registrant is a litigious party that deliberately committed fraud on the USPTO to procure a false Section 15 Declaration of Incontestability that would afford and did afford Registrant benefits and presumptions under 15 U.S.C. § 1115, to which Registrant was not otherwise entitled, to assert against third-parties in litigation.

22. Specifically, once a registration has become incontestable under Section 15 of the Lanham Act, 15 U.S.C. § 1065, “the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce.” 15 U.S.C. § 1115(b). “Such conclusive evidence of the right to use the registered mark shall be subject to . . . the following defenses or defects: (1) That the registration or the incontestable right to use the mark was obtained fraudulently . . . .” *Id.*

23. Accordingly, in procuring and maintaining U.S. Trademark Reg. No. 3619407, Registrant made false, material representations of fact which it knew or should have known were false, with intent to deceive the USPTO into acknowledging the Section 15 Declaration of Incontestability. For these reasons, U.S. Trademark Reg. No. 3619407 for the BLUE MIST Mark was obtained fraudulently and should be cancelled.

**CANCELLATION FOR FRAUD**  
**SECTION 14(3) OF THE LANHAM ACT, 15 U.S.C. § 1064(3)**

24. Petitioner repeats and re-alleges each and every allegation contained in Paragraphs 1 through 23 above, as if set forth herein in full.

25. Petitioner asserts that Registrant's U.S. Trademark Reg. No. 3619407 should be cancelled under Section 14 of the Lanham Act, 15 U.S.C. § 1064(3), because the federal registration for the BLUE MIST Mark was obtained fraudulently.

26. A petition to cancel a registration is appropriate "[a]t any time if . . . registration was obtained fraudulently or contrary to the provisions of section 1054 of title 15 or of subsection (a), (b), or (c) of section 1052 of title 15 for a registration under this chapter, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts . . . ." 15 U.S.C. § 1064(3).

27. Under Section 15 of the Lanham Act, 15 U.S.C. § 1065, ". . . the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That . . . (2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of . . . ."

28. Registrant filed its Combined Declaration of Use and Incontestability under Sections 8 & 15 for the BLUE MIST Mark on May 23, 2014 with the USPTO while the Federal Court Action involving said rights was pending.

29. In the Combined Declaration of Use and Incontestability under Sections 8 & 15 for the BLUE MIST Mark on May 23, 2014, Registrant's counsel Martin Jerisat declared under penalty of perjury: "The signatory being warned that willful false statements and the like are



punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this submission, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.”

30. Registrant’s statements in its Combined Declaration of Use and Incontestability under Sections 8 & 15 for the BLUE MIST Mark were false, and Registrant knew or should have known of the falsity of its statements.

31. Registrant’s statements in its Combined Declaration of Use and Incontestability under Sections 8 & 15 for the BLUE MIST Mark were false representations of a material fact, and Registrant knew or should have known of the falsity of its statements.

32. Upon information and belief, Registrant intended to induce the USPTO to rely upon Registrant’s false representations of a material fact and thereby acknowledge the Section 15 Declaration for U.S. Trademark Reg. No. 3619407 for the BLUE MIST Mark.

33. Upon information and belief, Registrant’s intentional false representations of a material fact deceived the USPTO into acknowledging the Section 15 Declaration for U.S. Trademark Reg. No. 3619407 for the BLUE MIST Mark.

34. In view of the foregoing, the Section 15 Declaration of Incontestability for U.S. Trademark Reg. No. 3619407 was obtained fraudulently.

35. In view of the foregoing, U.S. Trademark Reg. No. 3619407 was maintained fraudulently.

36. Accordingly, U.S. Trademark Reg. No. 3619407 should be cancelled under Section 14 of the Lanham Act, 15 U.S.C. § 1064(3).

By virtue of the foregoing, Petitioner believes that it is now and will be damaged by the continued presence on the Principal Register of Registration No. 3619407 for the BLUE MIST Mark. If Registrant is permitted to maintain the Registration and retain such rights as conferred under the Principal Register of the Lanham Act, Registrant will retain unlawful gain and advantage to which Registrant is not entitled under the Lanham Act, to the detriment and harm of Petitioner.

WHEREFORE, Petitioner respectfully requests that the Board cancel U.S. Trademark Reg. No. 3619407 in its entirety, declare that no right of incontestability exists or ever existed with regard to U.S. Trademark Reg. No. 3619407, and sustain this Petition for Cancellation in favor of Petitioner.

Petitioner hereby appoints Ann K. Ford, a member of the Bar of the District of Columbia, Thomas E. Zutic, a member of the Bar of the District of Columbia, John M. Nading, a member of the Bar of the District of Columbia, David M. Kramer, a member of the Bar of the District of Columbia, Eunice R. Chung, a member of the Bar of the District of Columbia, Ashley H. Joyce, a member of the Bar of the State of California, and all of the law firm of DLA Piper LLP (US), 500 8th Street, NW, Washington, DC 20004, telephone number (202) 799-4000, to transact all business in the USPTO in connection with this Cancellation Proceeding and hereby revokes all previous powers of attorney herein.

Please address all correspondence to:

Ann K. Ford, Esq.  
DLA Piper LLP (US)  
500 8th Street, NW  
Washington, DC 20004  
[dctrademarks@dlapiper.com](mailto:dctrademarks@dlapiper.com)

The filing fee for this Cancellation in the amount of \$300.00 is hereby electronically transferred with the submission of the Petition for Cancellation.

The undersigned, registered agent for Petitioner herein, states that she is authorized to prosecute this Cancellation, that she has read and signed the foregoing Petition for Cancellation and knows the contents thereof, and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that willful false statements may jeopardize the validity of this Cancellation and any decision resulting therefrom.

Dated: February 17, 2015

Respectfully submitted,

**DLA PIPER LLP (US)**

By: /s/ Ann K. Ford  
Ann K. Ford  
Thomas E. Zutic  
John M. Nading  
Ashley H. Joyce  
500 8th Street, NW  
Washington, D.C. 20004  
Tel. 202-799-4000  
Fax 202-799-5000

*Attorneys for Petitioner SIS Resources Ltd.*

**CERTIFICATE OF SERVICE**

This is to certify that a copy of the foregoing **PETITION FOR CANCELLATION** was served via First Class U.S. Mail, postage prepaid, and properly addressed to:

Starbuzz Tobacco, Inc.  
10871 Forbes Ave  
Garden Grove, California 92843

Natu J. Patel  
The Patel Law Firm, P.C.  
22952 Mill Creek Drive  
Laguna Hills, California 92653

this 17th day of February, 2015.

/s/ Ann K Ford

\_\_\_\_\_  
Ann K. Ford

*Attorney for Petitioner*

# **EXHIBIT A**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**

**Int. Cl.: 34**

**Prior U.S. Cls.: 2, 8, 9 and 17**

**United States Patent and Trademark Office**

**Reg. No. 3,619,407**

**Registered May 12, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**Blue Mist**

STARBUZZ TOBACCO, INC. (CALIFORNIA CORPORATION)  
UNIT #A  
1889 W. COMMONWEALTH STREET  
FULLERTON, CA 92833

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: PIPE TOBACCO, TOBACCO, SMOKING TOBACCO, FLAVORED TOBACCO, MOLASSES TOBACCO, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

SER. NO. 77-619,104, FILED 11-20-2008.

FIRST USE 12-1-2006; IN COMMERCE 12-1-2006.

REGINA DRUMMOND, EXAMINING ATTORNEY

**Generated on:** This page was generated by TSDR on 2015-02-11 09:19:54 EST

**Mark:** BLUE MIST

Blue Mist

**US Serial Number:** 77619104

**Application Filing Date:** Nov. 20, 2008

**US Registration Number:** 3619407

**Registration Date:** May 12, 2009

**Register:** Principal

**Mark Type:** Trademark

**Status:** A Sections 8 and 15 combined declaration has been accepted and acknowledged.

**Status Date:** Jun. 10, 2014

**Publication Date:** Feb. 24, 2009

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## Mark Information

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**Mark Literal Elements:** BLUE MIST

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

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## Related Properties Information

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**International Registration Number:** 1031097

**International Application(s) /Registration(s) Based on this Property:** A0018784/1031097

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## Goods and Services

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**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco

**International Class(es):** 034 - Primary Class

**U.S Class(es):** 002, 008, 009, 017

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Dec. 01, 2006

**Use in Commerce:** Dec. 01, 2006

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## Basis Information (Case Level)

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**Filed Use:** Yes

**Currently Use:** Yes

**Amended Use:** No

**Filed ITU:** No

**Currently ITU:** No

**Amended ITU:** No

**Filed 44D:** No

**Currently 44D:** No

**Amended 44D:** No

**Filed 44E:** No

**Currently 44E:** No

**Amended 44E:** No

**Filed 66A:** No

**Currently 66A:** No

**Filed No Basis:** No

**Currently No Basis:** No

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## Current Owner(s) Information

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**Owner Name:** Starbuzz Tobacco, Inc.

**Owner Address:** 10871 Forbes Ave  
Garden Grove, CALIFORNIA 92843  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** CALIFORNIA

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## Attorney/Correspondence Information

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Attorney of Record	
<b>Attorney Name:</b> Natu J. Patel <b>Attorney Primary Email Address:</b> <a href="mailto:NPatel@thePatelLawFirm.com">NPatel@thePatelLawFirm.com</a>	<b>Docket Number:</b> S015-4472 <b>Attorney Email Authorized:</b> Yes
Correspondent	
<b>Correspondent Name/Address:</b> Natu J. Patel The Patel Law Firm, P.C. 22952 Mill Creek Drive Laguna Hills, CALIFORNIA 92653 UNITED STATES	
<b>Phone:</b> (949) 955-1077 <b>Correspondent e-mail:</b> <a href="mailto:NPatel@thePatelLawFirm.com">NPatel@thePatelLawFirm.com</a> <a href="mailto:MUy@thePatelLawFirm.com">MUy@thePatelLawFirm.com</a> <a href="mailto:JChuan@thePatelLawFirm.com">JChuan@thePatelLawFirm.com</a>	<b>Fax:</b> (949) 955-1877 <b>Correspondent e-mail Authorized:</b> Yes
Domestic Representative - Not Found	

## Prosecution History

Date	Description	Proceeding Number
Dec. 19, 2014	ATTORNEY REVOKED AND/OR APPOINTED	
Dec. 19, 2014	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Nov. 13, 2014	NOTICE OF SUIT	
Sep. 24, 2014	NOTICE OF SUIT	
Jul. 02, 2014	NOTICE OF SUIT	
Jun. 26, 2014	NOTICE OF SUIT	
Jun. 11, 2014	NOTICE OF SUIT	
Jun. 10, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Jun. 10, 2014	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	69471
Jun. 10, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	69471
May 23, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
May 23, 2014	TEAS SECTION 8 & 15 RECEIVED	
Mar. 10, 2014	NOTICE OF SUIT	
Dec. 19, 2013	NOTICE OF SUIT	
Dec. 17, 2013	NOTICE OF SUIT	
Nov. 08, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
Nov. 08, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Mar. 25, 2013	NOTICE OF SUIT	
Feb. 20, 2013	NOTICE OF SUIT	
Sep. 18, 2012	NOTICE OF SUIT	
May 25, 2011	NOTICE OF SUIT	
Jun. 09, 2010	NOTICE OF SUIT	
Aug. 29, 2009	NOTICE OF SUIT	
May 12, 2009	REGISTERED-PRINCIPAL REGISTER	
Feb. 24, 2009	PUBLISHED FOR OPPOSITION	
Feb. 04, 2009	NOTICE OF PUBLICATION	
Jan. 21, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	78413
Jan. 15, 2009	ASSIGNED TO LIE	78413
Dec. 30, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Dec. 29, 2008	ASSIGNED TO EXAMINER	78305
Nov. 24, 2008	NEW APPLICATION ENTERED IN TRAM	

## Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of** Section 15 - Accepted



Incontestability:

## TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: TMO LAW OFFICE 114

Date in Location: Jun. 10, 2014

## Proceedings

### Summary

Number of Proceedings: 8

### Type of Proceeding: Opposition

Proceeding Number: [91214903](#)

Filing Date: Feb 12, 2014

Status: Pending

Status Date: Feb 12, 2014

Interlocutory Attorney: ANDREW P BAXLEY

### Defendant

Name: PR Brothers LLC

Correspondent Address: BEN T LILA  
MANDOUR & ASSOCIATES APC  
16870 W BERNARDO DRIVE, SUITE 400  
SAN DIEGO CA , 92127  
UNITED STATES

Correspondent e-mail: [blila@mandourlaw.com](mailto:blila@mandourlaw.com) , [jmandour@mandourlaw.com](mailto:jmandour@mandourlaw.com)

### Associated marks

Mark	Application Status	Serial Number	Registration Number
DLITE MIST	Opposition Pending	<a href="#">86048029</a>	

### Plaintiff(s)

Name: Starbuzz Tobacco, Inc.

Correspondent Address: NATU J PATEL  
THE PATEL LAW FIRM PC  
22952 MILL CREEK DR  
LAGUNA HILLS CA , 92653  
UNITED STATES

Correspondent e-mail: [NPatel@thePatelLawFirm.com](mailto:NPatel@thePatelLawFirm.com) , [MUy@thePatelLawFirm.com](mailto:MUy@thePatelLawFirm.com) , [JChuan@thePatelLawFirm.com](mailto:JChuan@thePatelLawFirm.com)

### Associated marks

Mark	Application Status	Serial Number	Registration Number
BLUE MIST	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77619104</a>	<a href="#">3619407</a>
CITRUS MIST	Registered	<a href="#">77699076</a>	<a href="#">3695500</a>
TROPICAL MIST	Registered	<a href="#">85360053</a>	<a href="#">4196957</a>
HAWAIIAN MIST	Registered	<a href="#">85359875</a>	<a href="#">4196953</a>
PEACH MIST	Registered	<a href="#">85533824</a>	<a href="#">4287968</a>

### Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 12, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 12, 2014	Mar 24, 2014
3	PENDING, INSTITUTED	Feb 12, 2014	
4	CHANGE OF CORRESP ADDRESS	Mar 21, 2014	
5	ANSWER	Mar 21, 2014	
6	P APPEARANCE / POWER OF ATTORNEY	Dec 09, 2014	
7	P MOT TO SUSP PEND DISP CIV ACTION	Dec 22, 2014	
8	P CORRESPONDENCE	Jan 07, 2015	

### Type of Proceeding: Opposition

Proceeding Number: [91214086](#)

Filing Date: Dec 18, 2013

Status: Pending

Status Date: Dec 18, 2013

Interlocutory Attorney: ELIZABETH WINTER

**Defendant**

**Name:** Philip Melnick

**Correspondent Address:** PHILLIP MELNICK  
PO BOX 131822  
STATEN ISLAND NY , 10313  
UNITED STATES

**Correspondent e-mail:** [philipmelnick@aol.com](mailto:philipmelnick@aol.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
MYST	Opposition Pending	<a href="#">85774314</a>	

**Plaintiff(s)**

**Name:** Starbuzz Tobacco Inc.

**Correspondent Address:** NATU J PATEL  
THE PATEL LAW FIRM PC  
22952 MILL CREEK DRIVE  
LAGUNA HILLS CA , 92653  
UNITED STATES

**Correspondent e-mail:** [NPatel@thePatelLawFirm.com](mailto:NPatel@thePatelLawFirm.com) , [MUy@thePatelLawFirm.com](mailto:MUy@thePatelLawFirm.com) , [JChuan@thePatelLawFirm.com](mailto:JChuan@thePatelLawFirm.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
BLUE MIST	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77619104</a>	<a href="#">3619407</a>
CITRUS MIST	Registered	<a href="#">77699076</a>	<a href="#">3695500</a>
PEACH MIST	Registered	<a href="#">85533824</a>	<a href="#">4287968</a>
TROPICAL MIST	Registered	<a href="#">85360053</a>	<a href="#">4196957</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Dec 18, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Dec 19, 2013	Jan 28, 2014
3	PENDING, INSTITUTED	Dec 19, 2013	
4	D MOT FOR EXT W/ CONSENT	Jan 27, 2014	
5	EXTENSION OF TIME GRANTED	Jan 27, 2014	
6	P MOT TO VACATE (#5) AND MOTION FOR DEFAULT JUDGMENT	Feb 04, 2014	
7	D REQ TO W/DRAW AS ATTORNEY	Feb 10, 2014	
8	D REPLY TO P MOTION AND CROSS MOTION FOR SUMMARY JUDGMENT	Feb 19, 2014	
9	SUSPENDED	Jun 26, 2014	
10	RESPONSE DUE 30 DAYS (DUE DATE)	Jun 30, 2014	Jul 30, 2014
11	ANSWER	Jul 30, 2014	
12	TRIAL DATES RESET	Aug 07, 2014	
13	P APPEARANCE / POWER OF ATTORNEY	Jan 16, 2015	

**Type of Proceeding: Opposition**

**Proceeding Number:** [91213286](#)

**Filing Date:** Nov 01, 2013

**Status:** Pending

**Status Date:** Nov 01, 2013

**Interlocutory Attorney:** GEORGE POLOGEORGIS

**Defendant**

**Name:** SIS Resources Ltd.

**Correspondent Address:** ANN K FORD  
DLA PIPER LLP US  
500 8TH STREET NW  
WASHINGTON DC , 20004  
UNITED STATES

**Correspondent e-mail:** [Ann.Ford@dlapiper.com](mailto:Ann.Ford@dlapiper.com) , [Thomas.Zutic@dlapiper.com](mailto:Thomas.Zutic@dlapiper.com) , [John.Nading@dlapiper.com](mailto:John.Nading@dlapiper.com) , [dctrademarks@dlapiper.com](mailto:dctrademarks@dlapiper.com)

**Associated marks**

Serial	Registration
--------	--------------

Mark	Application Status	Number	Number
MOCHA MIST	Opposition Pending	<a href="#">85846992</a>	
<b>Plaintiff(s)</b>			

**Name:** Starbuzz Tobacco, Inc.

**Correspondent Address:** NATU J PATEL  
THE PATEL LAW FIRM PC  
22952 MILL CREEK DRIVE  
LAGUNA HILLS CA , 92653  
UNITED STATES

**Correspondent e-mail:** [NPatel@thePatelLawFirm.com](mailto:NPatel@thePatelLawFirm.com) , [MUy@thePatelLawFirm.com](mailto:MUy@thePatelLawFirm.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
BLUE MIST	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77619104</a>	<a href="#">3619407</a>
CITRUS MIST	Registered	<a href="#">77699076</a>	<a href="#">3695500</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 01, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 01, 2013	Dec 11, 2013
3	PENDING, INSTITUTED	Nov 01, 2013	
4	P CHANGE OF CORRESP ADDRESS	Nov 08, 2013	
5	ANSWER	Dec 11, 2013	
6	D APPEARANCE / POWER OF ATTORNEY	Feb 20, 2014	
7	D MOT FOR EXT W/O CONSENT	Mar 20, 2014	
8	D REQ TO W/DRAW AS ATTORNEY	Mar 31, 2014	
9	P OPP/RESP TO MOTION	Apr 01, 2014	
10	RESPONSE DUE 30 DAYS (DUE DATE)	Apr 02, 2014	May 02, 2014
11	D APPEARANCE / POWER OF ATTORNEY	Apr 29, 2014	
12	D CHANGE OF CORRESP ADDRESS	Apr 29, 2014	
13	D'S MOT TO EXTEND GRANTED; TRIAL DATES RESET	Jun 28, 2014	
14	CHANGE OF CORRESP ADDRESS	Sep 03, 2014	
15	D MOT FOR EXT W/O CONSENT	Sep 22, 2014	
16	P MOT TO COMPEL DISCOVERY	Sep 29, 2014	
17	P MOT TO COMPEL DISCOVERY	Sep 29, 2014	
18	P MOT TO COMPEL DISCOVERY	Sep 29, 2014	
19	P MOT TO COMPEL DISCOVERY	Sep 29, 2014	
20	P MOT TO COMPEL DISCOVERY	Sep 29, 2014	
21	P MOT TO COMPEL DISCOVERY	Sep 29, 2014	
22	PARTIES' STIP PROTECTIVE ORDER	Oct 13, 2014	
23	D OPP/RESP TO MOTION	Oct 14, 2014	
24	SUSP PEND DISP OF OUTSTNDNG MOT	Nov 10, 2014	
25	P APPEARANCE / POWER OF ATTORNEY	Jan 16, 2015	
26	P'S MOT TO COMPEL DENIED W/O PREJ; D'S MOT TO EXTEND GRANTED; TRIAL DATES RESET	Feb 01, 2015	
27	P MOT TO SUSP PEND DISP CIV ACTION	Feb 09, 2015	

**Type of Proceeding: Opposition**

**Proceeding Number:** [91213185](#)

**Filing Date:** Oct 25, 2013

**Status:** Terminated

**Status Date:** Feb 04, 2014

**Interlocutory Attorney:** MARY CATHERINE FAINT

**Defendant**

**Name:** Jeffrey Binder

**Correspondent Address:** RICHARD L MORRIS JR

TRADEMARKRENEWALS.COM  
C/O 1 800 4 TRADEMARK , PO BOX 398538  
MIAMI BEACH FL , 33239-8538  
UNITED STATES

Correspondent e-mail: [richard@4trademark.com](mailto:richard@4trademark.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
THINMIST	Abandoned - After Inter-Partes Decision	<a href="#">85501815</a>	
Plaintiff(s)			

Name: Starbuzz Tobacco, Inc.

Correspondent Address: MARTIN JERISAT  
STARBUZZ TOBACCO INC  
10871 FORBES AVENUE  
GARDEN GROVE CA , 92843  
UNITED STATES

Correspondent e-mail: [martin@starbuzztobacco.com](mailto:martin@starbuzztobacco.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CITRUS MIST	Registered	<a href="#">77699076</a>	<a href="#">3695500</a>
TROPICAL MIST	Registered	<a href="#">85360053</a>	<a href="#">4196957</a>
HAWAIIAN MIST	Registered	<a href="#">85359875</a>	<a href="#">4196953</a>
PEACH MIST	Registered	<a href="#">85533824</a>	<a href="#">4287968</a>
BLUE MIST	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77619104</a>	<a href="#">3619407</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Oct 25, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Oct 25, 2013	Dec 04, 2013
3	PENDING, INSTITUTED	Oct 25, 2013	
4	P CHANGE OF CORRESP ADDRESS	Nov 08, 2013	
5	NOTICE OF DEFAULT	Dec 20, 2013	
6	BD DECISION: SUSTAINED	Feb 04, 2014	
7	TERMINATED	Feb 04, 2014	

#### Type of Proceeding: Opposition

Proceeding Number: [91212459](#)

Filing Date: Sep 13, 2013

Status: Terminated

Status Date: Jul 24, 2014

Interlocutory Attorney: CHERYL S GOODMAN

#### Defendant

Name: S&E Distributor, Inc.

Correspondent Address: JEFFREY P THENNISCH  
INGRASSIA FISHER & LORENZ PC  
1050 WILSHIRE DR SUITE 230  
TROY MI , 48084  
UNITED STATES

Correspondent e-mail: [docketing@ifllaw.com](mailto:docketing@ifllaw.com); [jeff@ifllaw.com](mailto:jeff@ifllaw.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
COOL MIST	Abandoned - After Inter-Partes Decision	<a href="#">85812071</a>	
Plaintiff(s)			

Name: Starbuzz Tobacco, Inc.

Correspondent Address: MARTIN JERISAT  
STARBUZZ TOBACCO INC  
10871 FORBES AVE  
GARDEN GROVE CA , 92843  
UNITED STATES

Correspondent e-mail: [martin@starbuzztobacco.com](mailto:martin@starbuzztobacco.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
BLUE MIST	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77619104</a>	<a href="#">3619407</a>
CITRUS MIST	Registered	<a href="#">77699076</a>	<a href="#">3695500</a>
TROPICAL MIST	Registered	<a href="#">85360053</a>	<a href="#">4196957</a>
HAWAIIAN MIST	Registered	<a href="#">85359875</a>	<a href="#">4196953</a>
PEACH MIST	Registered	<a href="#">85533824</a>	<a href="#">4287968</a>
Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 13, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 13, 2013	Oct 23, 2013
3	PENDING, INSTITUTED	Sep 13, 2013	
4	ANSWER	Oct 10, 2013	
5	P MOT TO STRIKE	Nov 05, 2013	
6	SUSP PEND DISP OF OUTSTNDNG MOT	Nov 06, 2013	
7	CHANGE OF CORRESP ADDRESS	Nov 08, 2013	
8	PROCEEDINGS RESUMED	Jan 14, 2014	
9	D MOT TO CONSOLIDATE	Jan 29, 2014	
10	P OPP/RESP TO MOTION	Feb 28, 2014	
11	TRIAL DATES REMAIN AS SET	May 27, 2014	
12	W/DRAW OF APPLICATION	Jul 10, 2014	
13	BD DECISION: SUSTAINED	Jul 24, 2014	
14	TERMINATED	Jul 24, 2014	

#### Type of Proceeding: Opposition

Proceeding Number: [91207921](#)

Filing Date: Nov 07, 2012

Status: Pending

Status Date: Nov 07, 2012

Interlocutory Attorney: JENNIFER KRISP

#### Defendant

Name: Loyalina Tobacco Manufacturing F.Z.C.

Correspondent Address: JEFFREY H GREGER  
LOWE HAUPTMAN HAM & BERNER LLP  
2318 MILL ROAD , SUITE 1400  
ALEXANDRIA VA , 22314  
UNITED STATES

Correspondent e-mail: [jhgreger@ipfirm.com](mailto:jhgreger@ipfirm.com), [kbaird@ipfirm.com](mailto:kbaird@ipfirm.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
OCEAN MIST	Opposition Pending	<a href="#">85555791</a>	
Plaintiff(s)			

Name: Starbuzz Tobacco, Inc.

Correspondent Address: NATU J PATEL  
THE PATEL LAW FIRM PC  
22952 MILL CREEK DR  
LAGUNA HILLS CA , 92653  
UNITED STATES

Correspondent e-mail: [NPatel@thePatellLawFirm.com](mailto:NPatel@thePatellLawFirm.com) , [MUy@thePatellLawFirm.com](mailto:MUy@thePatellLawFirm.com) , [JChuan@thePatellLawFirm.com](mailto:JChuan@thePatellLawFirm.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
BLUE MIST	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77619104</a>	<a href="#">3619407</a>
CITRUS MIST	Registered	<a href="#">77699076</a>	<a href="#">3695500</a>
TROPICAL MIST	Registered	<a href="#">85360053</a>	<a href="#">4196957</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 07, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 08, 2012	Dec 18, 2012
3	PENDING, INSTITUTED	Nov 08, 2012	
4	D'S MOTION TO DISMISS - RULE 12(B)	Dec 17, 2012	
5	D'S MOTION TO DISMISS - RULE 12(B)	Dec 17, 2012	
6	D'S MOTION TO DISMISS - RULE 12(B)	Dec 17, 2012	
7	P'S OPPOSITION/RESPONSE TO MOTION	Jan 04, 2013	
8	D'S REPLY IN SUPPORT OF MOTION	Jan 23, 2013	
9	SUSPENDED PENDING DISP OF OUTSTNDNG MOT	Jan 25, 2013	
10	PROCEEDINGS RESUMED	Feb 04, 2013	
11	P'S MOTION TO AMEND PLEADING/AMENDED PLEADING	Feb 26, 2013	
12	P MOT TO SUSP PEND DISP CIV ACTION	Feb 27, 2013	
13	D MOT TO DISMISS: FRCP 12(B)	Mar 27, 2013	
14	D CHANGE OF CORRESP ADDRESS	Mar 27, 2013	
15	SUSP PEND DISP OF CIVIL ACTION	Apr 15, 2013	
16	CHANGE OF CORRESP ADDRESS	Nov 08, 2013	
17	RESPONSE DUE 30 DAYS (DUE DATE)	Apr 18, 2014	May 18, 2014
18	RESPONSE DUE	Jul 02, 2014	
19	P MOT TO SUSP PEND DISP CIV ACTION	Aug 04, 2014	
20	SUSP PEND DISP OF CIVIL ACTION	Sep 15, 2014	
21	P APPEARANCE / POWER OF ATTORNEY	Jan 16, 2015	

**Type of Proceeding: Opposition**Proceeding Number: [91197260](#)

Filing Date: Nov 04, 2010

Status: Terminated

Status Date: Jul 17, 2012

Interlocutory Attorney: ROBERT COGGINS

**Defendant**

Name: Inhale, Inc.

Correspondent Address: LOUIS F TERAN  
STRATEGIC LEGAL COUNSELING  
1055 E COLORADO BLVD SUITE 500  
PASADENA CA , 91106 2371  
UNITED STATES

Correspondent e-mail: [literan@strategiclegalcounseling.com](mailto:literan@strategiclegalcounseling.com)**Associated marks**

Mark	Application Status	Serial Number	Registration Number
STRAWBERRY APPLE MIST	Abandoned - After Inter-Partes Decision	<a href="#">77934179</a>	

**Plaintiff(s)**

Name: Starbuzz Tobacco, Inc.

Correspondent Address: NATU J PATEL  
THE PATEL LAW FIRM PC  
2532 DUPONT DR  
IRVINE CA , 92612  
UNITED STATES

Correspondent e-mail: [NPatel@thePatelLawFirm.com](mailto:NPatel@thePatelLawFirm.com)**Associated marks**

Mark	Application Status	Serial Number	Registration Number
BLUE MIST	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77619104</a>	<a href="#">3619407</a>
CITRUS MIST	Registered	<a href="#">77699076</a>	<a href="#">3695500</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Nov 04, 2010	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Nov 04, 2010	Dec 14, 2010
3	PENDING, INSTITUTED	Nov 04, 2010	
4	ANSWER	Dec 09, 2010	
5	D'S MOTION FOR SUMMARY JUDGMENT	Feb 18, 2011	
6	DATES REMAIN AS SET	Mar 14, 2011	
7	D'S MOTION FOR SUMMARY JUDGMENT	Mar 15, 2011	
8	SUSPENDED PENDING DISP OF OUTSTNDNG MOT	Mar 24, 2011	
9	P'S OPPOSITION/RESPONSE TO MOTION	Apr 18, 2011	
10	D'S REPLY IN SUPPORT OF MOTION	May 02, 2011	
11	DEF'S MOTION FOR SUMMARY JUDGMENT DENIED	Mar 16, 2012	
12	WITHDRAWAL OF OPPOSITION	Jun 21, 2012	
13	BOARD'S COMMUNICATION	Jun 26, 2012	
14	WITHDRAWAL OF APPLICATION	Jul 05, 2012	
15	BOARD'S DECISION: SUSTAINED	Jul 17, 2012	
16	TERMINATED	Jul 17, 2012	

#### Type of Proceeding: Opposition

Proceeding Number: [91195039](#)

Filing Date: May 25, 2010

Status: Terminated

Status Date: Dec 07, 2010

Interlocutory Attorney: ELIZABETH WINTER

#### Defendant

Name: Emirates Tobacco Manufacturing

Correspondent Address: JEFFREY H GREGER  
LOWE HAUPTMAN HAM & BERNER, LLP  
1700 DIAGONAL RD , SUITE 310  
ALEXANDRIA VA , 22314-2866  
UNITED STATES

Correspondent e-mail: [jhgreger@ipfirm.com](mailto:jhgreger@ipfirm.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
ORANGE BLUE	Abandoned - After Inter-Partes Decision	<a href="#">77692194</a>	

#### Plaintiff(s)

Name: Starbuzz Tobacco, Inc.

Correspondent Address: NATU J PATEL  
THE PATEL LAW FIRM, P.C.  
2532 DUPONT DRIVE  
IRVINE CA , 92612  
UNITED STATES

Correspondent e-mail: [npatel@thePatelLawFirm.com](mailto:npatel@thePatelLawFirm.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
BLUE MIST	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77619104</a>	<a href="#">3619407</a>
MELON BLUE	Registered	<a href="#">77461889</a>	<a href="#">3815043</a>

#### Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	May 25, 2010	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	May 26, 2010	Jul 05, 2010
3	PENDING, INSTITUTED	May 26, 2010	
4	ANSWER AND COUNTERCLAIM ( FEE)	Jul 03, 2010	
5	TRIAL DATES RESET	Jul 23, 2010	

6	P'S MOTION TO DISMISS - RULE 12(B)	Aug 17, 2010
7	P'S MOTION TO STRIKE	Aug 17, 2010
8	PROCEEDINGS RESUMED	Oct 29, 2010
9	WITHDRAWAL OF OPPOSITION	Nov 29, 2010
10	BD'S DECISION: DISMISSED W/ PREJUDICE	Dec 07, 2010
11	TERMINATED	Dec 07, 2010



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# Blue Mist

<b>Word Mark</b>	BLUE MIST
<b>Goods and Services</b>	IC 034. US 002 008 009 017. G & S: Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco. FIRST USE: 20061201. FIRST USE IN COMMERCE: 20061201
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	77619104
<b>Filing Date</b>	November 20, 2008
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	February 24, 2009
<b>Registration Number</b>	<b>3619407</b>
<b>International Registration Number</b>	1031097
<b>Registration Date</b>	May 12, 2009
<b>Owner</b>	(REGISTRANT) Starbuzz Tobacco, Inc. CORPORATION CALIFORNIA 10871 Forbes Ave Garden Grove CALIFORNIA 92843
<b>Attorney of Record</b>	Natu J. Patel
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Affidavit Text</b>	SECT 15. SECT 8 (6-YR).
<b>Live/Dead Indicator</b>	LIVE

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# **EXHIBIT B**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**

ESTTA Tracking number: **ESTTA568658**Filing date: **11/01/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Starbuzz Tobacco, Inc.
Granted to Date of previous extension	11/06/2013
Address	10630 Fern Avenue Stanton, CA 90680 UNITED STATES
Correspondence information	Natu J. Patel THE PATEL LAW FIRM, P.C. 22952 Mill Creek Drive Laguna Hills, CA 92653 UNITED STATES NPatel@thePatelLawFirm.com Phone:(949) 955-1077

**Applicant Information**

Application No	85846992	Publication date	07/09/2013
Opposition Filing Date	11/01/2013	Opposition Period Ends	11/06/2013
Applicant	SIS Resources Ltd. P.O. Box 674 Bet Shemesh, ILX 99000 ILX		

**Goods/Services Affected by Opposition**


Class 034. First Use: 2010/09/19 First Use In Commerce: 2010/09/19  
All goods and services in the class are opposed, namely: Electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges, cartomisers, and atomisers


**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------

**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	3619407	Application Date	11/20/2008
Registration Date	05/12/2009	Foreign Priority Date	NONE
Word Mark	BLUE MIST		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 2006/12/01 First Use In Commerce: 2006/12/01 Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco

U.S. Registration No.	3695500	Application Date	03/25/2009
Registration Date	10/13/2009	Foreign Priority Date	NONE
Word Mark	CITRUS MIST		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 034. First use: First Use: 2008/03/04 First Use In Commerce: 2008/03/04 Pipe tobacco; molasses tobacco; tobacco; smoking tobacco; flavored tobacco; herbal molasses herbs for smoking, tobacco and tobacco substitutes		

Attachments	77619104#TMSN.jpeg( bytes ) 77699076#TMSN.jpeg( bytes ) MOCHA MIST - Notice of Opposition 110113.pdf(755332 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/natupatel/
Name	Natu J. Patel

Date	11/01/2013
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**IN THE UNITED STATES PATENT AND TRADE MARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

***In the Matter of Application Serial No. 85/846,992***

***Mark: MOCHA MIST***

***Filed: February 12, 2013***

***Published: July 9, 2013***

STARBUZZ TOBACCO, INC.,

Opposer,

v.

SIS RESOURCES LTD.,

Applicant.

**OPPOSITION NO: \_\_\_\_\_**

**NOTICE OF OPPOSITION**

Starbuzz Tobacco, Inc. ("Starbuzz"), a corporation organized and existing under the laws of the State of California, believes that it will be damaged by registration of the mark shown in U.S. Application Serial No. 85/846,992 in International Class 34 (the "Application") and hereby opposes the same.

**As grounds for opposition it is alleged that:**

**Starbuzz's Background**

1. Starbuzz is a manufacturer and distributor of tobacco, electronic cigarettes, hookahs, and various other products. Starbuzz's address has been changed from 2116 W. Lincoln Avenue, Anaheim, California 92801 to 10871 Forbes Avenue, Garden Grove, California 92843.

2. Starbuzz is the owner of U.S. Registration No. 3,619,407 for the mark “BLUE MIST” used in connection with “Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco” in International Class 034. Starbuzz has sold and/or distributed products bearing the “BLUE MIST” mark since at least as early as December 1, 2006. A true and correct copy of the “BLUE MIST” registration certificate is attached hereto as **Exhibit A**.

3. Starbuzz also owns U.S. Registration No. 3,695,500 for the mark “CITRUS MIST” used in connection with “Pipe tobacco; molasses tobacco; tobacco; smoking tobacco; flavored tobacco; herbal molasses herbs for smoking, tobacco and tobacco substitutes” in International Class 034. Starbuzz has sold and/or distributed products bearing the “CITRUS MIST” mark since at least as early as March 4, 2008. A true and correct copy of the “CITRUS MIST” registration certificate is attached hereto as **Exhibit B**.

4. Starbuzz’s “BLUE MIST” and “CITRUS MIST” marks are collectively referred to as the Starbuzz Marks.

#### **SIS’s Background**

5. Starbuzz is informed and believes, and on that basis alleges that, Applicant, SIS Resources Ltd. (“SIS”) is an Israeli corporation, whose address is P.O. Box 674, 99000 Bet Shemesh, Israel.

6. Starbuzz is informed and believes, and on that basis alleges that, SIS has designated Ms. Rachel D. Brandeis-Danielov, Esq., whose address is 20533 Biscayne Blvd., Suite 784, Miami, FL 33180-1529, as the representative upon whom the Opposition may be served.



7. Starbuzz is informed and believes, and on that basis alleges that, on February 12, 2013, SIS filed U.S. Application Serial No. 85/846,992 for the mark “MOCHA MIST” (“SIS's Mark”) for “Electronic cigarettes components, accessories, parts, and structural parts therefor, namely, refill cartridges, cartomisers, and atomisers” in International Class 34 (“SIS's Goods”).

8. The Application was filed based upon use of SIS's Mark in commerce, pursuant to Section 1(a) of the Lanham Act. SIS claimed that it had been using SIS's Mark at least as early as 09/19/2010.

9. The USPTO published SIS's Mark for opposition in the Official Gazette on July 9, 2013.

10. On July 24, 2013, Starbuzz obtained an extension of time to oppose the Application, and has until November 6, 2013 to file the Opposition. Therefore, this Notice of Opposition is timely.

### **GROUND FOR OPPOSITION**

#### **Standing and Priority**

11. Starbuzz re-alleges and incorporates by this reference paragraphs 1 through 10, inclusive, of this Notice of Opposition as if fully set forth herein.

12. Starbuzz is informed and believes, and on that basis alleges that, the filing date and date of first use of the Starbuzz Marks in commerce predates the date of first use of SIS's Mark in commerce. Therefore, Starbuzz's rights to the Starbuzz Marks have priority over any rights claimed by SIS in SIS's Mark.

**Likelihood of Confusion Pursuant to 15 U.S.C. §1052(d)**

13. Starbuzz re-alleges and incorporates by this reference paragraphs 1 through 12, inclusive, of this Notice of Opposition as if fully set forth herein.

14. The term “MIST” has no special meaning within the tobacco industry. The Starbuzz Marks containing the term “MIST” are therefore arbitrary or fanciful as applied to tobacco and other related products and should be afforded the highest level of protection.

15. Based on the identical term “MIST”, Starbuzz is informed and believes, and on that basis alleges that, SIS’s Mark, when used in conjunction with SIS’s Goods, so resembles the Starbuzz Marks, as to be likely to cause confusion, to cause mistake, and to deceive within the meaning of 15 U.S.C. §1052(d).

16. In fact, SIS’s Mark is similar to the Starbuzz Marks in appearance, sound and overall commercial impression.

17. Starbuzz is informed and believes, and on that basis alleges that, the type of goods offered in conjunction with SIS’s Mark is similar or related to the type of goods offered in conjunction with the Starbuzz Marks.

18. Starbuzz’s rights to the Starbuzz Marks are not limited to tobacco products, but extend to related products within the same industry and market, or within the natural zone of expansion, including electronic cigarette products.

19. Starbuzz is informed and believes, and on that basis alleges that, SIS’s Goods, and Starbuzz’s goods, are marketed to identical or similar groups of consumers.

20. Starbuzz is informed and believes, and on that basis alleges that, SIS's Goods and Starbuzz's goods, are advertised, promoted, and/or sold through the same or similar channels of trade.

21. Starbuzz is informed and believes, and on that basis alleges that, SIS's Goods and Starbuzz's goods, target the same general class of purchasers.

22. Starbuzz has no control over the nature and quality of SIS's Goods that bear SIS's Mark, and any dissatisfaction with SIS's Goods would reflect adversely on Starbuzz, thus damaging the goodwill and reputation Starbuzz has established in the Starbuzz Marks.

23. Registration of SIS's Mark will damage Starbuzz because the trademark sought to be registered, "MOCHA MIST", is so similar to the Starbuzz Marks, that use of SIS's Mark will cause confusion or mistake, and is likely to deceive purchasers, as well as the general public, into the erroneous belief that SIS's Goods and Starbuzz's goods originate from the same source, or are authorized or sponsored by Starbuzz.

24. Starbuzz's customers, as well as the general public, are likely to be confused, mistaken, or deceived as to the origin or sponsorship of SIS's Goods and Starbuzz's goods. Based upon such likelihood of confusion, SIS's Mark should be denied registration pursuant to 15 U.S.C. §1052(d).

WHEREFORE, Starbuzz prays that Application Serial No. 85/846,992 be denied registration.

///

///

Starbuzz hereby consents and appoints Natu J. Patel of The Patel Law Firm, P.C., 22952 Mill Creek Drive, Laguna Hills, CA 92653, who is a member of the Bar of the State of California, as its duly authorized agent and attorney to prosecute this Opposition and to transact all business in the Patent and Trademark Office and in the United States Courts, to sign his name to all papers which may hereinafter be filed in connection therewith, and to receive all official communications in connection with this Opposition.

Respectfully submitted,  
The Patel Law Firm, P.C.

/natupatel/

Natu J. Patel  
Attorney for Starbuzz  
Starbuzz Tobacco, Inc.

The Patel Law Firm, P.C.  
22952 Mill Creek Drive  
Laguna Hills, CA 92653  
Telephone: (949) 955-1077  
Facsimile: (949) 955-1877  
NPatel@thePatelLawFirm.com

JC/rp

**CERTIFICATE OF SERVICE**

I certify that a copy of this NOTICE OF OPPOSITION is being served via overnight courier, postage prepaid, on this the 1st day of November, 2013, to the following:

**SIS Resources Ltd.'s Attorney/Representative:**

Rachel D. Brandeis-Danielov, Esq.  
Green Smoke, Inc.  
20533 Biscayne Blvd., Suite 784  
Miami, FL 33180-1529

**SIS Resources Ltd.:**

SIS Resources Ltd.  
P.O. Box 674  
99000 Bet Shemesh, Israel

  
Mark Uy

## **Exhibit A**

**Int. Cl.: 34**

**Prior U.S. Cls.: 2, 8, 9 and 17**

**United States Patent and Trademark Office**

**Reg. No. 3,619,407**

**Registered May 12, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**Blue Mist**

**STARBUZZ TOBACCO, INC. (CALIFORNIA COR-  
PORATION)  
UNIT #A  
1889 W. COMMONWEALTH STREET  
FULLERTON, CA 92833**

**THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.**

**FOR: PIPE TOBACCO, TOBACCO, SMOKING  
TOBACCO, FLAVORED TOBACCO, MOLASSES TO-  
BACCO, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).**

**SER. NO. 77-619,104, FILED 11-20-2008.**

**FIRST USE 12-1-2006; IN COMMERCE 12-1-2006.**

**REGINA DRUMMOND, EXAMINING ATTORNEY**

## **Exhibit B**



# United States of America

United States Patent and Trademark Office

## Citrus Mist

**Reg. No. 3,695,500** STARBUZZ TOBACCO, INC. (CALIFORNIA CORPORATION)  
Registered Oct. 13, 2009 2116 W. LINCOLN AVENUE  
ANAHEIM, CA 92801

**Int. Cl.: 34** FOR: PIPE TOBACCO; MOLASSES TOBACCO; TOBACCO; SMOKING TOBACCO;  
FLAVORED TOBACCO; HERBAL MOLASSES HERBS FOR SMOKING, TOBACCO AND  
TOBACCO SUBSTITUTES, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

**TRADEMARK**  
**PRINCIPAL REGISTER** FIRST USE 3-4-2008; IN COMMERCE 3-4-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,619,407.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CITRUS", APART FROM THE MARK AS SHOWN.

SER. NO. 77-699,076, FILED 3-25-2009.

DAVID YONTEF, EXAMINING ATTORNEY



*David J. Kybas*

Director of the United States Patent and Trademark Office

# **EXHIBIT C**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**

Natu J. Patel, SBN 188618  
 Jason Chuan, SBN 261868  
 Daniel H. Ngai, SBN 302297  
**THE PATEL LAW FIRM, P.C.**  
 22952 Mill Creek Drive  
 Laguna Hills, California 92653  
 Phone: 949.955.1077  
 Facsimile: 949.955.1877  
 NPatel@thePatelLawFirm.com

Attorneys for Plaintiff,  
 Starbuzz Tobacco, Inc.,  
 a California corporation

**UNITED STATES DISTRICT COURT  
 CENTRAL DISTRICT OF CALIFORNIA**

STARBUZZ TOBACCO, INC., a	) Case No.:
California corporation,	)
	) COMPLAINT FOR:
Plaintiff,	)
vs.	) 1. TRADEMARK INFRINGEMENT
	) (UNDER 15 U.S.C. §1114);
	)
SIS RESOURCES LTD., an Israeli	) 2. FALSE DESIGNATION OF
corporation, NU MARK LLC, a	) ORIGIN (UNDER 15 U.S.C.
Virginia limited liability company,	) §1125);
	)
Defendants.	) 3. UNFAIR BUSINESS PRACTICES
	) (UNDER BUS. & PROF. CODE
	) §17200 et seq.); AND
	)
	) 4. COMMON LAW TRADEMARK
	) INFRINGEMENT AND UNFAIR
	) COMPETITION
	)
	) DEMAND FOR JURY TRIAL
	)
	)

1 Plaintiff, Starbuzz Tobacco, Inc. complains and alleges as follows:

2 **PARTIES**

3 1. Plaintiff, Starbuzz Tobacco, Inc. (“Starbuzz” or “Plaintiff”), is now,  
4 and at all times relevant herein was, a corporation organized under the laws of the  
5 State of California, with its principal place of business in the City of Garden  
6 Grove, California.  
7

8 2. Defendant, SIS Resources LTD. (“SIS Resources”), is now, and at all  
9 times relevant herein was, a corporation organized under the laws of Israel, with its  
10 principal place of business at 9/2 Nahal Arugot St., Ramat Beit Shemesh, Israel  
11 99097. Starbuzz is informed and believes, and on that basis alleges, that SIS  
12 Resources is the owner of the infringing MOCHA MIST trademark which it uses  
13 and displays in this judicial district.  
14

15 3. Defendant Nu Mark LLC (“Nu Mark”) is now, and at all times  
16 relevant herein was, a limited liability company organized under the laws of the  
17 State of Virginia, with its principal place of business at 6603 W. Broad Street,  
18 Richmond, Virginia 23260. Defendant Nu Mark does business within this judicial  
19 district through its website [www.greensmoke.com](http://www.greensmoke.com) which displays the infringing  
20 MOCHA MIST trademark to consumers in this judicial district.  
21  
22  
23  
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1           4.     Starbuzz is informed and believes, and on that basis alleges, that in  
2 April 2014, Nu Mark acquired the original owner of the www.greensmoke.com  
3 website, namely Green Smoke, LLC.  
4

5           5.     SIS Resources and Nu Mark are collectively referred to as  
6 “Defendants.”  
7

8           6.     Starbuzz is informed and believes, and on that basis alleges, that  
9 Defendants are responsible for each of their acts and for their conduct, which are  
10 the true legal causes for the damages herein alleged.  
11

## 12                           **JURISDICTION AND VENUE**

13           7.     This Court has original jurisdiction over this action pursuant to 15  
14 U.S.C. §§1119 and 1121, and 28 U.S.C. §§1331 and 1338, in that this Complaint  
15 raises federal questions under the United States Trademark Act (Lanham Act), 15  
16 U.S.C. §1051 et seq. The Court has supplemental jurisdiction over the state law  
17 claims pursuant to 28 U.S.C. §1367.  
18

19           8.     The Court has personal jurisdiction over Defendants because they  
20 have purposefully engaged in using trademarks that are identical to, and  
21 confusingly similar to, Starbuzz’s trademarks in connection with the sale and  
22 distribution of electronic cigarettes and e-liquids. Since Starbuzz’s registered  
23 trademarks provide constructive notice of Starbuzz’s intellectual property rights  
24 and Starbuzz’s location, Defendants knew or should have known that their  
25  
26  
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28

1 activities were directed towards California, and the effect of those activities would  
2 be felt in California.

3  
4 9. The Court also has personal jurisdiction over Defendants because  
5 Defendants have engaged in business activities in and directed to California, and  
6 have committed tortious acts within the State.

7  
8 10. The Court also has personal jurisdiction over Defendants because they  
9 have purposefully availed themselves of the opportunity to conduct commercial  
10 activities in this forum. The Complaint arises out of those commercial activities.

11  
12 11. Venue is proper in this district under 28 U.S.C. § 1391 (b) and (c) in  
13 that substantial injury occurred and continues to occur in this district, a substantial  
14 portion of the events that are the subject of this action took place in this district,  
15 and Defendants are doing business within this judicial district and are subject to  
16 personal jurisdiction in this district.  
17

18  
19 **AGENCY**

20  
21 12. At all times herein mentioned, each Defendant was the agent, servant,  
22 joint venturer, partner, or employee of the other Defendants, successor  
23 corporations, successors in interest, or entities and, in doing the things herein  
24 alleged, were acting within the purpose and scope of said agency or employment at  
25 the time of the incident. All Defendants were acting within the scope and course  
26  
27  
28

1 of that agency and employment and with the knowledge and implied and/or  
2 express consent and permission of the other Defendants.

### 3 **INTRODUCTION**

4  
5 13. This case alleges a straightforward yet egregious claim of trademark  
6 infringement, and other violations of federal and state law. It is egregious because  
7  
8 Defendants have intentionally duplicated, adopted, and used trademarks that are  
9 identical or substantially similar to Starbuzz's trademarks in their products with  
10 blatant disregard to Starbuzz's intellectual property rights, in order to unfairly  
11 compete with Starbuzz and to trade upon Starbuzz's goodwill.  
12

13 14. As a manufacturer and supplier of premium hookah tobacco, as well  
14 as a distributor of hookahs, electronic cigarettes, electronic vaporizers, e-liquids  
15 and other products worldwide, Starbuzz has obtained over ninety (90) federally  
16 registered trademarks in the United States and has sought to obtain worldwide  
17 intellectual property protection in more than thirty-three (33) countries.  
18

19 15. Over the past several years, Starbuzz has sold, and continues to sell,  
20 tobacco products, electronic cigarettes, e-liquid, and electronic vaporizers bearing  
21 one or more of the following trademarks: BLUE MIST and CITRUS MIST.  
22 Starbuzz's aforementioned marks are collectively referred to as the "Starbuzz  
23 Marks."  
24  
25  
26  
27  
28

1           16. Starbuzz discovered that Defendants are using trademarks that are  
2 identical or substantially similar to the Starbuzz Marks in connection with  
3 Defendants' products.  
4

5           17. Defendants are not affiliated with Starbuzz in any way, and do not  
6 have Starbuzz's permission to use the Starbuzz Marks, or any mark that is  
7 confusingly similar to the Starbuzz Marks.  
8

9           18. Defendants intentionally adopted and use the confusingly similar  
10 trademark MOCHA MIST in connection with electronic cigarettes, cartridges, and  
11 vaporizers (the "Infringing Products"), to falsely convey to consumers, vendors,  
12 and third parties an association with Starbuzz, and to unfairly trade and benefit  
13 from the reputation and goodwill of Starbuzz's business and the Starbuzz Marks.  
14

15           19. On February 12, 2013, Defendant SIS Resources filed a trademark  
16 application, serial no. 85/846,992 for the MOCHA MIST trademark under Section  
17 1(b) of the Lanham Act, 15 U.S.C. § 1051(a), alleging a date of first use of  
18 September 19, 2010. The MOCHA MIST trademark is referred to herein as the  
19 "Infringing Mark."  
20  
21

22           20. Defendants are aware that their actions are specifically prohibited and  
23 are on notice that Starbuzz has not consented to their actions in any way.  
24  
25  
26  
27  
28



21. By this Complaint, Starbuzz seeks to prevent deception, consumer confusion, mistake, annoyance, and loss of customer goodwill, and to protect its intellectual property and reputation from intentional infringement.

22. Starbuzz files this civil action against Defendants for violations of the United States Trademark Act (Lanham Act), 15 U.S.C. §1051 et seq., and related state and common law claims.

## FACTS

### **OWNERSHIP OF THE STARBUZZ MARKS**

23. For the past several years, Starbuzz has been using the Starbuzz Marks in commerce.

24. Starbuzz also registered with the United States Patent and Trademark Office (“USPTO”) the following marks for various tobacco and related products:

<b><u>Trademark</u></b>	<b><u>Reg. No.</u></b>	<b><u>Register</u></b>	<b><u>First Use At Least As Early As</u></b>	<b><u>Exhibit</u></b>
BLUE MIST	3,619,407	Principal	December 1, 2006	<b><u>A</u></b>
CITRUS MIST	3,695,500	Principal	March 4, 2008	<b><u>B</u></b>

25. At all times relevant herein, Starbuzz has been, and still is, the owner of the exclusive rights, title, and interest in the Starbuzz Marks for tobacco and other related products, and has the full and exclusive rights to bring suit to enforce its trademark rights, including the right to recover for past infringement.

1 **STARBUZZ'S CONTINUOUS USE OF ITS MARKS**

2 26. Starbuzz manufactures, distributes, imports, and sells tobacco  
3 products throughout the United States and internationally. Starbuzz also  
4 distributes and sells tobacco alternative products, such as electronic cigarettes, e-  
5 liquids, and other related products throughout the United States and internationally.  
6 Starbuzz prides itself on its reputation for high-quality products. Starbuzz's  
7 continued goal is to develop new and popular tobacco, tobacco alternatives, and  
8 other related products while preserving the quality of its products and brand  
9 identity.  
10  
11  
12

13 27. Starbuzz sells its products to thousands of customers and clients,  
14 including boutique stores, wholesalers, and suppliers. Starbuzz has used, created  
15 and marketed the Starbuzz Marks continuously over the years. The Starbuzz  
16 Marks have brought Starbuzz enormous success, and Starbuzz is now known for its  
17 high quality products.  
18  
19

20 28. Starbuzz uses the Starbuzz Marks on advertising brochures,  
21 advertising leaflets, on the Internet, and on the packaging of its products.  
22

23 29. Starbuzz's intellectual property and brand identity have substantial  
24 image recognition.  
25

26 30. The Starbuzz Marks are important as they serve as easily-recognizable  
27 identifiers of the high quality goods and services that Starbuzz offers. There is a  
28

1 particularly close association among consumers between Starbuzz, the Starbuzz  
2 Marks, and the quality of the products and services offered under the Starbuzz  
3 Marks. For consumers, customers, vendors, and clients, the Starbuzz Marks are  
4 associated with original, flavorful, and smooth smoking tobacco, tobacco  
5 alternatives, and related products of the highest quality at an affordable price.  
6  
7

## 8 **DEFENDANT'S WRONGFUL ACTS**

### 9 Sales of Infringing Products

10  
11 31. Starbuzz is informed and believes, and on that basis alleges, that  
12 Defendants have sold and are currently selling, distributing, advertising and  
13 promoting the Infringing Products on the website www.greensmoke.com. Plaintiff  
14 is informed and believes, and thereon alleges, that Nu Mark distributes SIS  
15 Resources' products throughout the United States, including California, through  
16 that website. True and correct copies of printouts from various parts of the website  
17 www.greensmoke.com are attached hereto as **Exhibit C**.  
18  
19

20  
21 32. Starbuzz is informed and believes, and on that basis alleges, that  
22 Defendants have continuously and systematically distributed the Infringing  
23 Products throughout California and the United States, misled and confused  
24 consumers, and negatively affected the publicity regarding the Starbuzz products.  
25  
26  
27  
28

1           33. Starbuzz is informed and believes, and on that basis alleges, that  
2 Defendants are using the Infringing Mark to market, promote, advertise and sell  
3 the Infringing Products.  
4

5           34. Starbuzz is informed and believes, and on that basis alleges, that  
6 Defendants knew of Starbuzz's prior use of the Starbuzz Marks by virtue of  
7 Starbuzz's trademark registrations and reputation in the tobacco market.  
8

9           35. Nonetheless, Defendants adopted the Infringing Mark to market and  
10 sell the Infringing Products, to deceive consumers into believing that the Infringing  
11 Products are produced and manufactured by Starbuzz, and to trade upon Starbuzz's  
12 goodwill.  
13

14  
15 Defendants' Use of the Infringing Mark is Likely to Cause Consumer Confusion

16           36. Defendants' distribution and sale of the Infringing Products bearing  
17 the Infringing Mark is likely to cause consumer confusion.  
18

19           37. To date, Defendants are continuing with their infringing activity.  
20

21           38. Starbuzz is informed and believes, and on that basis alleges, that  
22 Defendants began using the Infringing Mark after Starbuzz began using the  
23 Starbuzz Marks for various products. Therefore, Starbuzz's rights in the Starbuzz  
24 Marks have priority over Defendants' rights in the Infringing Mark.  
25

26           39. Starbuzz is informed and believes, and on that basis alleges, that  
27 Defendants knew of Starbuzz's prior use of the Starbuzz Marks. Nonetheless,  
28

1 Defendants adopted and/or used the Infringing Mark to advertise their business and  
2 products.

3  
4 40. Starbuzz is informed and believes, and on that basis alleges, that given  
5 the similar or related nature of Starbuzz's products and the Infringing Products,  
6 and the similarity between the Infringing Mark and the Starbuzz Marks, consumers  
7  
8 are likely to be confused as to the source of Starbuzz's products and Defendants'  
9 products.

10  
11 41. Starbuzz is further informed and believes, and on that basis alleges,  
12 that Defendants intentionally, and in bad faith, adopted and used the Infringing  
13 Mark to trade upon the fame and goodwill associated with the Starbuzz Marks, to  
14  
15 deceive consumers, vendors and third parties, to attract new business in  
16 competition to Starbuzz, and to derive an economic benefit therefrom.

17  
18 42. Defendants knowingly used and continue to use the Infringing Mark  
19 without Starbuzz's consent or authorization.

20  
21 43. The products that Defendants offer under the Infringing Mark are in  
22 the same category of products which Starbuzz offers under the Starbuzz Marks.  
23 Therefore, Defendants' use of the Infringing Mark is likely to cause consumer  
24  
25 confusion.

26  
27 44. Starbuzz and Defendants sell their products online. Starbuzz and  
28 Defendants thus have convergent marketing channels.

1           45. Starbuzz is further informed and believes, and on that basis alleges,  
2 that Starbuzz and Defendants have convergent marketing channels since they sell  
3 and market products within the same geographic area.  
4

5           46. Defendants' use of convergent marketing channels increases the  
6 likelihood of consumer confusion.  
7

8           47. Defendants' continued use of the Infringing Mark is thus likely to lead  
9 consumers, retailers, wholesalers, and vendors to mistakenly conclude that  
10 Defendants' products are affiliated, connected, or associated with Starbuzz.  
11 Consumers are likely to be misled and confused as to the true source, sponsorship,  
12 or affiliation of Defendants' products.  
13  
14

15           48. Starbuzz never consented, either orally or in writing, to allow  
16 Defendants to use trademarks identical or similar to the Starbuzz Marks for any  
17 reason, including the marketing and sale of Infringing Products.  
18

19           49. Defendants knowingly used and continue to use the Infringing Mark  
20 without Starbuzz's consent or authorization.  
21

22                           **FIRST CLAIM FOR RELIEF**  
23                   **[Trademark Infringement Under Lanham Act 15 U.S.C. §1114]**  
24                           **(Against All Defendants)**

25           50. Starbuzz re-alleges and incorporates by this reference paragraphs 1  
26 through 49, inclusive, of this Complaint as if fully set forth herein.  
27  
28

1           51. Defendants' use of the Infringing Mark to promote, market, or sell  
2 Infringing Products constitutes trademark infringement pursuant to 15 U.S.C.  
3 §1114.  
4

5           52. Defendants have promoted, sold, and marketed, and continue to  
6 promote, sell, and market, Infringing Products using the Infringing Mark, which  
7  
8 are identical or confusingly similar to the Starbuzz Marks.

9           53. Starbuzz is informed and believes, and on that basis alleges, that its  
10 use of the Starbuzz Marks in commerce predates Defendants' use of the Infringing  
11 Mark in commerce.  
12

13           54. The Starbuzz Marks are highly distinctive, arbitrary and/or fanciful,  
14  
15 and are entitled to strong trademark protection.

16           55. Defendants continue to promote, sell and market the Infringing  
17 Products under the Infringing Mark, in direct competition with Starbuzz's  
18 products, which Starbuzz promotes, sells, and markets under the Starbuzz Marks.  
19 Defendants therefore use the Infringing Mark on the same, related, or  
20  
21 complementary category of goods as Starbuzz.  
22

23           56. Defendants' Infringing Mark is so similar in appearance,  
24  
25 pronunciation, meaning, and commercial impression to the Starbuzz Marks that  
26 consumers are likely to be confused as to the source of the parties' products.  
27  
28

1           57. Starbuzz is informed and believes, and on that basis alleges, that  
2 Defendants market and sell their products throughout the United States through  
3 various channels, including, but not limited to, the internet and retail stores and  
4 shops. These are the same channels through which Starbuzz markets and sells its  
5 goods. These are the same channels through which Starbuzz markets and sells its  
6 goods.

7  
8           58. Starbuzz is informed and believes, and on that basis alleges, that  
9 Defendants intentionally and willfully adopted the Infringing Mark in an effort to  
10 deceive or cause confusion with the consuming public.

11  
12           59. Defendants' attempts to cause confusion, or to cause mistake, or to  
13 deceive further indicate an intentional and willful infringement upon the Starbuzz  
14 Marks.

15  
16           60. Defendants' continued use of the Infringing Mark also demonstrates  
17 Defendants' intentional and willful infringement of the Starbuzz Marks.

18  
19           61. Defendants' intentional, continuing, and willful infringement of the  
20 Starbuzz Marks has caused and will continue to cause damage to Starbuzz, and is  
21 causing irreparable harm to Starbuzz for which there is no adequate remedy at law.

22  
23           62. Defendants are directly, contributorily, and/or vicariously liable for  
24 these actions.  
25  
26  
27  
28



**SECOND CLAIM FOR RELIEF**  
**[Trademark Infringement - False Designation of Origin Under**  
**Lanham Act 15 U.S.C. §1125(a)(1)(A)]**  
**(Against All Defendants)**

63. Starbuzz re-alleges and incorporates by this reference paragraphs 1 through 62, inclusive, of this Complaint as if fully set forth herein.

64. In connection with Infringing Products, Defendants knowingly and willfully used in commerce, words, terms, names, symbols, or devices, or a combination thereof, which are likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Defendants with Starbuzz, or as to the origin, sponsorship, or approval of Defendants' goods.

65. Starbuzz is informed and believes, and on that basis alleges, that Defendants willfully and intentionally created a false or misleading affiliation, connection, or association between Defendants' goods and Starbuzz's goods.

66. Starbuzz is informed and believes, and on that basis alleges, that Defendants adopted words, terms, names, symbols, or devices, or a combination thereof, which are similar to the Starbuzz Marks, or willfully and intentionally marketed their goods and services with words, terms, names, symbols, or devices, or a combination thereof, similar to the Starbuzz Marks.

67. Starbuzz is informed and believes, and on that basis alleges, that Starbuzz's use of the Starbuzz Marks in commerce precedes Defendants' use of the Infringing Marks in interstate commerce.

1           68. Starbuzz is informed and believes, and on that basis alleges, that  
2 Defendants' aforesaid acts were done with knowledge of Starbuzz's trademarks,  
3 and the knowledge that use of such words, terms, names, symbols, or devices, or a  
4 combination thereof, was misleading.  
5

6           69. Defendants' intentional and willful infringement of Starbuzz's  
7 trademarks has caused and will continue to cause damage to Starbuzz and is  
8 causing irreparable harm to Starbuzz for which there is no adequate remedy at law.  
9  
10

11           70. Starbuzz was damaged by these acts in an amount to be proven at  
12 trial. Defendants' actions have caused and will continue to cause irreparable harm  
13 to Starbuzz for which there is no adequate remedy at law. Thus, Starbuzz is also  
14 entitled to injunctive and equitable relief against Defendants under the Lanham  
15 Act.  
16  
17

18           71. Defendants are directly, contributorily, and/ or vicariously liable for  
19 these actions.  
20

21                           **THIRD CLAIM FOR RELIEF**  
22                           **[Unfair Competition – Violation of California**  
23                           **Business and Professions Code §17200 et seq.]**  
                              **(Against All Defendants)**

24           72. Starbuzz re-alleges and incorporates by this reference paragraphs 1  
25 through 71 inclusive, of this Complaint as if fully set forth herein.  
26

27           73. Starbuzz is informed and believes, and on that basis alleges, that  
28 Defendants' aforesaid acts constitute actionable wrongs under California Business

1 and Professions Code §17200 *et seq.* in that Defendants' unlawful, unfair, or  
2 fraudulent use of words, terms, names, symbols, or devices, or a combination  
3 thereof, which are similar to the Starbuzz Marks, create a probability of confusion  
4 or misunderstanding as to the source, sponsorship, approval, or certification of  
5 Starbuzz's and Defendants' goods.  
6

7  
8 74. Starbuzz is informed and believes, and on that basis alleges, that  
9 Defendants have offered and continue to market goods using words, terms, names,  
10 symbols, or devices, or a combination thereof, which are similar to the Starbuzz  
11 Marks, in an attempt to unfairly compete with Starbuzz.  
12

13 75. Starbuzz is further informed and believes, and on that basis alleges,  
14 that Defendants have also been attempting to unfairly compete with Starbuzz  
15 through the use of deceptive and/or misleading advertising.  
16

17 76. By reason of the foregoing unlawful acts, Defendants have caused,  
18 and continue to cause, substantial and irreparable damage and injury to Starbuzz  
19 and to the public. Defendants have benefited from such unlawful conduct, and will  
20 continue to carry out such unlawful conduct and to be unjustly enriched thereby,  
21 unless enjoined by this Court.  
22

23 77. As a proximate and direct result of Defendants' acts as herein alleged,  
24 Starbuzz has sustained damages in an amount to be proven at trial.  
25  
26  
27  
28

1           78. Defendants are directly, contributorily and/or vicariously liable for  
2 these actions.

3                                   **FOURTH CLAIM FOR RELIEF**  
4                   **[Common Law Trademark Infringement and Unfair Competition]**  
5                                   **(Against All Defendants)**

6           79. Starbuzz re-alleges and incorporates by this reference paragraphs 1  
7 through 78, inclusive, of this Complaint as if fully set forth herein.

8           80. Starbuzz is informed and believes, and on that basis alleges, that  
9 Defendants' aforesaid acts constitute actionable wrongs under the common law in  
10 that Defendants' use of the Infringing Mark constitutes an infringement and  
11 violation of Starbuzz's rights in its trademarks, and creates a likelihood that  
12 Starbuzz's customers, potential customers, and the public generally will be  
13 confused or misled as to the source of goods and services because they are likely to  
14 believe that Defendants' products are identical to or affiliated with that of  
15 Starbuzz.

16           81. By reason of the foregoing unlawful acts, Defendants have caused,  
17 and continue to cause, substantial and irreparable damage and injury to Starbuzz  
18 and to the public. Defendants have benefited from such unlawful conduct and will  
19 continue to carry out such unlawful conduct and to be unjustly enriched thereby  
20 unless enjoined by this Court.



1 purchases of products or services, or products sold in the course of providing such  
2 services, or any related activities, pursuant to 15 U.S.C. §1118;

3  
4 5. A preliminary and permanent injunction, pursuant to 15 U.S.C. §1116,  
5 enjoining and prohibiting Defendants and any of their officers, directors,  
6 employees, agents, subsidiaries, distributors, dealers, and all persons in active  
7 concert or participation with any of them from:  
8

9 A. Using Starbuzz's trademarks, or any confusingly similar marks,  
10 including, but not limited to, the marks BLUE MIST, CITRUS MIST, and  
11 MOCHA MIST, in any manner, on or in products, merchandise, or goods, or for  
12 purposes of advertising, selling, or soliciting purchases of, products or  
13 merchandise;  
14

15  
16 B. Infringing on Starbuzz's trademarks;  
17

18 C. Assisting, aiding, or abetting any other person or business entity in  
19 engaging in or performing any of the activities referred to in subparagraphs (A)  
20 and (B) above;  
21

22 6. An Order requiring Defendants and their agents, servants, and  
23 employees and all persons acting in concert with or for them to file with this Court  
24 and serve on Starbuzz, within thirty (30) days after service of an injunction, a  
25 report in writing, under oath, setting forth in detail the manner and form in which  
26  
27  
28

1 Defendants have complied with the applicable injunction, pursuant to 15 U.S.C.  
2 §1116;

3  
4 7. An Order requiring Defendants to withdraw and abandon their  
5 trademark application, serial no. 85/846,992, for the infringing MOCHA MIST  
6 Trademark or cancelling Defendant's infringing MOCHA MIST Trademark  
7 pursuant to Section 37 of the Lanham Act, 15 U.S.C. § 1119, if it proceeds to  
8 registration;  
9

10  
11 8. Pre-judgment and post-judgment interest on any amounts awarded at  
12 the maximum legal rate as permitted by law and equity; and

13  
14 9. Any other or further relief that the Court deems appropriate, proper,  
15 and just.

16 **ON THE THIRD AND FOURTH CLAIMS**

17  
18 1. An Order finding that Defendants have infringed Starbuzz's  
19 intellectual property rights and unfairly competed with Starbuzz;

20  
21 2. Judgment for Starbuzz and against Defendants for actual, special, and  
22 consequential damages, in an amount to be proven at trial and for costs incurred in  
23 the litigation;

24  
25 3. An Order requiring Defendants to account for and disgorge all gains,  
26 profits, and advantages from the violations of California State, and common law;  
27  
28

1           4.     A preliminary and permanent injunction, enjoining and prohibiting  
2 Defendants and any of their officers, directors, employees, agents, subsidiaries,  
3 distributors, dealers, and all persons in active concert or participation with any of  
4 them from using the marks BLUE MIST, CITRUS MIST, and MOCHA MIST to  
5 advertise, solicit business or otherwise compete with Starbuzz.  
6

7  
8           5.     Pre-judgment and post-judgment interest on any amounts awarded at  
9 the maximum legal rate as permitted by law and equity; and  
10

11           6.     Any other or further relief that the Court deems appropriate, proper,  
12 and just.  
13

14 DATED: February 4, 2015

Respectfully Submitted,  
**THE PATEL LAW FIRM, P.C.**



Natu J. Patel,  
Jason Chuan,  
Daniel H. Ngai,  
Attorneys for Plaintiff  
Starbuzz Tobacco, Inc.



**DEMAND FOR TRIAL BY JURY**

Plaintiff Starbuzz Tobacco, Inc. hereby demands a trial by jury on all  
issues raised in the Complaint.

DATED: February 4, 2015

Respectfully Submitted,  
**THE PATEL LAW FIRM, P.C.**



Natu J. Patel,  
Jason Chuan,  
Daniel H. Ngai,  
Attorneys for Plaintiff  
Starbuzz Tobacco, Inc.

## **Exhibit A**

**Int. Cl.: 34**

**Prior U.S. Cls.: 2, 8, 9 and 17**

**United States Patent and Trademark Office**

**Reg. No. 3,619,407**

**Registered May 12, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**Blue Mist**

STARBUZZ TOBACCO, INC. (CALIFORNIA CORPORATION)  
UNIT #A  
1889 W. COMMONWEALTH STREET  
FULLERTON, CA 92833

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: PIPE TOBACCO, TOBACCO, SMOKING TOBACCO, FLAVORED TOBACCO, MOLASSES TOBACCO, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

SER. NO. 77-619,104, FILED 11-20-2008.

FIRST USE 12-1-2006; IN COMMERCE 12-1-2006.

REGINA DRUMMOND, EXAMINING ATTORNEY

## **Exhibit B**

# United States of America

United States Patent and Trademark Office

## Citrus Mist

**Reg. No. 3,695,500** STARBUZZ TOBACCO, INC. (CALIFORNIA CORPORATION)  
Registered Oct. 13, 2009 2116 W. LINCOLN AVENUE  
ANAHEIM, CA 92801

**Int. Cl.: 34** FOR: PIPE TOBACCO; MOLASSES TOBACCO; TOBACCO; SMOKING TOBACCO;  
FLAVORED TOBACCO; HERBAL MOLASSES HERBS FOR SMOKING, TOBACCO AND  
TOBACCO SUBSTITUTES, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

**TRADEMARK**  
**PRINCIPAL REGISTER** FIRST USE 3-4-2008; IN COMMERCE 3-4-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,619,407.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CITRUS", APART FROM THE MARK AS SHOWN.

SER. NO. 77-699,076, FILED 3-25-2009.

DAVID YONTEF, EXAMINING ATTORNEY



*David J. Kyffers*

Director of the United States Patent and Trademark Office

## **Exhibit C**

30 DAY money back guarantee (<http://www.greensmoke.com/ecig-info/our-guarantee.html>) | FREE shipping both ways (<http://www.greensmoke.com/e>)

Home / E-cig Info / Flavored Cartridges

## Flavored Cartridges



### FLAVORMAX™ CARTRIDGES

Discover our FlavorMax Cartridges.™ Made with patented technology, these e-cig cartridges contain two main parts: a heating element and e-liquid. The heating element (aka "atomizer") vaporizes the liquid into thick, realistic vapor, which contains nicotine and flavoring.

- ✓ Variety of 7 Flavors
- ✓ Choice of 5 Nicotine Levels
- ✓ Unbelievable Vapor Volume
- ✓ Flavor Shield™ Technology
- ✓ Smooth, Easy Draw
- ✓ Triple-Sealed for Freshness

(<http://www.greensmoke.com/ecig-info/>)

#### RED LABEL TOBACCO™



**Classic:** Smooth and Mild

#### ABSOLUTE TOBACCO



**Full-Bodied:** Woody and Aromatic

#### TOBACCO GOLD™



**Luxurious:** Rich and Sweet

#### MENTHOL ICE™



**Cool:** A Refreshing Taste

#### MOCHA MIST™



**Cultured:** A Sophisticated Coffee Blend

#### SMOOTH CREAM™



**Refined:** A Gourmet and Creamy Blend

#### MOUNTAIN CLOVE™



**Exotic:** A Warm and Spicy Clove Blend

#### VARIETY PACK



**Not Sure?** Get A Variety Pack!

## Nicotine Levels

**2.4%**

NICOTINE

**1.8%**

NICOTINE

**1.2%**

NICOTINE

**0.6%**

NICOTINE

**0%**

NICOTINE

(<http://www.greensmoke.com/ecig-info/>)



cartridges/)

Not all flavors are available in the state of California. If you live outside of California and are not able to order those flavors, please call our customer service and they'll be happy to assist you.

**WARNING:** This product contains nicotine which is a highly addictive substance. It is intended for use by existing smokers above legal age only. Do not use this product to treat any medical condition or habit. Do not use if pregnant, breast-feeding or suffering from any medical condition. Stop use if you show any sensitivity to this product. This product contains nicotine, a chemical known to the State of California to cause birth defects or other reproductive harm.

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**COMPANY****SITE**

Contact Us (</ecig-info/contact-us.html>)

My Account (</account/dashboard>)

About Us (</meet-our-team.html>)

Shipping Info (</ecig-info/faq.html#faqGroupHeading>)

Affiliate Program (<https://earn.greensmoke.com/home/>)

Español (<http://www.greensmoke.com/espanol/>)

Privacy (</ecig-info/privacy-policy.html>)

Terms (</ecig-info/terms-and-conditions.html>)

**Green**

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6603 W. Broad Street  
Richmond, VA, 23230  
(888) 224 1345 (tel:18882241345)

**18+**

(</ecig-info/green-smoke-is-intended-for>)

Teal v. white link →



# **EXHIBIT D**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**

Natu J. Patel, SBN 188618  
 Jason Chuan, SBN 261868  
 Carla A. Federis, SBN 266611  
**THE PATEL LAW FIRM, P.C.**  
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Attorneys for Plaintiff,  
 Starbuzz Tobacco, Inc.,  
 a California corporation

**UNITED STATES DISTRICT COURT  
 CENTRAL DISTRICT OF CALIFORNIA**

STARBUZZ TOBACCO, INC., a	)	Case No.: 8:13-cv-00411-CJC-AN
California corporation,	)	
	)	<b>FIRST AMENDED COMPLAINT</b>
Plaintiff,	)	<b>FOR:</b>
	)	
vs.	)	<b>1. DECLARATORY</b>
	)	<b>JUDGMENT FOR NON-</b>
	)	<b>INFRINGEMENT OF</b>
LOEC, INC., a Delaware corporation,	)	<b>TRADEMARKS; AND</b>
	)	
Defendant.	)	<b>2. DECLARATORY</b>
	)	<b>JUDGMENT FOR NON-</b>
	)	<b>DILUTION OF</b>
	)	<b>TRADEMARKS</b>
	)	<b>DEMAND FOR JURY TRIAL</b>
	)	
	)	

1 Plaintiff, Starbuzz Tobacco, Inc. complains and alleges as follows:

2 **PARTIES**

3 1. Plaintiff, Starbuzz Tobacco, Inc. ("Starbuzz" or "Plaintiff"), is now,  
4 and at all times relevant herein was, a corporation organized under the laws of the  
5 State of California, with its principal place of business in the City of Stanton,  
6 California.  
7

8 2. Defendant, LOEC, Inc. ("LOEC" or "Defendant"), is now, and at all  
9 times relevant herein was, a corporation organized under the laws of the State of  
10 Delaware, with its principal place of business in the City of Greensboro, North  
11 Carolina.  
12

13 3. Starbuzz is informed and believes, and on that basis alleges, that  
14 Defendant is responsible for its acts and for its conduct, which are the true legal  
15 causes for the relief herein alleged.  
16

17 **JURISDICTION AND VENUE**

18 4. This Court has original jurisdiction over this action pursuant to 15  
19 U.S.C. § 1121, 28 U.S.C. § 1331, 28 U.S.C. § 1338, and 28 U.S.C. 2201(a), in that  
20 this Complaint raises federal questions under the United States Trademark Act  
21 (Lanham Act), 15 U.S.C. §1051 *et seq.* and seeks declaratory relief from this Court  
22 to clarify the rights of the parties.  
23  
24  
25  
26  
27  
28

1           5.     The Court has personal jurisdiction over Defendant because it has  
2 systematically and continuously engaged in substantial business activities in and  
3 directed to California. Defendant therefore knew or should have known that its  
4 activities were directed towards California, and the effect of those activities would  
5 be felt in California.  
6

7  
8           6.     The exercise of personal jurisdiction over Defendant is also proper  
9 since its conduct is expressly aimed at California, through sale of electronic  
10 cigarette products in California and through operation of a website selling  
11 electronic cigarette products in California, bearing the marks at issue in this  
12 Complaint.  
13

14  
15           7.     Additionally, the Court has personal jurisdiction over Defendant  
16 because it has purposefully availed itself of the opportunity to conduct commercial  
17 activities in this forum. Defendant is registered as a foreign corporation doing  
18 business in California. This Complaint arises out of those commercial activities.  
19

20           8.     Venue is proper in this district under 28 U.S.C. § 1391 (b) and (c) in  
21 that substantial injury occurred and continues to occur in this district, a substantial  
22 portion of the events that are the subject of this action took place in this district,  
23 and that Defendant is subject to personal jurisdiction within this district.  
24  
25  
26  
27  
28

## INTRODUCTION

9. This case consists of straightforward claims seeking a declaration that Starbuzz's use of the mark "BLUE MIST" for electronic cigarettes does not infringe upon Defendant's trademark rights, and does not dilute Defendant's trademarks.

10. Defendant has accused Starbuzz of trademark infringement and dilution under the Lanham Act, 15 U.S.C. § 1051, *et seq.*

11. Defendant further demanded that Starbuzz cease and desist from using its BLUE MIST mark for electronic cigarettes, abandon the application to register its BLUE MIST mark for electronic cigarettes, and enter into settlement with Defendant regarding the matter.

12. By this Complaint, Starbuzz seeks declaratory judgment that Starbuzz's BLUE MIST mark has priority over Defendant's BLU marks, and that there is no likelihood of confusion between Starbuzz's mark and Defendant's marks when used in connection with electronic cigarettes.

13. Starbuzz further seeks declaratory judgment that Starbuzz's use of the BLUE MIST mark does not dilute Defendant's marks.

//

//

//

## FACTS

### Starbuzz's Ownership the BLUE MIST mark

14. Starbuzz is recognized worldwide as a manufacturer and supplier of premium hookah tobacco and other related products. As such, Starbuzz has obtained over 90 federally registered trademarks in the United States and has sought to obtain worldwide intellectual property protection in more than 33 countries.

15. Starbuzz is the owner of the federally registered trademark BLUE MIST (Reg. No. 3,619,407) for "Pipe Tobacco; Molasses Tobacco; Tobacco; Smoking Tobacco; Flavored Tobacco; and Herbal Molasses," in International Class 034 (the "BLUE MIST Mark"). A true and correct copy of the registration certificate is attached hereto as Exhibit A.

16. Starbuzz has been using the BLUE MIST Mark in commerce since December 1, 2006.

17. At all times relevant herein, Starbuzz has been, and still is, the owner of the exclusive rights, title, and interest in the BLUE MIST Mark for tobacco and related products.

### Starbuzz's Continuous Use of the BLUE MIST Mark

18. Starbuzz manufactures, distributes, imports, and sells tobacco and related products throughout the United States and internationally. Starbuzz prides

1 itself on its reputation for high-quality tobacco and related products. Starbuzz's  
2 continued goal is to develop new and popular tobacco and related products while  
3 preserving the quality of its products and brand identity.  
4

5 19. Starbuzz sells its tobacco and related products to thousands of  
6 customers and clients, including boutique stores, wholesalers, and suppliers.  
7  
8 Starbuzz has used, created and marketed the BLUE MIST Mark continuously over  
9 the years. The BLUE MIST Mark has brought Starbuzz enormous success, and  
10 Starbuzz is now known for its high quality products.  
11

12 20. Starbuzz uses the BLUE MIST Mark on advertising brochures,  
13 advertising leaflets, on the Internet, and on the packaging of its tobacco and related  
14 products.  
15

16 21. Starbuzz's intellectual property and brand identity have substantial  
17 image recognition.  
18

19 22. The BLUE MIST Mark is important as it serves as an easily-  
20 recognizable identifiers of the high quality goods that Starbuzz offers. There is a  
21 particularly close association among consumers between Starbuzz, the BLUE  
22 MIST Mark, and the quality of the tobacco and related products offered under the  
23 BLUE MIST Mark. For consumers, customers, vendors, and clients, the BLUE  
24 MIST Mark is associated with original, flavorful, and smooth tobacco and related  
25 products, which are of the highest quality at an affordable price.  
26  
27  
28

1           23.   Starbuzz's rights to the BLUE MIST Mark are not limited to tobacco  
2 products, but extend to related products within the same industry and market, or  
3 within the natural zone of expansion.  
4

5           24.   Starbuzz, therefore, expanded its use of the BLUE MIST Mark to  
6 related products, including electronic cigarettes.  
7

8           25.   On December 28, 2012, Starbuzz applied to register "BLUE MIST"  
9 for electronic cigarettes (Serial No. 85/812,403) on the USPTO's Principal  
10 Register (the "Application"). Starbuzz claimed its prior registration of the BLUE  
11 MIST Mark in the Application. A true and correct copy of the Application is  
12 attached hereto as **Exhibit B**.  
13  
14

15 **Defendant's Ownership of the BLU Marks**

16           26.   Starbuzz is informed and believes, and on that basis alleges, that in or  
17 about April 2012, Lorillard, Inc. ("Lorillard"), the parent company of Defendant,  
18 acquired all of the assets of Blec, LLC ("Blec"). This included certain marks  
19 owned by Blec.  
20  
21

22           27.   Starbuzz is informed and believes, and on that basis alleges, that on  
23 March 17, 2009, Blec, applied to register the mark "BLU ECIGS" for "Cigarettes  
24 containing tobacco substitutes not for medical purposes; Electronic cigarettes for  
25 use as an alternative to traditional cigarettes; Smokeless cigarette vaporizer pipe;  
26 and Tobacco substitutes," in International Class 034.  
27  
28



1           28.   Blec claimed that “BLU ECIGS” has been in use in commerce since  
2 May 1, 2009.

3           29.   On June 8, 2009, the USPTO refused registration of “BLU ECIGS”  
4 on the grounds that it was likely to be confused with a prior pending application for  
5 “BLUEMOON” for “Cigarettes containing tobacco substitutes not for medical  
6 purposes; Pipe tobacco; Smokeless tobacco; Tobacco filters; Tobacco pipes;  
7 Tobacco substitute; Tobacco substitutes; Tobacco substitutes not for medical  
8 purposes; Tobacco, cigars and cigarettes” in Class 034.  
9

10           30.   In response, on December 3, 2009, Blec argued to the USPTO that  
11 there was no likelihood of confusion because purchasers of electronic cigarettes  
12 were sophisticated, and “a quick search of the Trademark database reveals 85 live  
13 and dead marks under class 034 which include “BLUE” within the mark. Looking  
14 even closer, there are currently 35 marks currently registered under international  
15 class 034 which contain “BLUE” within the mark. Attached to this response are  
16 copies from the Trademark Office of registrations under class 034 for “RICH  
17 BLUE,” “WIND BLUE,” “BLUE LAGOON CIGARETTES,” “BLUE MIST,”  
18 “MENTHOL BLUE,” “BLUE NOTE,” and “BLUE SMOKE CIGAR.””  
19

20           31.   On September 7, 2010, the “BLU ECIGS” mark was registered on the  
21 USPTO Principal Register (Registration No. 3,846,035). A true and correct copy  
22 of the trademark registration is attached hereto as **Exhibit C**.  
23  
24  
25  
26  
27  
28

32. In 2010, Blec also filed applications to register the following trademarks for electronic cigarettes and related products in International Class 034:

Trademark	Application No.	Register	First Use At Least As Early As	Exhibit
BLU	85/131,287	Principal	May 1, 2009	<u><b>D</b></u>
BLU (design mark)	85/131,965	Principal	May 1, 2009	<u><b>E</b></u>
BLU CIGS	85/092,665	Principal	May 1, 2009	<u><b>F</b></u>

33. The BLU CIGS (Serial No. 85/092,665), BLU (design mark) (Serial No. 85/092,665) and BLU (85/131,287) marks were initially denied registration based upon a likelihood of confusion with various trademarks with BLU for goods in Class 034.

34. In responding to the initial refusals to register, Blec again represented that the consumers of electronic cigarettes were sophisticated, and there were numerous third party users of the term "BLUE" in Class 034.

35. The BLU ECIGS, BLU, BLU, and BLU CIGS are collectively referred to as the "BLU Marks."

36. Starbuzz is informed and believes, and on that basis alleges, that Blec was using the BLU Marks with respect to its BLU brand of electronic cigarette products.

37. On or about May 29, 2012, in conjunction with the sale of its assets to Lorillard, Blec assigned its entire right, title and interest in and to the BLU Marks

1 to Lorillard Technology, Inc. ("LTI"), an intellectual property holding company  
2 that is the subsidiary of Defendant.

3 38. Starbuzz is informed and believes, and on that basis alleges, that as a  
4 holding company, LTI licenses the BLU Marks to Defendant and its affiliates.  
5

6 39. Starbuzz is informed and believes, and on that basis alleges, that  
7 Defendant currently uses the BLU Marks to promote and sell the BLU brand of  
8 electronic cigarette products.  
9

10  
11 **Starbuzz's Priority to the BLUE MIST Mark**

12 40. Starbuzz is informed and believes, and on that basis alleges, that the  
13 date of first use of the BLUE MIST Mark in commerce predates the date of first  
14 use of the BLU Marks in commerce. Therefore, Starbuzz's rights to use BLUE  
15 MIST on tobacco and related products have priority over any rights claimed by  
16 Defendants in their BLU Marks.  
17

18  
19 **Meaning of the BLU Marks and Third Party Use**

20 41. The BLU Marks contain the term "BLU", which refers to the color  
21 blue and describes the blue LED light feature in Defendant's electronic cigarette  
22 products.  
23

24 42. The term "BLU" is weak because (a) it is descriptive of a feature of  
25 Defendant's electronic cigarette products; and (b) there are numerous third party  
26 users of the term "BLU" or "BLUE" for tobacco products.  
27  
28

1           43. Starbuzz is informed and believes, and on that basis alleges, that there  
2 are approximately thirty-nine (39) live registered marks containing the terms  
3 “BLU” or “BLUE” in Class 034, in addition to approximately twenty-three (23)  
4 live applications to register marks with “BLU” or “BLUE” in Class 034.  
5

6           44. Since the terms “BLU” or “BLUE” are weak due to descriptiveness  
7 and extensive third party use for similar goods, Defendant does not have exclusive  
8 rights to those terms for electronic cigarettes.  
9

10 **No Likelihood of Confusion between BLUE MIST and the BLU Marks**  
11

12           45. The only similarity between BLUE MIST and the BLU Marks is the  
13 weak and descriptive term “BLU”.  
14

15           46. The addition of the term “MIST” in Starbuzz’s mark changes the  
16 appearance, pronunciation, and meaning of the mark such that likelihood of  
17 confusion is avoided.  
18

19           47. There is also no similarity between BLUE MIST and the BLU Marks  
20 as used in the marketplace.  
21

22           48. The label for the products bearing the BLUE MIST mark is  
23 completely different from the label of the products bearing the BLU Marks. True  
24 and correct copies of pictures of Starbuzz’s and Defendant’s products are attached  
25 hereto as **Exhibit G**.  
26  
27  
28

1           49. The fonts, colors, background, arrangement, and pictures associated  
2 with the "BLUE MIST" mark bears no similarity to the font, colors, background,  
3 arrangement and picturing of labels associated with the BLU Marks. Additionally,  
4 "BLUE MIST" is accompanied by the Starbuzz's name and logo, thereby avoiding  
5 any likelihood of confusion.  
6

7  
8           50. Because no likelihood of confusion exists between "BLUE MIST"  
9 and the BLU Marks, Starbuzz has not infringed upon the BLU Marks.  
10

11 **No Dilution of the BLU Marks**

12           51. Starbuzz is informed and believes, and on that basis alleges, that the  
13 BLU Marks are not widely recognized by the general consuming public.  
14

15           52. Starbuzz is further informed and believes, and on that basis alleges,  
16 that Starbuzz's use of "BLUE MIST" does not weaken the BLU Marks since the  
17 term "BLU" is already weak due to descriptiveness and substantial third party use.  
18

19           53. Starbuzz is also informed and believes, and on that basis alleges, that  
20 there is no tarnishment of the BLU Marks because Starbuzz is not using "BLUE  
21 MIST" inappropriately or in an unflattering manner. Starbuzz is using "BLUE  
22 MIST" on tobacco and other related products, including electronic cigarettes.  
23

24  
25           54. Therefore, there is no trademark dilution based upon Starbuzz's use of  
26 the "BLUE MIST" mark on its products.  
27  
28

1 **Defendant's Wrongful Demands**

2 55. On or about February 4, 2013, Starbuzz received a cease and desist  
3 letter from Lorillard, who was writing on behalf of its subsidiaries and affiliates,  
4 including Defendant. In the letter, Lorillard on behalf of Defendant claimed  
5 ownership of the BLU Marks and demanded that Starbuzz cease and desist from all  
6 use of "BLUE MIST", file an express abandonment of the Application, and enter  
7 into a settlement agreement with Defendant to resolve the matter. A true and  
8 correct copy of the February 4, 2013 letter is attached hereto as **Exhibit H**.  
9

10  
11  
12 56. In the February 4th letter, Lorillard, on behalf of Defendant, further  
13 accused Starbuzz of trademark infringement and dilution of the BLU Marks. In  
14 particular, the letter stated that "Starbuzz's use of the Infringing Mark in  
15 connection with the marketing and sale of electronic cigarettes is likely to cause  
16 confusion, or to cause mistake, or to deceive as to the affiliation, connection, or  
17 association between Starbuzz and Lorillard, and/or is likely to cause confusion,  
18 mistake, or deception as to the origin, sponsorship, or approval of the goods or  
19 services purveyed by Starbuzz, and Lorillard's goods, services, and commercial  
20 activities."  
21  
22  
23  
24

25 57. Lorillard, on behalf of Defendant, further stated that "Lorillard makes  
26 these demands without prejudice to any other remedies available to it under the  
27  
28

1 law, including its rights to actual damages, statutory damages, treble damages,  
2 Starbuzz's wrongfully-derived profits and attorneys' fees."

3  
4 58. On February 15, 2013, Starbuzz responded to the February 4th letter  
5 by claiming that there is no likelihood of confusion between the parties' respective  
6 marks.

7  
8 59. In response, on March 1, 2013, Lorillard rejected Starbuzz's  
9 arguments and once again demanded that Starbuzz cease and desist from all use of  
10 "BLUE MIST", file an express abandonment of the Application, and enter into a  
11 settlement agreement with Defendant to resolve the matter.

12  
13 60. Through the February 4th and March 1st letters, Lorillard, on behalf  
14 of Defendant, has placed Starbuzz in reasonable apprehension that it will sue  
15 Starbuzz if the parties' rights are not clarified since Lorillard, on behalf of  
16 Defendant:

17  
18 (a) Articulated its position that Starbuzz is infringing and diluting its rights  
19 to the BLU Marks;

20  
21 (b) Specifically described the steps Lorillard has taken against other parties,  
22 including successful litigation of infringement claims in a specific forum of their  
23 choice, thereby obtaining equitable relief and damages; and

24  
25 (c) Indicated its intent to pursue other remedies under the law.

1           61. Based upon the cease and desist letters, and since Starbuzz is making  
2 bona fide use of the "BLUE MIST" mark in connection with its tobacco and  
3 electronic cigarette products, there is an actual controversy as to whether Plaintiff's  
4 use of the "BLUE MIST" mark infringes upon and dilutes Defendant's BLU  
5 Marks.  
6

7  
8           62. By this Complaint, Starbuzz seeks declaratory relief from this Court  
9 to clarify its rights to the "BLUE MIST" mark and Defendant's rights in the BLU  
10 Marks.  
11

12           63. By this Complaint, Starbuzz also seeks declaratory relief from this  
13 Court that Starbuzz's use of the "BLUE MIST" mark in connection with electronic  
14 cigarettes does not infringe upon and dilute Defendant's BLU Marks.  
15

16           64. Starbuzz's Application for BLUE MIST for electronic cigarettes has  
17 not yet been approved for publication by the USPTO. In the event that the  
18 Application is published for opposition and Defendant, its parent company  
19 Lorillard, or its subsidiary holding company LTI, files an opposition with the  
20 Trademark Trial and Appeal Board, Starbuzz further seeks an order from this Court  
21 allowing Starbuzz leave to amend this pleading in order to have this Court direct  
22 the USPTO to dismiss that opposition and register the BLUE MIST mark for  
23 electronic cigarettes on the USPTO principal register.  
24

25  
26  
27  
28 //



**FIRST CLAIM FOR RELIEF**  
**[Declaratory Judgment for Non-Infringement of Trademarks]**  
**(Against Defendant)**

65. Starbuzz re-alleges and incorporates by this reference paragraphs 1 through 64, inclusive, of this Complaint as if fully set forth herein.

66. Based upon Defendant's use of the BLU Marks and Starbuzz's use of BLUE MIST for electronic cigarettes, an actual controversy has arisen and now exists between Starbuzz and Defendant concerning their respective trademark rights. This controversy is of sufficient immediacy to warrant a declaratory judgment.

67. Specifically, Defendant has accused Starbuzz that its use of BLUE MIST on electronic cigarettes infringes upon Defendant's rights to its BLU Marks.

68. Starbuzz asserts that there is no likelihood of confusion between "BLUE MIST" and the BLU Marks, based on the fact that: (a) Starbuzz's use of the BLUE MIST Mark for tobacco and related products have priority over Defendant's use of the BLU Marks; (b) Defendant's BLU Marks are weak and merely descriptive; and (c) there is no similarity in appearance, pronunciation and meaning between the marks.

69. A judicial determination is essential at this time with respect to the parties' rights to their marks.

1           70. Starbuzz therefore seeks a declaration from this Court that its use of  
2 “BLUE MIST” on electronic cigarettes does not infringe upon the BLU Marks  
3 because consumers are not likely to be confused as to the source of Starbuzz’s  
4 goods and Defendant’s goods.  
5

6                           **SECOND CLAIM FOR RELIEF**  
7                           **[Declaratory Judgment for Non-Dilution of Trademarks]**  
8                           **(Against Defendant)**

9           71. Starbuzz re-alleges and incorporates by this reference paragraphs 1  
10 through 70, inclusive, of this Complaint as if fully set forth herein.  
11

12           72. Based upon the cease and desist letters sent to Starbuzz, an actual  
13 controversy has arise and now exists between Starbuzz and Defendant regarding  
14 Starbuzz’s use of BLUE MIST for electronic cigarettes. The controversy is of  
15 sufficient immediacy to warrant a declaratory judgment.  
16  
17

18           73. Specifically, Lorillard, on behalf of Defendant, has alleged that  
19 Starbuzz’s use of BLUE MIST has diluted Defendant’s BLU Marks.  
20

21           74. Starbuzz asserts that there is no dilution, based on the fact that: (1)  
22 the BLU Marks are not famous marks; (2) there is no likelihood of confusion  
23 between “BLUE MIST” and Defendant’s BLU Marks; and (3) Starbuzz has not  
24 weakened or tarnished the BLU Marks.  
25

26           75. A judicial determination is essential at this time with respect to the  
27 parties’ rights to their marks.  
28

1           76. Starbuzz therefore seeks a declaration from this Court that its use of  
2 BLUE MIST has not diluted Defendant's BLU Marks because the BLU Marks are  
3 not famous, consumers are not likely to be confused as to the source of Starbuzz's  
4 goods and Defendant's goods, and there was no weakening or tarnishment of the  
5 BLU Marks through Starbuzz's use of "BLUE MIST" on its products.  
6

7  
8                                   **PRAYER FOR RELIEF**

9           WHEREFORE, Starbuzz respectfully prays for judgment against Defendant  
10 as follows:  
11

12           1. An order declaring that Starbuzz has priority to its BLUE MIST Mark  
13 for tobacco and related products over Defendant's BLU Marks for electronic  
14 cigarettes;  
15

16           2. An order declaring that Starbuzz's "BLUE MIST" mark is not  
17 confusingly similar to Defendant's BLU Marks;  
18

19           3. An order declaring that Starbuzz's use of "BLUE MIST" mark on  
20 electronic cigarettes does not infringe upon Defendant's BLU Marks;  
21

22           4. An order declaring that Starbuzz's use of the "BLUE MIST" mark on  
23 electronic cigarettes does not dilute Defendant's BLU Marks;  
24

25           5. In the event that Defendant, its parent company Lorillard, or its  
26 subsidiary holding company LTI, file an Opposition proceeding with the USPTO  
27 against the Application, an order declaring that the USPTO dismiss the Opposition  
28

1 proceeding and approve the Application to register BLUE MIST (Serial No.  
2 85/812,403) with respect to electronic cigarettes;

3  
4 6. An order for an award of attorneys' fees and costs of this action, in an  
5 amount to be determined at trial, pursuant to applicable federal law;

6  
7 7. Such additional and further relief as may follow from the entry of a  
8 declaratory judgment; and

9  
10 8. Any other and further relief as the Court deems appropriate, proper  
11 and just.

12 DATED: October 9, 2013

Respectfully Submitted,  
**THE PATEL LAW FIRM, P.C.**

14  
15 

16 Natu J. Patel,  
17 Attorneys for Plaintiff  
18 Starbuzz Tobacco, Inc.  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

**DEMAND FOR TRIAL BY JURY**

Plaintiff Starbuzz Tobacco, Inc. hereby demands a trial by jury on all issues raised in the Complaint.

DATED: October 9, 2013

Respectfully Submitted,  
**THE PATEL LAW FIRM, P.C.**



Natu J. Patel,  
Attorneys for Plaintiff  
Starbuzz Tobacco, Inc.

## **Exhibit A**

Int. Cl.: 34

Prior U.S. Cls.: 2, 8, 9 and 17

Reg. No. 3,619,407

**United States Patent and Trademark Office**

Registered May 12, 2009

**TRADEMARK  
PRINCIPAL REGISTER**

**Blue Mist**

STARBUZZ TOBACCO, INC. (CALIFORNIA CORPORATION)  
UNIT #A  
1889 W. COMMONWEALTH STREET  
FULLERTON, CA 92833

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

FOR: PIPE TOBACCO, TOBACCO, SMOKING TOBACCO, FLAVORED TOBACCO, MOLASSES TOBACCO, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

SER. NO. 77-619,104, FILED 11-20-2008.

FIRST USE 12-1-2006; IN COMMERCE 12-1-2006.

REGINA DRUMMOND, EXAMINING ATTORNEY

## **Exhibit B**



PTO Form 1478 (Rev 9/2006)  
OMB No. 0651-0009 (Exp 12/31/2014)

## Trademark/Service Mark Application, Principal Register

Serial Number: 85812403

Filing Date: 12/28/2012

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	85812403
<b>MARK INFORMATION</b>	
*MARK	<u>BLUE MIST</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	BLUE MIST
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font, style, size, or color.
REGISTER	Principal
<b>APPLICANT INFORMATION</b>	
*OWNER OF MARK	Starbuzz Tobacco, Inc.
*STREET	10630 Fern Avenue
*CITY	Stanton
*STATE (Required for U.S. applicants)	California
*COUNTRY	United States
*ZIP/POSTAL CODE (Required for U.S. applicants only)	90680
<b>LEGAL ENTITY INFORMATION</b>	
TYPE	corporation



<b>STATE/COUNTRY OF INCORPORATION</b>	California
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	
<b>INTERNATIONAL CLASS</b>	034
<b>* IDENTIFICATION</b>	ELECTRONIC CIGARETTES
<b>FILING BASIS</b>	SECTION 1(a)
<b>FIRST USE ANYWHERE DATE</b>	At least as early as 08/22/2012
<b>FIRST USE IN COMMERCE DATE</b>	At least as early as 08/22/2012
<b>SPECIMEN FILE NAME(S)</b>	
<b>ORIGINAL PDF FILE</b>	<u>SPE0-6910813976-193038884 . Blue Mist specimen.pdf</u>
<b>CONVERTED PDF FILE(S) (1 page)</b>	<u>\\TICRS\EXPORT16\IMAGEOUT16\858\124\85812403\xml1\APP0003.JPG</u>
<b>SPECIMEN DESCRIPTION</b>	Product specimen showing the mark as used in commerce.
<b>ADDITIONAL STATEMENTS SECTION</b>	
<b>PRIOR REGISTRATION(S)</b>	The applicant claims ownership of U.S. Registration Number(s) 3619407.
<b>ATTORNEY INFORMATION</b>	
<b>NAME</b>	Natu J. Patel
<b>ATTORNEY DOCKET NUMBER</b>	S015-4160
<b>FIRM NAME</b>	The Patel Law Firm, P.C.
<b>STREET</b>	2532 Dupont Drive
<b>CITY</b>	Irvine
<b>STATE</b>	California
<b>COUNTRY</b>	United States
<b>ZIP/POSTAL CODE</b>	92612
<b>PHONE</b>	949-955-1077
<b>FAX</b>	949-955-1877



EMAIL ADDRESS	NPatel@thePatelLawFirm.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>CORRESPONDENCE INFORMATION</b>	
NAME	Natu J. Patel
FIRM NAME	The Patel Law Firm, P.C.
STREET	2532 Dupont Drive
CITY	Irvine
STATE	California
COUNTRY	United States
ZIP/POSTAL CODE	92612
PHONE	949-955-1077
FAX	949-955-1877
EMAIL ADDRESS	NPatel@thePatelLawFirm.com
AUTHORIZED TO COMMUNICATE VIA EMAIL	Yes
<b>FEE INFORMATION</b>	
NUMBER OF CLASSES	1
FEE PER CLASS	325
*TOTAL FEE DUE	325
*TOTAL FEE PAID	325
<b>SIGNATURE INFORMATION</b>	
SIGNATURE	/waelhalwani/
SIGNATORY'S NAME	Wael Salim Elhalwani
SIGNATORY'S POSITION	Chief Executive Officer
DATE SIGNED	12/28/2012

Natu J. Patel  
The Patel Law Firm, P.C.  
2532 Dupont Drive  
Irvine, California 92612  
949-955-1077(phone)  
949-955-1877(fax)  
NPatel@thePatelLawFirm.com (authorized)

A fee payment in the amount of \$325 has been submitted with the application, representing payment for 1 class(es).

#### **Declaration**

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

#### **Declaration Signature**

Signature: /waelelhalwani/ Date: 12/28/2012  
Signatory's Name: Wael Salim Elhalwani  
Signatory's Position: Chief Executive Officer  
RAM Sale Number: 5975  
RAM Accounting Date: 12/31/2012

Serial Number: 85812403  
Internet Transmission Date: Fri Dec 28 19:42:06 EST 2012  
TEAS Stamp: USPTO/BAS-69.108.139.76-2012122819420628  
4492-85812403-49013c13e8e136fbc696ffb4b8  
d327e155-CC-5975-20121228193038884338

PTO Form 1478 (Rev 9/2006)  
OMB No. 0651-0009 (Exp 12/31/2014)

## **Trademark/Service Mark Application, Principal Register**

**Serial Number: 85812403**

**Filing Date: 12/28/2012**

### **To the Commissioner for Trademarks:**

**MARK:** BLUE MIST (Standard Characters, see mark)

The literal element of the mark consists of BLUE MIST.

The mark consists of standard characters, without claim to any particular font, style, size, or color.

The applicant, Starbuzz Tobacco, Inc., a corporation of California, having an address of  
10630 Fern Avenue  
Stanton, California 90680  
United States

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

International Class 034: ELECTRONIC CIGARETTES

In International Class 034, the mark was first used by the applicant or the applicant's related company or licensee or predecessor in interest at least as early as 08/22/2012, and first used in commerce at least as early as 08/22/2012, and is now in use in such commerce. The applicant is submitting one(or more) specimen(s) showing the mark as used in commerce on or in connection with any item in the class of listed goods and/or services, consisting of a(n) Product specimen showing the mark as used in commerce..

#### **Original PDF file:**

SPE0-6910813976-193038884 . Blue Mist specimen.pdf

#### **Converted PDF file(s) (1 page)**

Specimen File1

The applicant claims ownership of U.S. Registration Number(s) 3619407.

#### **The applicant's current Attorney Information:**

Natu J. Patel of The Patel Law Firm, P.C.  
2532 Dupont Drive  
Irvine, California 92612  
United States

The attorney docket/reference number is S015-4160.

#### **The applicant's current Correspondence Information:**

# BLUE MIST



## **Exhibit C**



# United States of America

United States Patent and Trademark Office

## BLU ECIGS

**Reg. No. 3,846,035**

**Registered Sep. 7, 2010**

**Int. Cl.: 34**

**TRADEMARK**

**PRINCIPAL REGISTER**

BLEC, LLC (NEVADA LIMITED LIABILITY COMPANY)  
500 ARCHDALE DRIVE  
CHARLOTTE, NC 28217

FOR: CIGARETTES CONTAINING TOBACCO SUBSTITUTES NOT FOR MEDICAL PURPOSES; ELECTRONIC CIGARETTES FOR USE AS AN ALTERNATIVE TO TRADITIONAL CIGARETTES; SMOKELESS CIGARETTE VAPORIZER PIPE; TOBACCO SUBSTITUTES, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

FIRST USE 5-1-2009; IN COMMERCE 5-1-2009.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ECIGS", APART FROM THE MARK AS SHOWN.

SN 77-692,962, FILED 3-17-2009.

MARK SHINER, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office

## **Exhibit D**



United States Patent and Trademark Office

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### Record 1 out of 1

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BLU

**Word Mark** BLU

**Goods and Services** IC 034. US 002 008 009 017. G & S: Electronic cigarettes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters. FIRST USE: 20090501. FIRST USE IN COMMERCE: 20090501

**Standard Characters Claimed**

**Mark Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 85131287

**Filing Date** September 16, 2010

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** November 8, 2011

**Owner** (APPLICANT) BLEC, LLC LIMITED LIABILITY COMPANY NEVADA 401 N Tryon Street, Suite 1080 Charlotte NORTH CAROLINA 28202

**Assignment Recorded** ASSIGNMENT RECORDED

3/7/13

Trademark Electronic Search System (TESS)

**Attorney of  
Record** Blake E. Vande Garde

**Prior  
Registrations** 3846035

**Type of Mark** TRADEMARK

**Register** PRINCIPAL-2(F)

**Live/Dead  
Indicator** LIVE

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## **Exhibit E**



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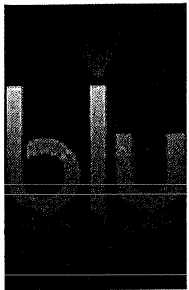
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## Record 1 out of 1

[TSDR](#) [ASSIGN Status](#) [TTAB Status](#) ( Use the "Back" button of the Internet Browser to return to TESS)



**Word Mark** BLU  
**Goods and Services** IC 034. US 002 008 009 017. G & S: Electronic cigarettes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters. FIRST USE: 20090501. FIRST USE IN COMMERCE: 20090501  
**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS  
**Design Search Code** 01.15.25 - Coal; Dust; Light rays; Liquids, spilling; Pouring liquids; Sand; Spilling liquids  
10.01.02 - Cigarettes; Holders, cigarette and cigar  
26.05.21 - Triangles that are completely or partially shaded  
26.11.21 - Rectangles that are completely or partially shaded  
**Serial Number** 85131965  
**Filing Date** September 17, 2010  
**Current Basis** 1A  
**Original Filing Basis** 1A  
**Published for Opposition** November 29, 2011  
**International Registration Number** 1058275  
**Owner** (APPLICANT) BLEC, LLC LIMITED LIABILITY COMPANY NEVADA 401 N Tryon Street, Suite 1080 Charlotte NORTH CAROLINA 28202

3/7/13

Trademark Electronic Search System (TESS)

**Assignment  
Recorded** ASSIGNMENT RECORDED

**Attorney of  
Record** Blake E. Vande Garde

**Prior  
Registrations** 3846035

**Description of  
Mark** The color(s) blue, black, gray and white is/are claimed as a feature of the mark. The mark consists of the word "BLU" in stylized font whereby the letter "L" resembles a cigarette with blue light rays emitting therefrom that gradually become black towards the top and all letters appear in the color gray that gradually become white towards the top above a stylized partial reflection of the same all against a black field.

**Type of Mark** TRADEMARK

**Register** PRINCIPAL-2(F)-IN PART

**Live/Dead  
Indicator** LIVE

**Distinctiveness**

**Limitation** as to "BLU"

**Statement**

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## **Exhibit F**



3/7/13

Trademark Electronic Search System (TESS)



United States Patent and Trademark Office

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TESS was last updated on Thu Mar 7 05:03:18 EST 2013

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**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*( Use the "Back" button of the Internet Browser to return to TESS)***BLU CIGS****Word Mark** BLU CIGS**Goods and Services** IC 034. US 002 008 009 017. G & S: Electronic cigarettes containing tobacco substitutes not for medical purposes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters. FIRST USE: 20090501. FIRST USE IN COMMERCE: 20090501**Standard Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 85092665**Filing Date** July 26, 2010**Current Basis** 1A**Original Filing Basis** 1A**Published for** November 8, 2011**Opposition****International Registration Number** 1051607

**Owner** (APPLICANT) BLEC, LLC LIMITED LIABILITY COMPANY NEVADA 401 N Tryon Street, Suite 1080  
Charlotte NORTH CAROLINA 28202

**Assignment  
Recorded** ASSIGNMENT RECORDED

**Attorney of  
Record** Blake E. Vande Garde

**Prior  
Registrations** 3846035

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CIGS" APART FROM THE MARK AS  
SHOWN

**Type of Mark** TRADEMARK

**Register** PRINCIPAL-2(F)

**Live/Dead  
Indicator** LIVE

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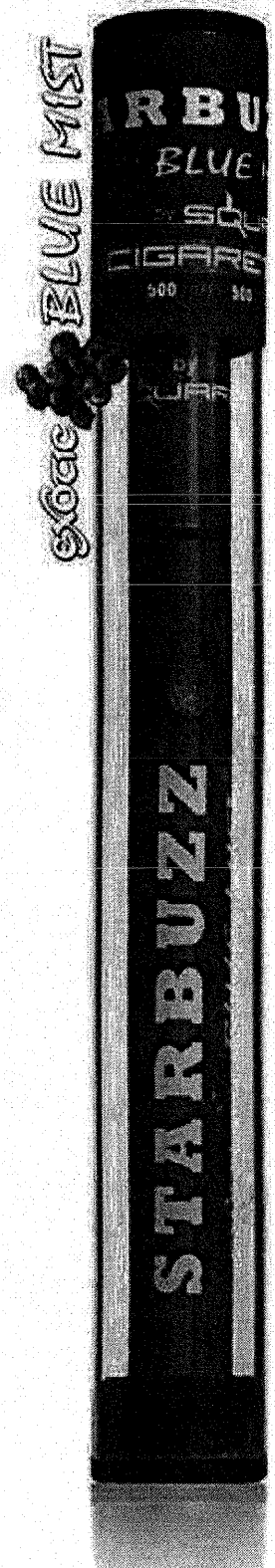
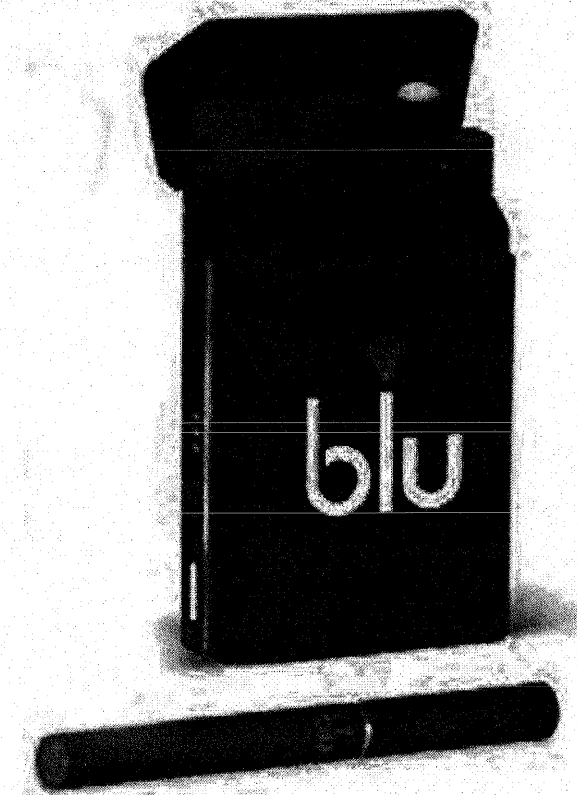
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## **Exhibit G**



## **Exhibit H**

McGuireWoods LLP  
77 West Wacker Drive  
Suite 4100  
Chicago, IL 60601-1818  
Phone: 312.849.8100  
Fax: 312.849.3690  
www.mcguirewoods.com

GEORGE R. SPATZ  
Direct: 312.321.7676

McGUIREWOODS

gspatz@mcguirewoods.com  
Direct Fax: 312.698.4584

February 4, 2013

**BY FEDEX AND E-MAIL**

Starbuzz Tobacco, Inc.  
c/o Natu J. Patel  
THE PATEL LAW FIRM, P.C.  
2532 Dupont Drive  
Irvine, CA 92612  
[NPatel@thePatelLawFirm.com](mailto:NPatel@thePatelLawFirm.com)

**Re: Starbuzz Tobacco, Inc.'s Infringing Use of and Application to  
Register the BLUE MIST Mark (U.S. Ser. No. 85/812,403)**

Dear Mr. Patel:

This firm represents Lorillard, Inc. and its subsidiaries and affiliates (collectively "Lorillard") in intellectual property matters. Lorillard is the nation's third largest tobacco company and manufactures and sells top quality branded cigarettes and electronic cigarettes, including the famous NEWPORT brand of cigarettes and BLU brand of electronic cigarettes.

Lorillard's electronic cigarettes are sold under the BLU ECIGS®, BLU CIGS™, BLU™, and BLU & Design trademarks (collectively the "BLU Family of Marks"). The BLU Family of Marks distinguish BLU brand electronic cigarettes from other electronic cigarettes and are well-known and instantly recognizable by consumers.

Lorillard has invested substantial time, effort and money in developing the goodwill associated with the BLU Family of Marks. For example, BLU was the first brand of electronic cigarette to sponsor a top 35 car in the NASCAR® Sprint Cup Series. Products featuring the BLU Family of Marks have been given out in gift bags at major events including the Oscars, American Music Awards, and Grammy awards. BLU is featured in national print and television advertising, including but not limited to commercials by its celebrity spokesperson, Stephen Dorff. BLU electronic cigarettes are sold at thousands of retail locations throughout the United States and via the Internet. Due to the extensive distribution and promotion of BLU electronic cigarettes, the BLU Family of Marks are well-known throughout the United States and among the consuming public.

Natu J. Patel  
February 4, 2013  
Page 2

Lorillard actively protects the investment it has made in its BLU Family of Marks. Lorillard has secured a federal registration for its BLU ECIGS mark with the United States Patent and Trademark Office (the "Trademark Office") in connection with "cigarettes containing tobacco substitutes not for medical purposes, electronic cigarettes for use as an alternative to traditional cigarettes, smokeless cigarette vaporizer pipe, and tobacco substitutes" (U.S. Reg. No. 3,846,035). The other marks in the BLU Family of Marks are currently the subject of pending applications before the Trademark Office. Lorillard further monitors the electronic cigarette market to prevent infringing products from damaging the substantial reputation it has built under the BLU Family of Marks.

We have recently learned that Starbuzz Tobacco, Inc. ("Starbuzz") is selling, offering for sale, advertising and/or distributing electronic cigarettes under the mark BLUE MIST (the "Infringing Mark") and has applied to register the Infringing Mark with the Trademark Office in connection with electronic cigarettes (U.S. Ser. No. 85/812,403). A screenshot of the infringing product is enclosed herewith.

Starbuzz's use of the Infringing Mark in connection with the marketing and sale of electronic cigarettes is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association between Starbuzz and Lorillard, and/or is likely to cause confusion, mistake, or deception as to the origin, sponsorship, or approval of the goods or services purveyed by Starbuzz, and Lorillard's goods, services, and commercial activities. As such, Starbuzz's unauthorized marketing and sale of electronic cigarettes under the Infringing Mark violates Lorillard's exclusive rights in its BLU Family of Marks and constitutes, at the very least, trademark infringement and dilution under the Lanham Act, 15 U.S.C. § 1051, *et seq.*

Lorillard intends to vigorously protect its valuable rights in its BLU Family of Marks to the fullest extent possible. When necessary, Lorillard has pursued formal action to protect its rights. For example, in a case very similar to the instant matter, Lorillard pursued and won a consent judgment in the United States District Court for the Western District of North Carolina, Case No. 3:12-cv-00223, against a company selling electronic cigarettes under the infringing AMERICAN BLUE TIP mark. In that matter, the court determined that Lorillard is the sole and exclusive owner of the BLU Family of Marks and has the right to sue upon, and recover damages for past infringement, and enjoin future infringement of the BLU Family of Marks. The court determined that the BLU Family of Marks are valid and enforceable and permanently enjoined the infringer from using the AMERICAN BLUE TIP mark and/or any other confusingly similar mark or device in the sale, offering for sale, distribution or advertising of electronic cigarettes or similar merchandise at any locality in the United States. Lorillard is confident that it will achieve a similar result in any action to enjoin the use of the BLUE MIST mark in connection with the sale, offering for sale, advertising and/or distribution of electronic cigarettes.

Natu J. Patel  
February 4, 2013  
Page 3

In light of the above, we demand that Starbuzz immediately: 1) cease all use of the Infringing Mark; 2) file a request with the Trademark Office for the express abandonment of its application to register the Infringing Mark (U.S. Ser. No. 85/812,403); and 3) enter into a settlement agreement to resolve this matter. Lorillard makes these demands without prejudice to any other remedies available to it under the law, including its rights to actual damages, statutory damages, treble damages, Starbuzz's wrongfully-derived profits and attorneys' fees.

Lorillard hopes that this dispute can be resolved amicably. Prompt acquiescence to Lorillard's demands, however, is a necessary prerequisite to such a resolution. To that end, please contact me by no later than February 15, 2013 to discuss your client's compliance with Lorillard's demands.

I look forward to your prompt response.

Sincerely yours,

**McGUIREWOODS LLP**



George R. Spatz

cc: Chris Howard (Lorillard Tobacco Company)





Hookahs : Hookah Tobacco : Hookah Charcoal : Hookah Accessories : Hookah Blog



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Free E-Cig or Shisha Hookah  
On Orders Over \$150Free Fruit Hookah On  
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## SEARCH PRODUCT

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## HOOKAHS

## SHISHA TOBACCO

Starbuzz Shisha Tobacco

Al Fakher Shisha Tobacco

Romman Shisha Tobacco

Starbuzz Bold Shisha Tobacco

Fumari Shisha Tobacco

Al Tawareg Shisha Tobacco

Starbuzz Acid Shisha Tobacco

Fantasia Shisha Tobacco

Nakhla Shisha Tobacco

Tangiers Shisha Tobacco

Hydro Herbal Shisha

Al Fakher Arena Tobacco

Tangiers Lucid Shisha Tobacco

Hydro Hookah Vapor Stones

Al Fakher Herbal Shisha

Tangiers F-Line Shisha Tobacco

Mya Rocks Vapor Stones

Social Smoke Shisha Tobacco

Tangiers Biruq Shisha Tobacco

Hookafina Shisha Tobacco

Shizzo Shisha Steam Stones

Hookah-Hookah Tobacco

Tonic Shisha Tobacco

Evolution Tea Herbal Shisha

Inhale Shisha Tobacco

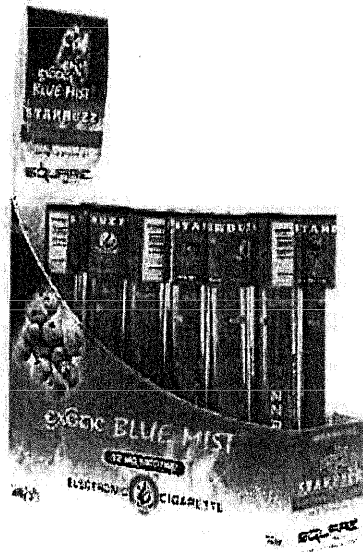
Layalina Shisha Tobacco

Al Amir Shisha Tobacco

## Welcome To Hookah &amp; Shisha Central

Starbuzz E-Cig Tobacco-Free Electronic  
Cigarette 12 Pack

Home : Shisha Tobacco &gt; Starbuzz Shisha Tobacco



SKU: BTO-SB-ECig-12Pack

Starbuzz E-Cig 12-Pack Flavor:

Blue mist

Starbuzz E-Cig 12-Pack Flavor #2:

None

Starbuzz E-Cig 12-Pack Flavor #3:

None

Price:

\$112.99

List Price: ~~\$131.88~~

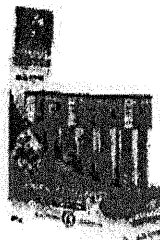
You Save: \$18.89 (14%)

Enter Quantity: 

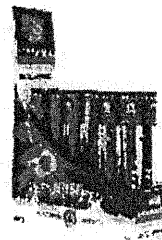
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2 people like this. Be the first of your friends.

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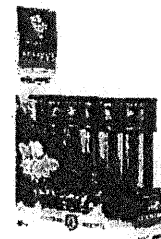
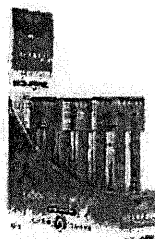
Blue Mist



Irish Peach



Pirate's Cave



Havana Shisha Tobacco

Hypnosis Shisha Tobacco

Fusion Shisha Tobacco

Al Waha Shisha Tobacco

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HOOKAH ACCESSORIES

CLEARANCE

HOOKAH SPECIALS

GET SPECIAL DISCOUNTS &  
Product Updates by Email

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- ▶ Hookah Education
- ▶ Why Shop With Us?
- ▶ Rave Reviews
- ▶ Hookah Tricks & Tips
- ▶ Lounge Directory
- ▶ Monthly Giveaway
- ▶ Reward Program

## Sex on the Beach

## Simply Mint

This is a 12-Pack display box of Starbuzz E-Cigarettes. This is great for retail stores or fans that like to purchase in bulk and save \$\$\$!

Enjoy the taste of Starbuzz anywhere in the palm of your hand! From Starbuzz Hookah Tobacco comes Starbuzz E-Cigs, a tobacco-free way to enjoy the most popular flavors of Starbuzz on the go! This cigarette-shaped device produces a flavored smoke-like vapor similar to a real cigarette but without the fire, ash, odor, or chemical substances. Each Starbuzz E-Cig will last up to 500 puffs!

The body of the Starbuzz E-Cig is made up of the following components:

1. A glycerin-based flavor cartridge, which contains 12 mg of nicotine.
2. An atomization chamber and smart chip with a lithium battery.
3. An operating LED indicator light that lights up when you press the activator button, just like how a real cigarette gets red at the tip while smoking.

Instructions for use of the Starbuzz Electronic Cigarette:

1. Pull the red tab on the side of the E-Cig.
2. Remove the plastic cap at the end.
3. Press the activator button on the side and enjoy up to 500 puffs!

**Note:** You must be 18 years of age to purchase this product.

## Starbuzz E-Cig Tobacco-Free Electronic Cigarette 12 Pack Reviews

Overall Product Feeling: No rating

Read all Starbuzz E-Cig Tobacco-Free Electronic Cigarette 12 Pack reviews | Write Your Own Review

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**CERTIFICATE OF SERVICE**  
**CENTRAL DISTRICT OF CALIFORNIA**  
**Starbuzz v. Lorillard, Inc., et al: Case No.: 2:13-cv-00411-CJC-AN**

The undersigned certifies that on October 9, 2013 the following documents and all related attachments (“Documents”) were filed with the Court using the CM/ECF system.

# FIRST AMENDED COMPLAINT

Pursuant to L.R. 5-3.3, all parties to the above case and/or each attorneys of record herein who are registered users are being served with a copy of these Documents via the Court's CM/ECF system. Any other parties and/or attorneys of record who are not registered users from the following list are being served by first class mail.

s/Natu J. Patel

Natu J. Patel

# **EXHIBIT E**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**



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333 SOUTH GRAND AVENUE, SUITE 2100  
LOS ANGELES, CALIFORNIA 90071

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333 South Grand Avenue, Suite 2100  
Los Angeles, CA 90071  
Telephone: (213) 457-1800  
Facsimile: (213) 457-1850

Attorneys for Defendant and Counterclaimant  
LOEC, INC.

**UNITED STATES DISTRICT COURT**  
**CENTRAL DISTRICT OF CALIFORNIA**  
**SOUTHERN DIVISION**

STARBUZZ TOBACCO, INC., a  
California corporation,  
  
Plaintiff,  
  
vs.  
  
LOEC, INC., a Delaware corporation,  
  
Defendant.

Case No. 8:13-cv-00411-CJC (ANx)  
[Assigned to the Hon. Cormac J. Carney]

**DEFENDANT LOEC, INC.'S  
ANSWER TO PLAINTIFF'S FIRST  
AMENDED COMPLAINT;  
COUNTERCLAIM OF LOEC, INC.**

**DEMAND FOR JURY**

LOEC, INC., a Delaware corporation,  
  
Counterclaimant,  
  
vs.  
  
STARBUZZ TOBACCO, INC., a  
California corporation,  
  
Counterdefendant.

1 Defendant LOEC, Inc. ("LOEC"), by and through its undersigned counsel,  
 2 hereby answers the First Amended Complaint ("FAC") of Plaintiff Starbuzz Tobacco,  
 3 Inc. ("Starbuzz") as follows:

#### 4 **PARTIES**

5 1. LOEC lacks knowledge or information sufficient to form a belief as to the  
 6 truth of the allegations in paragraph 1 of the FAC, and on that basis, denies them.

7 2. In response to the allegations of paragraph 2 of the FAC, LOEC admits that  
 8 it is a corporation organized under the laws of the State of Delaware. LOEC denies  
 9 that its principal place of business is in the City of Greensboro, North Carolina and  
 10 alleges that its principal place of business is 9101 Southern Pine Boulevard, Suite  
 11 250, Charlotte, North Carolina 28273.

12 3. In response to the allegations of paragraph 3 of the FAC, LOEC admits that  
 13 it is responsible for its acts and for its conduct. LOEC denies that Starbuzz is entitled  
 14 to any relief.

#### 15 **JURISDICTION AND VENUE**

16 4. In response to the allegations of paragraph 4 of the FAC, LOEC admits that  
 17 this Court has jurisdiction over Starbuzz's First Claim for Relief for Declaratory  
 18 Judgment for Non-Infringement of Trademarks but denies that this Court has subject  
 19 matter jurisdiction over Starbuzz's Second Claim for Relief for Declaratory Judgment  
 20 for Non-Dilution of Trademarks because there is no current actual case or  
 21 controversy with regard to Starbuzz's Second Claim for Relief for Declaratory  
 22 Judgment for Non-Dilution of Trademarks pursuant to 28 U.S.C. § 2201(a).

23 5. The allegations of paragraph 5 of the FAC are legal conclusions requiring  
 24 no response from LOEC. To the extent Paragraph 5 alleges facts, LOEC admits that  
 25 it engages in business activities in California. LOEC denies the remaining allegations  
 26 of Paragraph 5.

27 6. The allegations of paragraph 6 of the FAC are legal conclusions requiring  
 28 no response from LOEC. To the extent Paragraph 6 alleges facts, LOEC admits that

DYKEMA GOSSETT LLP  
333 SOUTH GRAND AVENUE, SUITE 2100  
LOS ANGELES, CALIFORNIA 90071

1 it engages in business activities in California and operates a website selling electronic  
2 cigarette products in California bearing its BLU marks.

3 7. The allegations of paragraph 7 of the FAC are legal conclusions requiring  
4 no response from LOEC. To the extent Paragraph 7 alleges facts, LOEC admits that  
5 it is registered as a foreign corporation doing business in California.

6 8. The allegations of paragraph 8 of the FAC are legal conclusions requiring  
7 no response from LOEC.

### 8 **INTRODUCTION**

9 9. In response to the allegations of paragraph 9 of the FAC, LOEC admits that  
10 Starbuzz has filed a declaratory relief action seeking judgment that Starbuzz's use of  
11 the mark "BLUE MIST" for electronic cigarettes does not infringe upon or dilute  
12 LOEC's trademark rights. LOEC denies the remaining allegations of paragraph 9 of  
13 the FAC.

14 10. LOEC admits the allegations of paragraph 10 of the FAC.

15 11. LOEC admits the allegations of paragraph 11 of the FAC.

16 12. LOEC admits the allegations of paragraph 12 of the FAC.

17 13. LOEC admits the allegations of paragraph 13 of the FAC.

### 18 **FACTS**

19 14. LOEC lacks knowledge or information sufficient to form a belief as to the  
20 truth of the allegations in paragraph 14 of the FAC, and on that basis, denies them.

21 15. LOEC admits that what appears to be a copy of Starbuzz's Trademark  
22 Registration No. 3,619,407 is attached as Exhibit A to the FAC, but alleges that the  
23 purported copy of Registration No. 3,619,407 attached as Exhibit A to the FAC  
24 speaks for itself. LOEC lacks knowledge and information sufficient to form a belief  
25 as to the truth of the remaining allegations of Paragraph 15 of the FAC, and on that  
26 basis, denies them.

27 16. LOEC lacks knowledge or information sufficient to form a belief as to the  
28 truth of the allegations in paragraph 16 of the FAC, and on that basis, denies them.

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1 17. LOEC lacks knowledge or information sufficient to form a belief as to the  
2 truth of the allegations in paragraph 17 of the FAC, and on that basis, denies them.

3 18. LOEC lacks knowledge or information sufficient to form a belief as to the  
4 truth of the allegations in paragraph 18 of the FAC, and on that basis, denies them.

5 19. LOEC lacks knowledge or information sufficient to form a belief as to the  
6 truth of the allegations in paragraph 19 of the FAC, and on that basis, denies them.

7 20. LOEC lacks knowledge or information sufficient to form a belief as to the  
8 truth of the allegations in paragraph 20 of the FAC, and on that basis, denies them.

9 21. LOEC denies the allegations in paragraph 21 of the FAC.

10 22. LOEC denies the allegations in paragraph 22 of the FAC.

11 23. LOEC denies the allegations in paragraph 23 of the FAC.

12 24. LOEC admits the allegation in paragraph 24 of the FAC that Starbuzz  
13 began using the "BLUE MIST" mark for electronic cigarettes. LOEC denies the  
14 remaining allegations in paragraph 24 of the FAC, including specifically that  
15 electronic cigarettes are a "related product" to Starbuzz's tobacco products.

16 25. In response to the allegations of paragraph 25 of the FAC, LOEC admits  
17 that what appears to be a copy of Starbuzz's Trademark Application Serial No.  
18 85/812,403 to register "BLUE MUST" for electronic cigarettes is attached as Exhibit  
19 B to the FAC. LOEC is without sufficient information or knowledge to determine the  
20 truth of the remaining allegations of Paragraph 25 of the FAC, and, therefore, denies  
21 them.

22 26. In response to the allegations of paragraph 26 of the FAC, LOEC admits  
23 that Lorillard, Inc., through its wholly owned subsidiary, Lorillard Holdings  
24 Company, Inc. ("LHCI"), formerly known as LRDHC, Inc., acquired BLEC, LLC  
25 ("BLEC")'s rights in the BLU Marks and other assets used in the manufacture,  
26 distribution, development, research, marketing, sale, and service of electronic  
27 cigarettes.

28 27. LOEC admits the allegations in paragraph 27 of the FAC.



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LOS ANGELES, CALIFORNIA 90071

1 28. LOEC admits the allegations in paragraph 28 of the FAC.

2 29. In response to the allegations of paragraph 29 of the FAC, LOEC admits  
3 that BLEC applied to the U.S. Patent & Trademark Office for a trademark  
4 registration in "BLU ECIGS," which was ultimately granted. LOEC alleges that the  
5 June 8, 2009 refusal from the USPTO speaks for itself and is the best evidence of its  
6 contents and terms.

7 30. In response to the allegations of paragraph 30 of the FAC, LOEC admits  
8 that BLEC responded to the USPTO's refusal to register on December 3, 2009.  
9 LOEC alleges that BLEC's December 3, 2009 response speaks for itself and is the  
10 best evidence of its contents and terms.

11 31. In response to the allegations of paragraph 31 of the FAC, LOEC admits  
12 that what appears to be a copy of BLEC's Trademark Registration No. 3,846,035 is  
13 attached as Exhibit C to the FAC. LOEC alleges that BLEC's Trademark  
14 Registration No. 3,846,035 speaks for itself and is the best evidence of its contents  
15 and terms.

16 32. In response to the allegations of paragraph 32 of the FAC, LOEC admits  
17 that what appears to be copies of information available on the USPTO's TESS  
18 website regarding BLEC's Trademark Application Serial Nos. 85/131,287,  
19 85/131,965, and 85/092,665 to register "BLU," "BLU (design mark)," and "BLU  
20 CIGS," respectively, for electronic cigarettes and related products in International  
21 Class 034 is attached as Exhibits D, E, and F, respectively, to the FAC.

22 33. In response to the allegations of paragraph 33 of the FAC, LOEC alleges  
23 that BLEC's Trademark Application files for Serial Nos. 85/131,287, 85/131,965,  
24 and 85/092,665 to register "BLU," "BLU (design mark)," and "BLU CIGS,"  
25 respectively, speak for themselves and are the best evidence of their contents and  
26 terms.

27 34. In response to the allegations of paragraph 34 of the FAC, LOEC alleges  
28 that BLEC's Trademark Application files for Serial Nos. 85/131,287, 85/131,965,

1 and 85/092,665 to register “BLU,” “BLU (design mark),” and “BLU CIGS,”  
2 respectively, speak for themselves and are the best evidence of their contents and  
3 terms.

4 35. In response to the allegations in paragraph 35 of the FAC, LOEC alleges  
5 that the FAC speaks for itself.

6 36. LOEC admits the allegations in paragraph 36 of the FAC.

7 37. In response to the allegations in paragraph 37, LOEC admits that in  
8 conjunction with the sale of BLEC’s assets to Lorillard, Inc., through its wholly  
9 owned subsidiary, Lorillard Holdings Company, Inc. (“LHCP”), formerly known as  
10 LRDHC, Inc., BLEC assigned its entire right, title, and interest in and to the BLU  
11 Marks to Lorillard Technologies, Inc. (“LTP”), an intellectual property holding  
12 company that is the subsidiary of LOEC.

13 38. LOEC admits the allegations in paragraph 38 of the FAC.

14 39. LOEC admits the allegations in paragraph 39 of the FAC.

15 40. In response to the allegations of paragraph 40 of the FAC, LOEC denies  
16 that Starbuzz’s rights, if any, to use “BLUE MIST” on tobacco and related products  
17 have priority over LOEC’s rights in the BLU Marks in connection with electronic  
18 cigarettes and related products. LOEC is without sufficient information to determine  
19 the truth of the remaining allegations of paragraph 40 of the FAC, and, therefore,  
20 denies them.

21 41. In response to the allegations of paragraph 41 of the FAC, LOEC admits  
22 that the BLU Marks contain the term “BLU,” which is associated with the color blue  
23 and the blue colored LED tip of the BLU electronic cigarettes, which distinguishes  
24 LOEC’s electronic cigarette from traditional cigarettes as well as other electronic  
25 cigarettes.

26 42. LOEC denies the allegations in paragraph 42 of the FAC.

27 43. LOEC lacks sufficient knowledge or information to determine the truth of  
28 the allegations of paragraph 43 of the FAC, and on that basis, denies them.

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1 44. In response to the allegations of paragraph 44 of the FAC, LOEC denies  
2 that the BLU Marks are weak. LOEC alleges that the remaining allegations in  
3 paragraph 44 are vague, overbroad, ambiguous, and incomplete, and, on that basis,  
4 LOEC is without sufficient information to respond to them.

5 45. LOEC denies the allegations in paragraph 45 of the FAC.

6 46. LOEC denies the allegations in paragraph 46 of the FAC.

7 47. LOEC denies the allegations in paragraph 47 of the FAC.

8 48. In response to the allegations of paragraph 48 of the FAC, LOEC admits  
9 that what appears to be a copy of pictures of LOEC's and Starbuzz's products is  
10 attached as Exhibit G to the FAC. LOEC denies the remaining allegations of  
11 paragraph 48 of the FAC.

12 49. LOEC denies the allegations in paragraph 49 of the FAC.

13 50. LOEC denies the allegations in paragraph 50 of the FAC.

14 51. In response to the allegations of paragraph 51 of the FAC, LOEC alleges  
15 that there is no current actual case or controversy between the parties regarding  
16 whether the "BLUE MIST" mark dilutes LOEC's BLU Marks, and therefore this  
17 Court lacks subject matter jurisdiction over Starbuzz's Second Claim for Relief for  
18 Declaratory Judgment for Non-Dilution of Trademarks pursuant to 28 U.S.C. §  
19 2201(a). On that basis, LOEC alleges that no response to the allegations of paragraph  
20 51 of the FAC is required.

21 52. In response to the allegations of paragraph 52 of the FAC, LOEC alleges  
22 that there is no current actual case or controversy between the parties regarding  
23 whether the "BLUE MIST" mark dilutes LOEC's BLU Marks, and therefore this  
24 Court lacks subject matter jurisdiction over Starbuzz's Second Claim for Relief for  
25 Declaratory Judgment for Non-Dilution of Trademarks pursuant to 28 U.S.C. §  
26 2201(a). On that basis, LOEC alleges that no response to the allegations of paragraph  
27 52 of the FAC is required.

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1           53. In response to the allegations of paragraph 53 of the FAC, LOEC alleges  
2 that there is no current actual case or controversy between the parties regarding  
3 whether the “BLUE MIST” mark dilutes LOEC’s BLU Marks, and therefore this  
4 Court lacks subject matter jurisdiction over Starbuzz’s Second Claim for Relief for  
5 Declaratory Judgment for Non-Dilution of Trademarks pursuant to 28 U.S.C. §  
6 2201(a). On that basis, LOEC alleges that no response to the allegations of paragraph  
7 53 of the FAC is required.

8           54. In response to the allegations of paragraph 54 of the FAC, LOEC alleges  
9 that there is no current actual case or controversy between the parties regarding  
10 whether the “BLUE MIST” mark dilutes LOEC’s BLU Marks, and therefore this  
11 Court lacks subject matter jurisdiction over Starbuzz’s Second Claim for Relief for  
12 Declaratory Judgment for Non-Dilution of Trademarks pursuant to 28 U.S.C. §  
13 2201(a). On that basis, LOEC alleges that no response to the allegations of paragraph  
14 54 of the FAC is required.

15           55. In response to the allegations of paragraph 55 of the FAC, LOEC admits  
16 that what appears to be a copy of a February 4, 2013 letter from Lorillard is attached  
17 as Exhibit H to the FAC. LOEC denies the remaining allegations of paragraph 48 of  
18 the FAC. LOEC alleges that the February 4, 2013 letter speaks for itself and is the  
19 best evidence of its contents and terms.

20           56. In response to the allegations of paragraph 56 of the FAC, LOEC alleges  
21 that the February 4, 2013 letter speaks for itself and is the best evidence of its  
22 contents and terms.

23           57. In response to the allegations of paragraph 57 of the FAC, LOEC alleges  
24 that the February 4, 2013 letter speaks for itself and is the best evidence of its  
25 contents and terms.

26           58. In response to the allegations of paragraph 58 of the FAC, LOEC alleges  
27 that the February 15, 2013 letter speaks for itself and is the best evidence of its  
28 contents and terms.

1           59. In response to the allegations of paragraph 59 of the FAC, LOEC alleges  
2 that the March 1, 2013 letter speaks for itself and is the best evidence of its contents  
3 and terms.

4           60. LOEC lacks sufficient knowledge or information to determine the truth of  
5 the allegations of paragraph 60 of the FAC, and on that basis, denies them.

6           61. In response to the allegations of paragraph 61 of the FAC, LOEC admits  
7 that there is a current actual case or controversy regarding whether Plaintiff's use of  
8 the "BLUE MIST" mark infringes upon Defendant's BLU Marks. LOEC denies that  
9 there is a current actual case or controversy regarding whether Plaintiff's use of the  
10 "BLUE MIST" mark dilutes Defendant's BLU Marks.

11           62. In response to the allegations of paragraph 62 of the FAC, LOEC admits  
12 that Starbuzz has filed an action for declaratory relief to clarify its rights to the  
13 "BLUE MIST" mark and LOEC's rights in the BLU Marks. LOEC denies that  
14 Starbuzz is entitled to any relief.

15           63. In response to the allegations in paragraph 63 of the FAC, LOEC admits  
16 that Starbuzz has filed an action for declaratory relief adjudging that Starbuzz's use  
17 of the "BLUE MIST" mark in connection with electronic cigarettes does not infringe  
18 upon and dilute LOEC's BLU Marks. LOEC denies that Starbuzz is entitled to any  
19 relief, and further denies that this Court has subject matter jurisdiction over  
20 Starbuzz's Second Claim for Relief for Declaratory Judgment for Non-Dilution of  
21 Trademarks because there is no current actual case or controversy with regard to  
22 Starbuzz's Second Claim for Relief for Declaratory Judgment for Non-Dilution of  
23 Trademarks pursuant to 28 U.S.C. § 2201(a).

24           64. LOEC alleges that the allegations in paragraph 64 of the FAC state no facts  
25 requiring a response. To the extent a response is required, LOEC denies that  
26 Starbuzz is entitled to any relief.

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**FIRST CLAIM FOR RELIEF**

**(Declaratory Judgment For Non-Infringement Of Trademarks)**

65. LOEC hereby restates and incorporates by reference its responses to paragraphs 1-64 as though fully set forth herein.

66. In response to the allegations of paragraph 66 of the FAC, LOEC admits that an actual controversy has arisen and now exists between Starbuzz and LOEC concerning whether Starbuzz's "BLUE MIST" Mark infringes upon LOEC's BLU Marks, but denies that there is a current actual case or controversy with regard to Starbuzz's Second Claim for Relief for Declaratory Judgment for Non-Dilution of Trademarks pursuant to 28 U.S.C. § 2201(a). LOEC further denies that Starbuzz is entitled to declaratory judgment.

67. LOEC admits the allegations in paragraph 67 of the FAC.

68. In response to the allegations of paragraph 68 of the FAC, LOEC admits that Starbuzz asserts that there is no likelihood of confusion between "BLUE MIST" and the BLU Marks. LOEC denies the remaining allegations of paragraph 68 of the FAC.

69. LOEC admits the allegations in paragraph 69 of the FAC.

70. In response to the allegations of paragraph 70 of the FAC, LOEC denies that Starbuzz is entitled to any relief.

**SECOND CLAIM FOR RELIEF**

**(Declaratory Judgment For Non-Dilution Of Trademarks)**

71. LOEC hereby restates and incorporates by reference its responses to paragraphs 1-70 as though fully set forth herein.

72. In response to the allegations of paragraph 72 of the FAC, LOEC admits that an actual controversy has arisen and now exists between Starbuzz and LOEC concerning whether Starbuzz's "BLUE MIST" mark infringes upon LOEC's BLU Marks, but denies that there is a current actual case or controversy with regard to Starbuzz's Second Claim for Relief for Declaratory Judgment for Non-Dilution of

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1 Trademarks pursuant to 28 U.S.C. § 2201(a). LOEC further denies that Starbuzz is  
2 entitled to declaratory judgment.

3 73. LOEC admits the allegations in paragraph 73 of the FAC, but further states  
4 that LOEC does not currently allege that Starbuzz's "BLUE MIST" mark dilutes  
5 LOEC's BLU Marks.

6 74. In response to the allegations of paragraph 74 of the FAC, LOEC alleges  
7 that there is no current actual case or controversy between the parties regarding  
8 whether the "BLUE MIST" mark dilutes LOEC's BLU Marks, and therefore this  
9 Court lacks subject matter jurisdiction over Starbuzz's Second Claim for Relief for  
10 Declaratory Judgment for Non-Dilution of Trademarks pursuant to 28 U.S.C. §  
11 2201(a). On that basis, LOEC alleges that no response to the allegations of paragraph  
12 74 of the FAC is required.

13 75. LOEC denies the allegations in paragraph 75 of the FAC because there is  
14 no current actual case or controversy regarding whether the "BLUE MIST" mark  
15 dilutes LOEC's BLU Marks, and therefore this Court lacks subject matter jurisdiction  
16 over Starbuzz's Second Claim for Relief for Declaratory Judgment for Non-Dilution  
17 of Trademarks pursuant to 28 U.S.C. § 2201(a).

18 76. In response to the allegations of paragraph 76 of the FAC, LOEC denies  
19 that the Court has subject matter jurisdiction over this claim or that Starbuzz is  
20 entitled to any relief.

21 **AFFIRMATIVE DEFENSES**

22 As and for separate affirmative defenses to Plaintiff's FAC, and without  
23 admitting any of Plaintiff's allegations or conceding the burden of proof found to be  
24 an element of any of Plaintiff's claims rather than an element of an affirmative  
25 defense as a matter of law, LOEC asserts the following affirmative defenses:  
26  
27  
28



**FIRST AFFIRMATIVE DEFENSE**

**(Failure to State a Claim)**

1. The allegations and claims in the FAC, in whole or in part, fail to state a claim upon which relief may be granted.

**SECOND AFFIRMATIVE DEFENSE**

**(Lack of Subject Matter Jurisdiction)**

2. Starbuzz's Second Claim for Relief for Declaratory Judgment for Non-Dilution of Trademarks is barred for lack of subject matter jurisdiction, pursuant to 28 U.S.C. § 2201(a), because there is no current actual case or controversy between the parties regarding whether the "BLUE MIST" mark dilutes LOEC's BLU Marks.

**PRAYER FOR RELIEF**

WHEREFORE, LOEC, Inc. prays for judgment as follows:

A. That Plaintiff take nothing by its First Amended Complaint and that judgment be entered in favor of Defendant LOEC, Inc.;

B. That this Court dismiss Starbuzz's First Amended Complaint with prejudice;

C. That Defendant LOEC, Inc. be awarded its costs and fees incurred in defending this action; and

D. That the Court grant such other relief as the Court deems just and appropriate.

E. LOEC hereby reserves its right to amend its Answer as additional information becomes available and additional defenses become apparent.

Dated: January 13, 2014

DYKEMA GOSSETT LLP

By: /s/ Allan Gabriel

Allan Gabriel

Walead Esmail

Vivian S. Lee

Attorneys for DEFENDANT AND  
COUNTERCLAIMANT LOEC, INC.



**COUNTERCLAIM**

Pursuant to Rule 13 of the Federal Rules of Civil Procedure, Defendant and Counterclaimant LOEC, Inc. ("LOEC"), by and through its undersigned counsel, hereby asserts the following counterclaims against Plaintiff and Counterdefendant Starbuzz Tobacco, Inc. ("Starbuzz"):

**NATURE OF THE ACTION**

1. This is an action for federal unfair competition under 15 USC 1125(a), California common law trademark infringement, unfair competition under California Business & Professions Code § 17200, and for an order directing the United States Patent & Trademark Office ("USPTO") to refuse registration of Starbuzz's applications to register trademarks containing the word "BLUE" for electronic cigarettes because they are likely to cause consumer confusion with LOEC's federally-registered BLU ECIGS mark, as well as its BLU CIGS, BLU, and BLU (design mark) marks (collectively referred to as the "BLU Family of Marks").

2. For years, LOEC has continuously used and extensively promoted its BLU Family of Marks in connection with the advertising, promotion, and sale of electronic cigarettes and related products. In particular, LOEC has invested substantial time, money, and effort to distinguish its top quality BLU electronic cigarette products from other electronic cigarette products by creating an association in the minds of consumers between those products and its distinctive "BLU" marks. As a result of LOEC's efforts, LOEC has created such association and substantive goodwill in the BLU Family of Marks.

3. As described more fully below, without LOEC's authorization or consent, Starbuzz, an entity whose business had focused on manufacturing and selling tobacco and hookah products, has recently begun to encroach on LOEC's trademark rights by using, and seeking to extend its use of, identifiers that contain the word "BLUE" in connection with its electronic cigarette products and/or components thereof. Starbuzz's use of, and threat of using, "BLUE MIST," "MELON BLUE,"

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1 and “SURFER BLUE” marks in connection with the advertising, promotion, and sale  
2 of electronic cigarette products and/or components thereof is intended to capitalize on  
3 the well-known and popular BLU Family of Marks and to mislead the public and  
4 members of the relevant trade into believing that Starbuzz and its products are  
5 authorized by, sponsored by, or affiliated with LOEC, its famous BLU Family of  
6 Marks, and its electronic cigarette goods. LOEC accordingly brings this  
7 Counterclaim in order to protect its valuable BLU Family of Marks and halt the  
8 likelihood of confusion and the damages and irreparable harm it has suffered and will  
9 continue to suffer as a result of Starbuzz’s unlawful actions.

#### 10 **JURISDICTION AND VENUE**

11 4. This action arises under the Lanham Act, 15 U.S.C. § 1051, *et seq.* This  
12 Court has jurisdiction over LOEC’s federal claims pursuant to 28 U.S.C. § 1138(b)  
13 (unfair competition), 28 U.S.C. § 1331 (federal question) and 15 U.S.C. §§ 1121  
14 (Lanham Act). This Court has supplemental jurisdiction over LOEC’s state law  
15 claims under 28 U.S.C. § 1367.

16 5. Venue is proper in this Court under 28 U.S.C. § 1391 because a  
17 substantial part of the events and/or property that is the subject of the action is  
18 situated in this judicial district.

19 6. The Court has personal jurisdiction over Starbuzz because Starbuzz has  
20 submitted to personal jurisdiction of this Court. In addition, Starbuzz conducts  
21 substantial business within California and/or have committed and continue to commit  
22 the unlawful actions complained of in California.

#### 23 **THE PARTIES**

24 7. Counterclaimant LOEC is a corporation organized and existing under the  
25 laws of Delaware, with a principal place of business at 9101 Southern Pine  
26 Boulevard, Suite 250, Charlotte, North Carolina 28273. LOEC is the leading  
27 electronic cigarette company in the United States. It manufactures, markets, and sells  
28 a variety of electronic cigarettes and related products throughout the United States

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1 and internationally under the well-known BLU Family of Marks, which are owned by  
2 Lorillard Technologies, Inc. ("LTI") and exclusively licensed to LOEC. LTI  
3 acquired all rights and interest in the BLU Family of Marks on or about April 2012  
4 from BLEC, LLC ("BLEC") through an asset and goodwill acquisition. As the  
5 predecessor-in-interest of the BLU Family of Marks, BLEC is hereinafter subsumed  
6 into "LOEC."

7 8. Counterdefendant Starbuzz has alleged it is a corporation organized  
8 under the laws of the State of California with its principal place of business in the  
9 City of Stanton, California. Starbuzz has alleged that it manufactures, distributes,  
10 advertises, and sells tobacco and related products under its STARBUZZ brand.  
11 Starbuzz has also alleged that it is the owner of U.S. Trademark Registration No.  
12 3,619,407 in the mark "BLUE MIST" for "Pipe Tobacco; Molasses Tobacco;  
13 Tobacco; Smoking Tobacco; Flavored Tobacco; and Herbal Molasses" (the "BLUE  
14 MIST Mark").

### 15 GENERAL ALLEGATIONS

#### 16 LOEC's Well-Known BLU Family of Marks

17 9. LOEC markets and sells its BLU brand electronic cigarettes and related  
18 products under a family of trademarks that are well-known throughout the United  
19 States. For years LOEC has invested substantial time, money, and effort advertising  
20 and promoting the products on which the BLU Family of Marks are used, including  
21 selling millions of BLU electronic cigarette products all over the world, including  
22 throughout the United States and in California. Through this investment, LOEC has  
23 built itself up as the leading electronic cigarette company in the United States and  
24 created considerable goodwill and a reputation for top quality electronic cigarette  
25 products.

26 10. LTI is the owner, and LOEC is the exclusive licensee, of Trademark  
27 Registration No. 3,846,035 for the mark "BLU ECIGS" for "Cigarettes containing  
28 tobacco substitutes not for medical purposes; Electronic cigarettes for use as an

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1 alternative to traditional cigarettes; Smokeless cigarette vaporizer pipe; Tobacco  
2 substitutes,” with a first use date of May 1, 2009 (the “BLU ECIGS Mark”). A true  
3 and correct copy of the Trademark Registration is attached hereto as **Exhibit A**.

4 11. LTI is also the owner, and LOEC is the exclusive licensee, of several  
5 U.S. Trademark Applications to register related marks, including:

6 a. Application No. 85/092665, filed on July 26, 2010, to register  
7 “BLU CIGS” for “Electronic cigarettes containing tobacco substitutes not for medical  
8 purposes that utilize electronic cigarette chargers and not lighters; electronic  
9 cigarettes for use as an alternative to traditional cigarettes that utilize electronic  
10 cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize  
11 electronic cigarette chargers and not lighters” with a first use date of May 1, 2009  
12 (the “BLU CIGS Mark”). A true and correct copy of the Trademark Application is  
13 attached hereto as **Exhibit B**.

14 b. Application No. 85/131287, filed on September 16, 2010, to  
15 register “BLU” for “Electronic cigarettes that utilize electronic cigarette chargers and  
16 not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that  
17 utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer  
18 pipes that utilize electronic cigarette chargers and not lighters” with a first use date of  
19 May 1, 2009 (the “BLU Mark”). A true and correct copy of the Trademark  
20 Application is attached hereto as **Exhibit C**.

21 c. Application No. 85/131965, filed on September 17, 2010, to  
22 register “BLU (design mark)” for “Electronic cigarettes that utilize electronic  
23 cigarette chargers and not lighters; electronic cigarettes for use as an alternative to  
24 traditional cigarettes that utilize electronic cigarette chargers and not lighters;  
25 smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not  
26 lighters” with a first use date of May 1, 2009 (the “BLU Design Mark”). A true and  
27 correct copy of the Trademark Application is attached hereto as **Exhibit D**.

28

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1           12. Since their first use in May 1, 2009, the BLU Family of Marks have  
2 distinguished LOEC's electronic cigarettes from other electronic cigarettes and have  
3 become well-known and instantly recognizable by consumers.

4           13. LOEC developed the idea of distinguishing its electronic cigarette from  
5 traditional cigarettes as well as other electronic cigarettes by adding a blue colored  
6 LED tip which lights up in blue when a user takes a drag off of the electronic  
7 cigarette. LOEC was the first to use the blue-colored LED tip in connection with an  
8 electronic cigarette in the United States, and it has therefore become an important and  
9 distinguishable part of the BLU Family of Marks. LOEC's blue-colored LED tip is  
10 well-known among consumers.

11           14. The designation "BLU," and its association with the color blue, was  
12 selected as a simple and powerful brand which would distinguish LOEC's products in  
13 the electronic cigarette marketplace.

14           15. Using the BLU Family of Marks and the distinct "BLU" brand and  
15 color, LOEC became an innovator and the leading provider of electronic cigarettes in  
16 the United States.

17           16. BLU was the first brand of electronic cigarette to sponsor a top 35 car in  
18 the NASCAR Sprint Cup Series. Products featuring the BLU Family of Marks have  
19 been given out in gift bags at major entertainment and sporting events, including the  
20 Oscars, American Music Awards, MTV Movie awards, Grammy awards, Country  
21 Music awards, and the American Century Golf Championship.

22           17. In 2011, LOEC ran a nationwide promotion to help raise money for the  
23 Wounded Warrior Project using the BLU Family of Marks. Wounded Warrior  
24 Project is a nonprofit organization that offers programs and services to severely  
25 injured service members during the time between active duty and transition to civilian  
26 life. Upon completion of the promotion, LOEC made a substantial donation to the  
27 Wounded Warrior Project.  
28

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1 18. The BLU Family of Marks has been heavily featured in national and  
2 local media, including in the Drudge Report, Jet Set Magazine, Rolling Stone, SPIN,  
3 Maxim, Men's Journal, Esquire, REELZ Channel, Si TV, MSG Network, BBC  
4 America, MAV TV, and USA Today. The BLU Family of Marks have also been  
5 promoted in commercials featuring celebrity spokespersons Stephen Dorff and Jenny  
6 McCarthy.

7 19. Millions of BLU electronic cigarette products have been sold, and  
8 continue to be sold, at thousands of retail locations throughout the United States and  
9 via the internet, including at Walgreens, Cumberland Farms, Sheetz, BiLo, H-E-B,  
10 Ingles, Meijer, Jackson Foods, Weis Markets, Kerr Drug, Scolari's, and others.

11 20. LOEC and LTI have the exclusive right to use the BLU Family of Marks  
12 in connection with the sale and offer to sell electronic cigarette products.

13 21. LOEC's BLU Family of Marks is inherently distinctive and have come  
14 to be associated by consumers with a single source.

15 22. As a result of LOEC's extensive use and promotion, the BLU Family of  
16 Marks have acquired secondary meaning and become widely recognized by the  
17 general consuming public and the trade as a designation of source identifying LOEC  
18 and the BLU Family of Marks' brand of electronic cigarettes.

19 **Starbuzz's Infringement of LOEC's Well-Known BLU Family of Marks**

20 23. LOEC is informed and believes that for years Starbuzz's business was  
21 the manufacture and sale of tobacco, hookah, and related products.

22 24. Recently, Starbuzz entered into the electronic cigarette business and  
23 began encroaching into LOEC's marketplace by manufacturing, advertising,  
24 marketing, distributing, and selling electronic cigarette products and/or components  
25 thereof under its BLUE MIST Mark, which, when used in connection with electronic  
26 cigarette products, is confusingly similar to the BLU Family of Marks. A true and  
27 correct copy of images from Starbuzz's website and third-party websites showing  
28



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1 Starbuzz offering electronic cigarette products and/or components thereof for sale in  
2 connection with its BLUE MIST Mark is attached hereto as **Exhibit E**.

3 25. LOEC is informed and believes that Starbuzz has manufactured,  
4 marketed, and sold substantial quantities of electronic cigarette products and/or  
5 components thereof under its BLUE MIST Mark and has obtained, and continues to  
6 obtain, substantial profits thereby.

7 26. On December 28, 2012, Starbuzz filed Application No. 85/812403 to  
8 register "BLUE MIST" for "Electronic cigarettes" with a claimed first use date of  
9 August 22, 2012. A true and correct copy of the Trademark Application is attached  
10 hereto as **Exhibit F**.

11 27. On or about February 4, 2013, after learning of Starbuzz's sale,  
12 advertising, and distribution of electronic cigarette products and/or components  
13 thereof under Starbuzz's BLUE MIST Mark, LOEC, through its parent corporation,  
14 Lorillard, Inc. ("Lorillard"), sent Starbuzz a letter demanding that it cease and desist  
15 the use of the BLUE Mist Mark in connection with electronic cigarette products and  
16 components thereof and withdraw its application to register the BLUE MIST Mark  
17 for electronic cigarettes. A true and correct copy of the February 4, 2013 letter from  
18 Lorillard to Starbuzz is attached hereto as **Exhibit G**.

19 28. On or about February 15, 2013, Starbuzz responded to Lorillard's letter  
20 by refusing to cease and desist its infringing activity. A true and correct copy of the  
21 February 15, 2013 letter from Starbuzz to Lorillard is attached hereto as **Exhibit H**.

22 29. On or about March 1, 2013, Lorillard responded to Starbuzz's letter by  
23 demanding again that Starbuzz cease and desist the use of the BLUE Mist Mark in  
24 connection with electronic cigarette products and components thereof and withdraw  
25 its application to register the BLUE MIST Mark for electronic cigarettes. A true and  
26 correct copy of the March 1, 2013 letter from Lorillard to Starbuzz is attached hereto  
27 as **Exhibit I**.

1           30. On or about March 8, 2013, Starbuzz responded to Lorillard's March 1,  
2 2013 letter by refusing to cease and desist its infringing activity and stating that it  
3 would file a declaratory relief action. A true and correct copy of the March 8, 2013  
4 letter from Starbuzz to Lorillard is attached hereto as **Exhibit J**.

5           31. Since Lorillard sent Starbuzz the cease and desist letters, Starbuzz has  
6 escalated its unlawful activity by recently expanding its use of "BLUE" marks for  
7 electronic cigarette products and components thereof and filing several additional  
8 U.S. Trademark Applications for marks that contain the word "BLUE" in connection  
9 with electronic cigarettes products and components thereof, including:

10           a. Application No. 86/111155, filed on November 5, 2013, to  
11 register "BLUE MIST" for "Tobacco substitute" with a claimed first use date of  
12 March 28, 2013. A true and correct copy of the Trademark Application is attached  
13 hereto as **Exhibit K**.

14           b. Application No. 86/111645, filed on November 6, 2013, to  
15 register "BLUE MIST" for "Cartridges sold filled with propylene glycol for  
16 electronic cigarettes; Cartridges sold filled with vegetable glycerin for electronic  
17 cigarettes" with a claimed first use date of July 12, 2013. A true and correct copy of  
18 the Trademark Application is attached hereto as **Exhibit L**.

19           c. Application No. 86/111093, filed on November 5, 2013, to  
20 register "BLUE MIST" for "Electronic cigarette liquid (e-liquid) comprised of  
21 flavorings in liquid form used to refill electronic cigarette cartridges" with a claimed  
22 first use date of July 12, 2013. A true and correct copy of the Trademark Application  
23 is attached hereto as **Exhibit M**.

24           d. Application No. 86/113590, filed on November 8, 2013, to  
25 register "MELON BLUE" for "Chemical flavorings in liquid form used to refill  
26 electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of  
27 flavorings in liquid form used to refill electronic cigarette cartridges" with a claimed  
28 first use date of November 8, 2013. A true and correct copy of the Trademark



1 Application is attached hereto as **Exhibit N**.

2 e. Application No. 86/113657, filed on November 8, 2013, to  
3 register "BLUE SURFER" for "Chemical flavorings in liquid form used to refill  
4 electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of  
5 flavorings in liquid form used to refill electronic cigarette cartridges" with a claimed  
6 first use date of November 8, 2013. A true and correct copy of the Trademark  
7 Application is attached hereto as **Exhibit O**.

8 32. Starbuzz's BLUE MIST marks, MELON BLUE mark and BLUE  
9 SURFER mark are collectively referred to herein as the "Starbuzz BLUE Marks."

10 33. Starbuzz's actions as alleged herein have caused and will cause LOEC  
11 irreparable harm for which money damages and other remedies are inadequate.  
12 Starbuzz has refused to cease its unlawful activity and has escalated its unlawful  
13 activity and sought to further capitalize on the fame and goodwill of the BLU Family  
14 of Marks by using and seeking to register additional trademarks containing "BLUE"  
15 in connection with its electronic cigarette products and/or components thereof.  
16 Therefore, unless this Court restrains Starbuzz, Starbuzz will continue and/or expand  
17 the unlawful activities alleged in this Counterclaim and otherwise continue to cause  
18 great and irreparable damage and injury to LOEC by, among other things:

19 a. Depriving LOEC of its rights to use and control use of its BLU  
20 Family of Marks;

21 b. Creating a likelihood of confusion, mistake, and deception among  
22 consumers and the trade as to the source of the Starbuzz infringing products;

23 c. Causing the public falsely to associate Starbuzz and its electronic  
24 cigarette products and/or components thereof with LOEC and/or its products, or vice  
25 versa;

26 d. Causing incalculable and irreparable damage to LOEC's goodwill  
27 and interfering with the capacity of the BLU Family of Marks to differentiate  
28 LOEC's BLU electronic cigarette products from others; and

1 e. Causing LOEC to lose sales of its BLU electronic cigarette  
2 products.

3 34. Accordingly, in addition to other relief sought, LOEC is entitled to  
4 preliminary and permanent injunctive relief against Starbuzz and all persons acting in  
5 concert with it.

6 **FIRST CLAIM**

7 **FEDERAL UNFAIR COMPETITION**

8 **(15 U.S.C. § 1125(a); Lanham Act § 43(a))**

9 35. LOEC hereby incorporates by reference and realleges the allegations of  
10 Paragraphs 1 through 33 as if fully set forth herein.

11 36. This cause of action arises under Section 43(a) of the Lanham Act, 15  
12 U.S.C. § 1125(a).

13 37. LTI is the owner of all right and title to the federally-registered BLU  
14 ECIGS Mark, as well as the BLU CIGS Mark, BLU Mark, and BLU (Design Mark),  
15 as reflected in LTI's federal trademark applications for electronic cigarette products.  
16 LTI has exclusively licensed use of the BLU Family of Marks to LOEC.

17 38. LOEC has used the BLU Family of Marks continuously and in good  
18 faith in connection with electronic cigarette sales since prior to Starbuzz's use of the  
19 Starbuzz BLUE Marks in connection with similar, if not identical, electronic cigarette  
20 goods and services.

21 39. The BLU Family of Marks are valid, protectable, and enforceable.

22 40. Starbuzz's use of the Starbuzz BLUE Marks as alleged above in  
23 commerce, in connection with electronic cigarette products and/or components  
24 thereof, has caused or is likely to cause confusion, mistake, or deception as to the  
25 affiliation, connection, or association of Starbuzz or its products with LOEC or  
26 LOEC's products bearing the BLU Family of Marks, or as to the origin of Starbuzz's  
27 goods, in that consumers are likely to believe falsely that Starbuzz is in some way  
28

1 legitimately affiliated, connected, or associated with, or otherwise related to, LOEC  
2 and the BLU Family of Marks.

3 41. Starbuzz's acts of trademark infringement and unfair competition have  
4 been willful, intentional, and committed with the intent to, and have caused,  
5 confusion, mistake, or deception.

6 42. Starbuzz's use of the Starbuzz BLUE Marks is, and always has been,  
7 without LOEC's or LTI's permission or consent and with the intent to unlawfully  
8 capitalize on the fame and goodwill of the BLU Family of Marks.

9 43. Starbuzz's use of the Starbuzz BLUE Marks constitutes a violation of  
10 Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

11 44. LOEC is without an adequate remedy at law because Starbuzz's unfair  
12 competition has caused great and irreparable injury to LOEC, and unless said acts are  
13 enjoined by this Court, they will continue and LOEC will continue to suffer great and  
14 irreparable injury.

15 45. Starbuzz's acts of trademark infringement and unfair competition have  
16 further caused LOEC to sustain substantial monetary damages, loss, and injury in an  
17 amount to be determined at the trial of this action.

## 18 **SECOND CLAIM**

### 19 **CALIFORNIA TRADEMARK INFRINGEMENT**

#### 20 **(California Common Law Trademark Infringement)**

21 46. LOEC hereby incorporates by reference and realleges the allegations of  
22 Paragraphs 1 through 44 as if fully set forth herein.

23 47. This cause of action arises under California common law.

24 48. LTI is the owner, and LOEC is the exclusive licensee, of all right and  
25 title to the BLU Family of Marks.

26 49. LOEC has used the BLU Family of Marks continuously and in good  
27 faith in connection with electronic cigarette sales since prior to Starbuzz's use of the  
28

DYKEMA GOSSETT LLP  
333 SOUTH GRAND AVENUE, SUITE 2100  
LOS ANGELES, CALIFORNIA 90071

1 Starbuzz BLUE Marks in connection with similar, if not identical, electronic cigarette  
2 goods and services.

3 50. Starbuzz's use of the Starbuzz BLUE Marks as alleged above in  
4 commerce, in connection with electronic cigarette products and/or components  
5 thereof, is likely to cause confusion, mistake, or deception as to the affiliation,  
6 connection, or association of Starbuzz with LOEC or LOEC's products bearing the  
7 BLU Family of Marks in that consumers are likely to believe falsely that Starbuzz is in  
8 some way affiliated, connected, or associated with, or otherwise related to, LOEC and  
9 the BLU Family of Marks.

10 51. Starbuzz's acts of trademark infringement have been willful, intentional,  
11 and committed with the intent to, and have caused, confusion, mistake, or deception.

12 52. Starbuzz's use, and threatened use, of the Starbuzz BLUE Marks is, and  
13 always has been, without LOEC's or LIT's permission or consent and with the intent  
14 to unlawfully capitalize on the fame and goodwill of the BLU Family of Marks.

15 53. As a direct and proximate result of Starbuzz's unlawful conduct, LOEC  
16 has suffered and will continue to suffer substantial harm and injury to its business,  
17 goodwill, and reputation.

18 54. Unless enjoined by this Court, the infringing acts complained of will  
19 continue. LOEC will be irreparably harmed and have no adequate remedy at law to  
20 redress the continuing injuries that Starbuzz has caused and will continue to cause by  
21 its conduct.

22 55. Starbuzz's acts of trademark infringement are willful, intentional, and  
23 committed with malice to harm LOEC's business. LOEC, therefore, seeks to recover  
24 enhanced damages and an award of attorneys' fees.

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**THIRD CLAIM**

**CALIFORNIA UNFAIR COMPETITION**

**(CAL. BUS. & PROF. CODE § 17200)**

56. LOEC hereby incorporates by reference and realleges the allegations of Paragraphs 1 through 54 as if fully set forth herein.

57. Starbuzz's conduct and infringement of the BLU Family of Marks constitutes "unlawful, unfair or fraudulent business act[s] or practice[s] and unfair, deceptive, untrue or misleading advertising" within the meaning of California Business & Professions Code Section 17200.

58. As a consequence of Starbuzz's actions, LOEC is entitled to injunctive relief and an order that Starbuzz disgorge all of its profits obtained from the manufacture, use, display or sale of infringing goods.

**PRAYER FOR RELIEF**

WHEREFORE, LOEC respectfully requests that the Court enter judgment:

1. Dismissing all claims in Starbuzz's First Amended Complaint with prejudice, finding that Starbuzz is not entitled to any of its requested relief, or any relief whatsoever, and denying with prejudice all relief requested by Starbuzz.

2. Adjudging that Starbuzz has competed unfairly with LOEC in violation of LOEC's rights under common law, 15 U.S.C. § 1125(a), and/or California law;

3. Adjudging that Starbuzz and its agents, employees, attorneys, successors, assigns, affiliates, and joint venturers and any person(s) in active concert or participation with it, and/or any person(s) acting for, with, by, through or under it, be enjoined and restrained at first during the pendency of this action and thereafter permanently from:

a. Manufacturing, producing, sourcing, importing, selling, offering for sale, distributing, advertising, or promoting any goods that display any words or symbols that so resemble the BLU Family of Marks as to be likely to cause confusion, mistake or deception, on or in connection with any product that is not

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LOS ANGELES, CALIFORNIA 90071

1 authorized by or for LOEC;

2 b. Using any word, term, symbol, device or combination thereof that  
3 causes or is likely to cause confusion, mistake or deception as to the affiliation or  
4 association of Starbuzz or its products with LOEC, or as to the origin of Starbuzz's  
5 goods, or any false designation of origin, false or misleading description or  
6 representation of fact;

7 c. Further infringing the rights of LOEC in and to the BLU Family  
8 of Marks or otherwise damaging LOEC's goodwill or business reputation;

9 d. Otherwise competing unfairly with LOEC in any manner; and

10 e. Continuing to perform in any manner whatsoever any of the other  
11 acts complained of in this Counterclaim;

12 4. Adjudging that Starbuzz, within thirty (30) days after service of the  
13 judgment demanded herein, be required to file with this Court and serve upon  
14 LOEC's counsel a written report under oath setting forth in detail the manner in which  
15 it complied with the judgment;

16 5. Adjudging that LOEC recover from Starbuzz its damages and lost profits  
17 in an amount to be proven at trial;

18 6. Adjudging that LOEC recover all profits earned by Starbuzz in  
19 connection with its unlawful activities;

20 7. Ordering an accounting of and impose a constructive trust on all of  
21 Starbuzz's funds and assets that arise out of its infringing activities;

22 8. Directing the USPTO to refuse registration to Starbuzz's infringing  
23 Trademark Application Nos. 85/812403, 86/111155, 86/111645, 86/111093,  
24 86/113590, and 86/113657;

25 9. Adjudging that Starbuzz and its agents, employees, attorneys,  
26 successors, assigns, affiliates, and joint venturers and any person(s) in active concert  
27 or participation with it, and/or any person(s) acting for, with, by, through or under it,  
28

1 be enjoined and restrained from applying to register any trademark applications with  
2 the USPTO that are likely to infringe on the BLU Family of Marks;

3 10. Adjudging that LOEC be awarded its costs and disbursements incurred  
4 in connection with this action, that this Counterclaim constitutes an exceptional case  
5 pursuant to 15 USC 1117(a), and therefore award to LOEC its reasonable attorneys'  
6 fees; and,

7 11. Adjudging that all such other relief be awarded to LOEC as this Court  
8 deems just and proper.

9  
10 Dated: January 13, 2014

**DYKEMA GOSSETT LLP**

11 By: /s/ Allan Gabriel  
12 Allan Gabriel  
13 Walead Esmail  
14 Vivian S. Lee  
15 Attorneys for DEFENDANT AND  
16 COUNTERCLAIMANT LOEC, INC.  
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**DEMAND FOR JURY TRIAL**

Pursuant to Federal Rule of Civil Procedure 38, on all issues so triable,  
Defendant and Counterclaimant LOEC, Inc. demands a jury on all issues so triable in  
this case.

Dated: January 13, 2014

DYKEMA GOSSETT LLP

By: /s/ Allan Gabriel  
Allan Gabriel  
Walead Esmail  
Vivian S. Lee  
Attorneys for DEFENDANT AND  
COUNTERCLAIMANT LOEC, INC.

DYKEMA GOSSETT LLP  
333 SOUTH GRAND AVENUE, SUITE 2100  
LOS ANGELES, CALIFORNIA 90071



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# BLU ECIGS

#### Word Mark

**BLU ECIGS**

#### Goods and Services

IC 034. US 002 008 009 017. G & S: Cigarettes containing tobacco substitutes not for medical purposes; Electronic cigarettes for use as an alternative to traditional cigarettes; Smokeless cigarette vaporizer pipe; Tobacco substitutes. FIRST USE: 20090501. FIRST USE IN COMMERCE: 20090501

#### Standard Characters Claimed

#### Mark Drawing Code

(4) STANDARD CHARACTER MARK

#### Trademark Search Facility Classification Code

LETTER-3-OR-MORE BLU-ECIGS Combination of three or more letters as part of the mark

#### Serial Number

77692962

#### Filing Date

March 17, 2009

#### Current Basis

1A

#### Original Filing Basis

1B

#### Published for Opposition

February 2, 2010

#### Registration Number

3846035

#### International

**Registration Number** 1051365

**Registration Date** September 7, 2010

**Owner** (REGISTRANT) BLEC, LLC LIMITED LIABILITY COMPANY NEVADA 401 N Tryon Street, Suite 1080 Charlotte NORTH CAROLINA 28202

(LAST LISTED OWNER) LORILLARD TECHNOLOGIES, INC. CORPORATION DELAWARE 714 GREEN VALLEY ROAD GREENSBORO NORTH CAROLINA 27408

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Blake E. Vande Garde

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "ECIGS" APART FROM THE MARK AS SHOWN

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead Indicator** LIVE

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# BLU CIGS

<b>Word Mark</b>	BLU CIGS
<b>Goods and Services</b>	IC 034. US 002 008 009 017. G & S: Electronic cigarettes containing tobacco substitutes not for medical purposes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters. FIRST USE: 20090501. FIRST USE IN COMMERCE: 20090501
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	85092665
<b>Filing Date</b>	July 26, 2010
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Published for Opposition</b>	November 8, 2011
<b>International Registration Number</b>	1051607

**Owner** (APPLICANT) BLEC, LLC LIMITED LIABILITY COMPANY NEVADA 401 N Tryon Street, Suite 1080  
Charlotte NORTH CAROLINA 28202

**Assignment  
Recorded** ASSIGNMENT RECORDED

**Attorney of  
Record** Blake E. Vande Garde

**Prior  
Registrations** 3846035

**Disclaimer** NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CIGS" APART FROM THE MARK AS  
SHOWN

**Type of Mark** TRADEMARK

**Register** PRINCIPAL-2(F)

**Live/Dead  
Indicator** LIVE

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# BLU

**Word Mark**

BLU

**Goods and Services**

IC 034. US 002 008 009 017. G & S: Electronic cigarettes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters. FIRST USE: 20090501. FIRST USE IN COMMERCE: 20090501

**Standard Characters Claimed**

**Mark**

**Drawing Code**

(4) STANDARD CHARACTER MARK

**Serial Number**

85131287

**Filing Date**

September 16, 2010

**Current Basis**

1A

**Original Filing Basis**

1A

**Published for Opposition**

November 8, 2011

**Owner**

(APPLICANT) BLEC, LLC LIMITED LIABILITY COMPANY NEVADA 401 N Tryon Street, Suite 1080 Charlotte NORTH CAROLINA 28202

**Assignment Recorded**

ASSIGNMENT RECORDED



**Attorney of Record** Blake E. Vande Garde  
**Prior Registrations** 3846035  
**Type of Mark** TRADEMARK  
**Register** PRINCIPAL-2(F)  
**Live/Dead Indicator** LIVE

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**Word Mark** BLU

**Goods and Services** IC 034. US 002 008 009 017. G & S: Electronic cigarettes that utilize electronic cigarette chargers and not lighters; electronic cigarettes for use as an alternative to traditional cigarettes that utilize electronic cigarette chargers and not lighters; smokeless cigarette vaporizer pipes that utilize electronic cigarette chargers and not lighters. FIRST USE: 20090501. FIRST USE IN COMMERCE: 20090501

**Mark Drawing Code** (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

**Design Search Code** 01.15.25 - Coal; Dust; Light rays; Liquids, spilling; Pouring liquids; Sand; Spilling liquids  
10.01.02 - Cigarettes; Holders, cigarette and cigar  
26.05.21 - Triangles that are completely or partially shaded  
26.11.21 - Rectangles that are completely or partially shaded

**Serial Number** 85131965

**Filing Date** September 17, 2010

**Current Basis** 1A

**Original Filing Basis** 1A

**Published for Opposition** November 29, 2011

**International Registration Number** 1058275

**Owner** (APPLICANT) BLEC, LLC LIMITED LIABILITY COMPANY NEVADA 401 N Tryon Street, Suite 1080 Charlotte NORTH CAROLINA 28202

**Assignment Recorded** ASSIGNMENT RECORDED

**Attorney of Record** Blake E. Vande Garde

**Prior Registrations** 3846035

**Description of Mark** The color(s) blue, black, gray and white is/are claimed as a feature of the mark. The mark consists of the word "BLU" in stylized font whereby the letter "L" resembles a cigarette with blue light rays emitting therefrom that gradually become black towards the top and all letters appear in the color gray that gradually become white towards the top above a stylized partial reflection of the same all against a black field.

**Type of Mark** TRADEMARK

**Register** PRINCIPAL-2(F)-IN PART

**Live/Dead Indicator** LIVE

**Distinctiveness**

**Limitation** as to "BLU"

**Statement**

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# EXHIBIT E



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MY ACCOUNT

GIFT CERTIFICATES

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SEARCH FOR A PRODUCT



ACCESSORIES CHARCOAL HOOKAHS ELECTRONICS STEAM STONES DEALS

Home Electronics Blue Mist E-BUZZ  
Home Electronics Blue Mist E-BUZZ

## BLUE MIST E-BUZZ

RRP: \$10.99

(You save \$3.50)

**\$7.49**

### Weight:

0.30 LBS

### Shipping:

Calculated at checkout

### \* Single or Box:

Single

### Quantity:

1

ADD TO CART



[Add to wishlist](#)



### PRODUCT DESCRIPTION

Blue Mist from Starbuzz Tobacco is a refined and is one of the smoothest flavors you will ever smoke. It's a flavor similar to cotton candy and a flavor that explodes with thick tobacco smoke.

Buy by the box of 12 and save over 20%!

WARNING: Nicotine is a harmful and addictive substance. The products offered on this site may be associated with tobacco use and subsequent inhaling of tobacco and nicotine.

### FIND SIMILAR PRODUCTS BY CATEGORY

### PRODUCT REVIEWS

### CUSTOMERS WHO VIEWED THIS PRODUCT ALSO VIEWED



Starbuzz E-Hose  
~~\$199.99~~ \$179.99

CHOOSE OPTIONS

Joyetech eVic  
\$129.99

ADD TO CART

Apple Doppio E-BUZZ  
~~\$10.99~~ \$7.49

CHOOSE OPTIONS

Blue Mist E-Hose Cartridge  
\$14.99

CHOOSE OPTIONS

## PRODUCTS

Accessories  
Charcoal  
Hookahs  
Electronics  
Steam Stones  
Deals

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Your Email:



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702-489-2899

HOME

MY ACCOUNT

GIFT CERTIFICATES

SIGN IN OR CREATE AN ACCOUNT

VIEW CART

SEARCH FOR A PRODUCT



ACCESSORIES CHARCOAL HOOKAHS ELECTRONICS STEAM STONES DEALS

Home Electronics Blue Mist E-Hose Cartridge  
Home Electronics Blue Mist E-Hose Cartridge



## BLUE MIST E-HOSE CARTRIDGE

\$14.99

Weight:

0.30 LBS

Shipping:

Calculated at checkout

\* Size:

1 Box (4ct)

Quantity:

1

ADD TO CART



Add to wishlist

### PRODUCT DESCRIPTION

Blue Mist from Starbuzz Tobacco is a refined and is one of the smoothest flavors you will ever smoke. It's a flavor similar to cotton candy and a flavor that explodes with thick tobacco smoke.

### FIND SIMILAR PRODUCTS BY CATEGORY

### PRODUCT REVIEWS

### CUSTOMERS WHO VIEWED THIS PRODUCT ALSO VIEWED



Starbuzz E-Hose  
~~\$199.99~~ \$179.99

CHOOSE OPTIONS



Apple Doppio E-Hose Cartridge  
\$14.99

CHOOSE OPTIONS



Joyetech eVic  
\$129.99

ADD TO CART



Blue Mist E-BUZZ  
~~\$10.99~~ \$7.49

CHOOSE OPTIONS



## PRODUCTS

Accessories  
Charcoal  
Hookahs  
Electronics  
Steam Stones  
Deals

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## BLUE MIST E-BUZZ ZERO

**\$10.99**

**Weight:**

0.30 LBS

**Shipping:**

Calculated at checkout

\* Single or Box:

[Add to wishlist](#)

Single



Sorry but this item is currently unavailable.

Please check back at a later stage.

### PRODUCT DESCRIPTION

Zero Nicotine, Extra Smooth

Blue Mist from Starbuzz Tobacco is a refined and is one of the smoothest flavors you will ever smoke. It's a flavor similar to cotton candy and a flavor that explodes with thick tobacco smoke.

### FIND SIMILAR PRODUCTS BY CATEGORY

### PRODUCT REVIEWS

### CUSTOMERS WHO VIEWED THIS PRODUCT ALSO VIEWED



Blue Mist E-BUZZ  
~~\$10.99~~ \$7.49

[CHOOSE OPTIONS](#)



Starbuzz E-Hose  
~~\$199.99~~ \$179.99

[CHOOSE OPTIONS](#)



Joyetech eVic  
\$129.99

[ADD TO CART](#)



Apple Doppio E-Buzz Zero  
\$10.99

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PRODUCTS

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Exhibit E, Page 46

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Charcoal  
Hookahs  
Electronics  
Steam Stones  
Deals

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Your Name:

Your Email:



Connect with us:

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All prices are in USD. Copyright 2014 Shop Starbuzz. Sitemap | WARNING: Nicotine is a harmful and addictive substance. The products offered on this site may be associated with tobacco use and subsequent inhaling of tobacco and nicotine.





**Sex on the Beach**

**Simply Mint**

This is a 12-Pack display box of Starbuzz E-Cigarettes. This is great for retail stores or fans that like to purchase in bulk and save \$\$!

Enjoy the taste of Starbuzz anyw here in the palm of your hand! From **Starbuzz Hookah Tobacco** comes Starbuzz E-Cigs, a tobacco-free way to enjoy the most popular flavors of Starbuzz on the go! This cigarette-shaped device produces a flavored smoke-like vapor similar to a real cigarette but w ithout the fire, ash, odor, or chemical substances. Each Starbuzz E-Cig comes w ith a 240.5 mAh battery, and **will produce an average of 250 puffs** depending on frequency and intensity of use.

The body of the Starbuzz E-Cig is made up of the following components:

1. A glycerin-based flavor cartridge, w hich contains **12 mg of nicotine**.
2. An atomization chamber and smart chip w ith a lithium battery.
3. An operating LED indicator light that lights up w hen you press the activator button, just like how a real cigarette gets red at the tip w hile smoking.

Instructions for use of the Starbuzz Electronic Cigarette:

1. Pull the red tab on the side of the E-Cig.
2. Remove the plastic cap at the end.
3. Press the activator button on the side and enjoy up to 500 puffs!

**Note:** You must be 18 years of age to purchase this product.

#### Starbuzz E-Cig Tobacco-Free Electronic Cigarette 12 Pack Reviews

Overall Product Feeling: No rating

[Read all Starbuzz E-Cig Tobacco-Free Electronic Cigarette 12 Pack reviews](#) | [Write Your Own Review](#)

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# EXHIBIT F



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**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*( Use the "Back" button of the Internet Browser to return to TESS)***BLUE MIST**

<b>Word Mark</b>	BLUE MIST
<b>Goods and Services</b>	IC 034. US 002 008 009 017. G & S: Electronic cigarettes. FIRST USE: 20120822. FIRST USE IN COMMERCE: 20120822
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	85812403
<b>Filing Date</b>	December 28, 2012
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Owner</b>	(APPLICANT) Starbuzz Tobacco, Inc. CORPORATION CALIFORNIA 10871 Forbes Avenue Garden Grove CALIFORNIA 92843
<b>Attorney of Record</b>	Martin Jerisat
<b>Prior Registrations</b>	3619407;4091743
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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# EXHIBIT G

McGuireWoods LLP  
77 West Wacker Drive  
Suite 4100  
Chicago, IL 60601-1818  
Phone: 312.849.8100  
Fax: 312.849.3690  
www.mcguirewoods.com

GEORGE R. SPATZ  
Direct: 312.321.7676

McGUIREWOODS

gspatz@mcguirewoods.com  
Direct Fax: 312.698.4584

February 4, 2013

**BY FEDEX AND E-MAIL**

Starbuzz Tobacco, Inc.  
c/o Natu J. Patel  
THE PATEL LAW FIRM, P.C.  
2532 Dupont Drive  
Irvine, CA 92612  
[NPatel@thePatelLawFirm.com](mailto:NPatel@thePatelLawFirm.com)

**Re: Starbuzz Tobacco, Inc.'s Infringing Use of and Application to  
Register the BLUE MIST Mark (U.S. Ser. No. 85/812,403)**

Dear Mr. Patel:

This firm represents Lorillard, Inc. and its subsidiaries and affiliates (collectively "Lorillard") in intellectual property matters. Lorillard is the nation's third largest tobacco company and manufactures and sells top quality branded cigarettes and electronic cigarettes, including the famous NEWPORT brand of cigarettes and BLU brand of electronic cigarettes.

Lorillard's electronic cigarettes are sold under the BLU ECIGS®, BLU CIGS™, BLU™, and BLU & Design trademarks (collectively the "BLU Family of Marks"). The BLU Family of Marks distinguish BLU brand electronic cigarettes from other electronic cigarettes and are well-known and instantly recognizable by consumers.

Lorillard has invested substantial time, effort and money in developing the goodwill associated with the BLU Family of Marks. For example, BLU was the first brand of electronic cigarette to sponsor a top 35 car in the NASCAR® Sprint Cup Series. Products featuring the BLU Family of Marks have been given out in gift bags at major events including the Oscars, American Music Awards, and Grammy awards. BLU is featured in national print and television advertising, including but not limited to commercials by its celebrity spokesperson, Stephen Dorff. BLU electronic cigarettes are sold at thousands of retail locations throughout the United States and via the Internet. Due to the extensive distribution and promotion of BLU electronic cigarettes, the BLU Family of Marks are well-known throughout the United States and among the consuming public.

Natu J. Patel  
February 4, 2013  
Page 2

Lorillard actively protects the investment it has made in its BLU Family of Marks. Lorillard has secured a federal registration for its BLU ECIGS mark with the United States Patent and Trademark Office (the "Trademark Office") in connection with "cigarettes containing tobacco substitutes not for medical purposes, electronic cigarettes for use as an alternative to traditional cigarettes, smokeless cigarette vaporizer pipe, and tobacco substitutes" (U.S. Reg. No. 3,846,035). The other marks in the BLU Family of Marks are currently the subject of pending applications before the Trademark Office. Lorillard further monitors the electronic cigarette market to prevent infringing products from damaging the substantial reputation it has built under the BLU Family of Marks.

We have recently learned that Starbuzz Tobacco, Inc. ("Starbuzz") is selling, offering for sale, advertising and/or distributing electronic cigarettes under the mark BLUE MIST (the "Infringing Mark") and has applied to register the Infringing Mark with the Trademark Office in connection with electronic cigarettes (U.S. Ser. No. 85/812,403). A screenshot of the infringing product is enclosed herewith.

Starbuzz's use of the Infringing Mark in connection with the marketing and sale of electronic cigarettes is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association between Starbuzz and Lorillard, and/or is likely to cause confusion, mistake, or deception as to the origin, sponsorship, or approval of the goods or services purveyed by Starbuzz, and Lorillard's goods, services, and commercial activities. As such, Starbuzz's unauthorized marketing and sale of electronic cigarettes under the Infringing Mark violates Lorillard's exclusive rights in its BLU Family of Marks and constitutes, at the very least, trademark infringement and dilution under the Lanham Act, 15 U.S.C. § 1051, *et seq.*

Lorillard intends to vigorously protect its valuable rights in its BLU Family of Marks to the fullest extent possible. When necessary, Lorillard has pursued formal action to protect its rights. For example, in a case very similar to the instant matter, Lorillard pursued and won a consent judgment in the United States District Court for the Western District of North Carolina, Case No. 3:12-cv-00223, against a company selling electronic cigarettes under the infringing AMERICAN BLUE TIP mark. In that matter, the court determined that Lorillard is the sole and exclusive owner of the BLU Family of Marks and has the right to sue upon, and recover damages for past infringement, and enjoin future infringement of the BLU Family of Marks. The court determined that the BLU Family of Marks are valid and enforceable and permanently enjoined the infringer from using the AMERICAN BLUE TIP mark and/or any other confusingly similar mark or device in the sale, offering for sale, distribution or advertising of electronic cigarettes or similar merchandise at any locality in the United States. Lorillard is confident that it will achieve a similar result in any action to enjoin the use of the BLUE MIST mark in connection with the sale, offering for sale, advertising and/or distribution of electronic cigarettes.

Natu J. Patel  
February 4, 2013  
Page 3


In light of the above, we demand that Starbuzz immediately: 1) cease all use of the Infringing Mark; 2) file a request with the Trademark Office for the express abandonment of its application to register the Infringing Mark (U.S. Ser. No. 85/812,403); and 3) enter into a settlement agreement to resolve this matter. Lorillard makes these demands without prejudice to any other remedies available to it under the law, including its rights to actual damages, statutory damages, treble damages, Starbuzz's wrongfully-derived profits and attorneys' fees.

Lorillard hopes that this dispute can be resolved amicably. Prompt acquiescence to Lorillard's demands, however, is a necessary prerequisite to such a resolution. To that end, please contact me by no later than February 15, 2013 to discuss your client's compliance with Lorillard's demands.

I look forward to your prompt response.

Sincerely yours,

**McGUIREWOODS LLP**



George R. Spatz

cc: Chris Howard (Lorillard Tobacco Company)



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Starbuzz Acid Shisha Tobacco

Fantasia Shisha Tobacco

Nakhla Shisha Tobacco

Tangiers Shisha Tobacco

Hydro Herbal Shisha

Al Fakher Arena Tobacco

Tangiers Lucid Shisha Tobacco

Hydro Hookah Vapor Stones

Al Fakher Herbal Shisha

Tangiers F-Line Shisha Tobacco

Mya Rocks Vapor Stones

Social Smoke Shisha Tobacco

Tangiers Birquq Shisha Tobacco

Hookafina Shisha Tobacco

Shlazo Shisha Steam Stones

Hookah-Hookah Tobacco

Tonic Shisha Tobacco

Evolution Tea Herbal Shisha

Inhale Shisha Tobacco

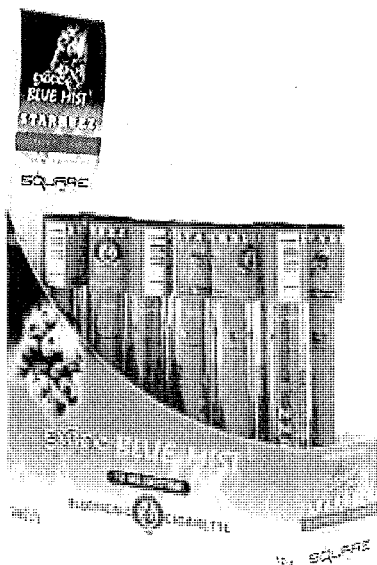
Layalina Shisha Tobacco

Al Amir Shisha Tobacco

## Welcome To Hookah & Shisha Central

### Starbuzz E-Cig Tobacco-Free Electronic Cigarette 12 Pack

Home : Shisha Tobacco > Starbuzz Shisha Tobacco



SKU: BTO-SB-ECig-12Pack

Starbuzz E-Cig 12-Pack Flavor:

blue mist

Starbuzz E-Cig 12-Pack Flavor #2:

None

Starbuzz E-Cig 12-Pack Flavor #3:

None

Price:

\$112.99

List Price: \$131.88

You Save: \$18.89 (14%)

Enter Quantity: 1

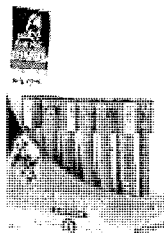
ADD TO SHOPPING CART

You can earn 119 Reward Points on this product!

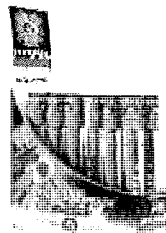


You and 2 others like this. Add a comment 2 people like this. Be the first of your friends.

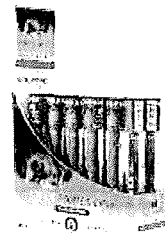
Available Flavors:



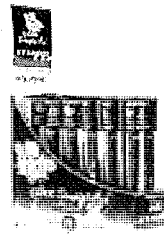
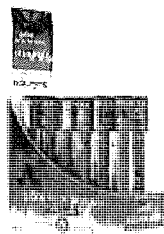
Blue Mist



Irish Peach



Pirate's Cave



Havana Shisha Tobacco

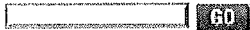
Hypnosis Shisha Tobacco

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#### Sex on the Beach

#### Simply Mint

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**Note:** You must be 18 years of age to purchase this product.

#### Starbuzz E-Cig Tobacco-Free Electronic Cigarette 12 Pack Reviews

Overall Product Feeling: No rating

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# EXHIBIT H



## The Patel Law Firm

A Professional Corporation

2532 Dupont Drive, Irvine, California 92612  
Tel: (949) 955-1077 - Fax: (949) 955-1877  
NPatel@thePatelLawFirm.com

February 15, 2013

**VIA Electronic Mail & US Mail**

gspatz@mcguirewoods.com

George R. Spatz, Esq.  
McGuireWoods LLP  
77 West Wacker Drive  
Suite 4100  
Chicago, IL 6061-1818

**RE: Objection to Use and Application to Register BLUE MIST  
SUBJECT TO FRE 408 - SETTLEMENT COMMUNICATION –  
NOT SUBJECT TO DISCOVERY**

Dear Mr. Spatz:

We represent Starbuzz Tobacco, Inc. (“Starbuzz”) with respect to its intellectual property rights. This letter is in response to your February 4, 2013 letter regarding Lorillard, Inc.’s (“Lorillard”) claims of trademark infringement and dilution. For the reasons that follow, we believe that there is no likelihood of confusion between Starbuzz’s BLUE MIST mark for tobacco products (Reg. No. 3619407) (the “BLUE MIST Mark”) and Lorillard’s “BLU” family of marks (the “BLU Marks”). In fact, the representations by the original owner of the BLU Marks, BLEC, LLC (“BLEC”), estop Lorillard from claiming that Starbuzz’s use of the BLUE MIST Mark is likely to cause confusion.

**I. THERE IS NO LIKELIHOOD OF CONFUSION BETWEEN THE MARKS BECAUSE OF NUMEROUS THIRD PARTY USERS OF “BLUE” FOR TOBACCO PRODUCTS**

As you know, the Seventh and Ninth Circuits analyze likelihood of confusion based upon a variety of factors. See *Autozone, Inc. v. Strick*, 543 F.3d 923, 929 (7th Cir. 2008); *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997). Both circuits evaluate the strength of the plaintiff’s mark, as well as the similarity between the marks as used in commerce.



George R. Spatz, Esq.

RE: Objection to Use and Application to Register BLUE MIST

SUBJECT TO FRE 408 - SETTLEMENT COMMUNICATION – NOT SUBJECT TO DISCOVERY

February 15, 2013

**A. Numerous Third Party Use Demonstrates that the BLU Marks are Weak.**

One of the most important factors to be analyzed is the strength of the mark. The BLU Marks contain the sole term “BLU”. But Lorillard does not have the exclusive right to use the term “BLUE” for tobacco products because there are numerous third party users of the term “BLUE” for tobacco products. Indeed, even an arbitrary mark may be classified as weak where there has been extensive third party use of similar marks on similar goods. *Matrix Motor Co. v. Toyota Jidosha Kabushiki*, 290 F. Supp. 2d 1083, 1091 (C.D. Cal. 2003); *Westward Coach Manufacturing Co. v. Ford Motor Co.*, 388 F.2d 627, 632 (7th Cir. 1968) (finding that the mark was weak due to extensive prior and concurrent use of the mark on a wide variety of products and the extensive prior registration of the mark for a variety of products); *S Industries, Inc. v. JI Audio, Inc.*, 29 F. Supp. 2d 878, 892-93 (N.D. Ill. 1998).

In this case, there are approximately thirty-nine (39) live registered marks containing the terms “BLU” or “BLUE” in Class 034, in addition to approximately twenty-three (23) live applications to register marks with “BLU” or “BLUE” in Class 034. Outside of Class 034, there are approximately two hundred and eighty-six (286) live, registered marks containing “BLU” or “BLUE”. The numerous third party use of the term “BLUE” demonstrates that the BLU Marks are incredibly weak. Therefore, confusion is unlikely.

**B. Confusion is Unlikely Because the BLU Marks are Weak, Descriptive Marks.**

Confusion is also unlikely because the BLU Marks are weak, descriptive marks. A merely descriptive mark is inherently much weaker than a suggestive mark and less deserving of trademark protection. *MFG CORP. v. Emra Corp.*, 626 F. Supp. 699, 703-05 (N.D. Ill. 1985).

Here, both the USPTO and BLEC noted that the BLU Marks are used in connection with electronic cigarettes with a blue LED that lights up when a user takes a drag. The USPTO thus refused registration of the BLU Marks on the grounds that they are merely descriptive, under Section 2(e)(1) of the Lanham Act. BLEC was only able to overcome this refusal by arguing that the marks had acquired distinctiveness under Section 2(f). BLEC, however, failed to provide any evidence to demonstrate that the marks had in fact acquired such distinctiveness. Accordingly, the evidence at hand demonstrates that the BLU Marks are weak, descriptive marks. Since the BLU Marks are weak, consumer confusion is not likely.

**C. Confusion is Not Likely Because the Only Similarity Between the Marks is in a Weak, Descriptive Term.**

The only similarity between the BLUE MIST Mark and the BLU Marks is in the terms “BLUE” and “BLU”. As explained *supra*, the term “BLU” is weak and descriptive

George R. Spatz, Esq.  
 RE: Objection to Use and Application to Register BLUE MIST  
 SUBJECT TO FRE 408 - SETTLEMENT COMMUNICATION – NOT SUBJECT TO DISCOVERY

February 15, 2013

of Lorillard's products. Thus, the addition of the term "MIST" changes the appearance, pronunciation and meaning of the marks enough to avoid a likelihood of confusion.

**D. Confusion is Not Likely Because there is No Similarity Between the Marks as Used in the Marketplace.**

There is no likelihood of confusion between the marks as they are used in the marketplace. The courts evaluate similarity in light of what happens in the marketplace, rather than just by making a side-by-side comparison. *Am General Corporation v. Daimlerchrysler Corporation*, 311 F.3d 796, 825 (7th Cir. 2002); *Filipino Yellow Pages, Inc. v. Asian Journal Publications, Inc.*, 198 F.3d 1143, 1147-50 (9th Cir. 1999) (judging similarity by reference to the marks' appearance, sound, and meaning).

Here, there is no similarity between the BLUE MIST Mark and the BLU Marks, as used in the marketplace. As shown in the attached **Exhibit A**, the label for products bearing the BLUE MIST Mark is completely different from the label of the products bearing the BLU Marks. The fonts, colors, background, arrangement, and pictures are completely different. Additionally, the BLUE MIST Mark is accompanied by the Starbuzz Tobacco name and logo, reducing the likelihood of confusion.

**II. LORILLARD IS ESTOPPED FROM CLAIMING THAT THE BLUE MIST MARK IS LIKELY TO BE CONFUSED WITH THE BLU MARKS.**

The representations of the original owner of the BLU Marks, BLEC, also estop Lorillard from claiming that Starbuzz's use of the BLUE MIST Mark is likely to cause confusion with the BLU Mark. Judicial estoppel, sometimes also known as the doctrine of preclusion of inconsistent positions, precludes a party from gaining an advantage by taking one position, and then seeking a second advantage by taking an incompatible position. *Wagner v. Professional Eng'Rs in Cal. Gov't*, 354 F.3d 1036, 1044 (9th Cir. 2004). For judicial estoppel to apply, a party's position must first be clearly inconsistent with a position earlier taken. *Jarrard v. Cdi Telecommunications, Inc.*, 408 F.3d 905, 914 (7th Cir. 2005) Second, the party must have prevailed on the basis of its earlier position "so that judicial acceptance of an inconsistent position in a later proceeding would create the perception that either the first or the second court was misled." *Id.*

Here, the USPTO originally refused registration of the BLU ECIGS mark because it was likely to cause confusion with the BLUE MOON mark. In its December 3, 2009 response, BLEC took the position that there was no likelihood of confusion because there were third party registrations in Class 034 containing "BLUE". **One of the third party marks BLEC cited was Starbuzz's "BLUE MIST" Mark.**

Similarly, the USPTO initially refused registration of the BLU CIGS (Serial No. 85092665), BLU (Serial No. 85131287) and BLU & Design (Serial No. 85131965) marks, on the grounds that they were likely to be confused with Zippmark, Inc.'s BLU

George R. Spatz, Esq.  
RE: Objection to Use and Application to Register BLUE MIST  
SUBJECT TO FRE 408 - SETTLEMENT COMMUNICATION - NOT SUBJECT TO DISCOVERY

February 15, 2013

trademark registrations (Reg. Nos. 3680360, 3299190, 3469390). In responding to these office actions, BLEC again represented that there was no likelihood of confusion because of third party use, citing to Starbuzz's BLUE MIST Mark.

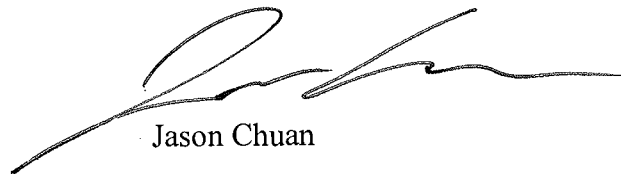
In making the foregoing representations, BLEC was relying on the rule that "Evidence of third-party use of similar marks on similar goods is relevant to show that a mark is relatively weak and entitled to only a narrow scope of protection." *Palm Bay Imports v. Veuve Clicquot Ponsardin*, 396 F.3d 1369, 1373 (Fed. Cir. 2005). Thus, BLEC took the position that Starbuzz's BLUE MIST Mark was similar to the BLU Marks, and was used on similar goods. To avoid a section 2(d) refusal based upon the BLUE MIST Mark, BLEC must have also taken the position that the BLUE MIST Mark was not confusingly similar to the BLU Marks.

Relying upon BLEC's positions, the USPTO allowed the BLU ECIGS mark to register, and published the BLU CIGS, BLU and BLU & Design marks for opposition. Therefore, BLEC and any subsequent owners of the BLU Marks, including Lorillard, are judicially estopped from claiming that the BLUE MIST Mark is likely to be confused with the BLU Marks.

In light of the facts stated above, we believe that there is no likelihood of confusion. Therefore, Lorillard should cease its attempts to assert rights in the BLU Marks against Starbuzz. We look forward to hearing from you at your convenience on or before **March 1, 2013**, regarding Lorillard's decision.

Please note that all of Starbuzz's rights, remedies, legal and factual positions, above and beyond those stated herein, are expressly reserved. If you have any questions, or concerns, please feel free to call me.

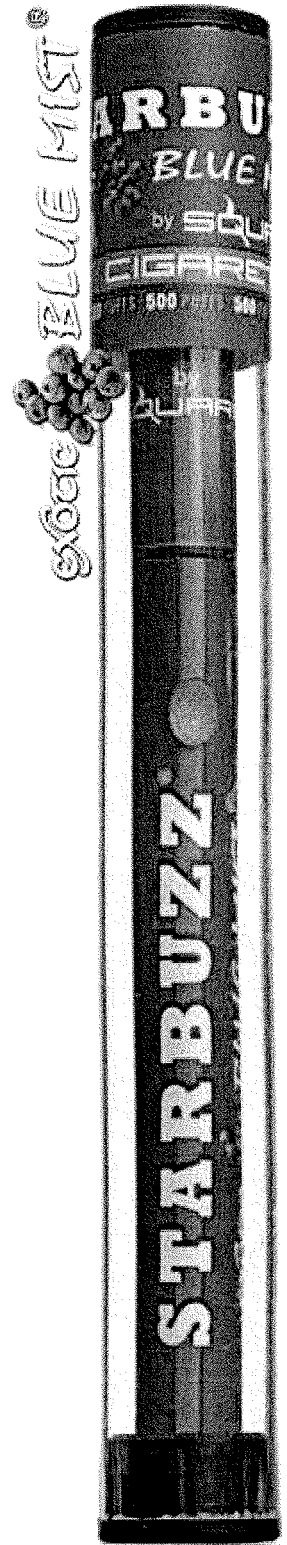
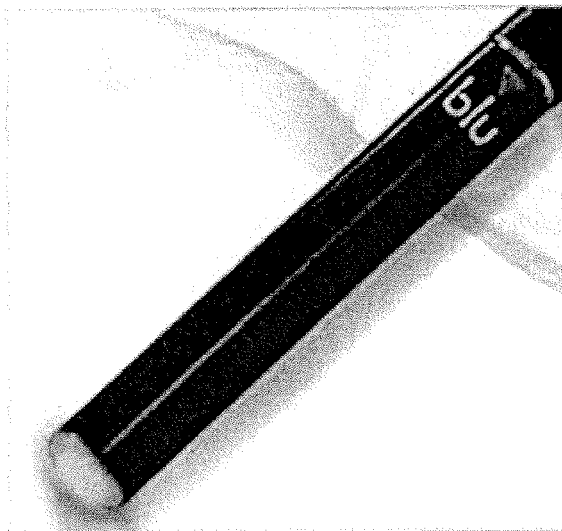
Very truly yours,  
THE PATEL LAW FIRM, P.C.



Jason Chuan

Enclosures  
NJP/JC/dn

# **EXHIBIT A**



# EXHIBIT I

McGuireWoods LLP  
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Fax: 312.849.3690  
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GEORGE R. SPATZ  
Direct: 312.321.7676

McGUIREWOODS

gspatz@mcguirewoods.com  
Direct Fax: 312.698.4584

March 1, 2013

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**BY U.S. MAIL AND E-MAIL**

Jason Chuan  
THE PATEL LAW FIRM, P.C.  
2532 Dupont Drive  
Irvine, CA 92612  
[NPatel@thePatelLawFirm.com](mailto:NPatel@thePatelLawFirm.com)

**Re: Starbuzz Tobacco, Inc.'s Infringing Use of and Application to  
Register the BLUE MIST Mark (U.S. Ser. No. 85/812,403)**

Dear Mr. Chuan:

We are in receipt of your letter dated February 15, 2013 which responds to our letter of February 4, 2013 regarding Starbuzz's infringing use and application to register the BLUE MIST mark. As discussed further below, we do not agree with the conclusions stated in your letter—that there is no likelihood of confusion between Lorillard's BLU Family of Marks and the BLUE MIST mark used in connection with electronic cigarettes. Your claim that Lorillard is somehow estopped from claiming a likelihood of confusion is incorrect as a matter of law.

In your letter, you assert that Lorillard's marks are weak and descriptive. To the contrary, Lorillard's BLU Family of Marks are not weak, nor are they descriptive. Lorillard's BLU electronic cigarettes were the first brand of electronic cigarettes to adopt a distinctive blue LED tip in the United States. However, a blue LED is not a necessary feature or characteristic of Lorillard's products or, for that matter, of any electronic cigarette or of any components or accessories associated with electronic cigarettes such as batteries, refill cartridges, cartomizers, cases and chargers. The fact that many other electronic cigarette brands have copied BLU's distinctive blue LED does not make Lorillard's BLU Family of Marks descriptive. BLU, as applied to electronic cigarettes, is arbitrary.

Lorillard's BLU Family of Marks are strong marks. Lorillard has built the BLU brand through substantial investment in advertising and promotion, several examples of which were provided to you in our February 4, 2013 letter. As a result, the BLU Family of Marks are well-known and instantly recognizable by electronic cigarette consumers. Simply put, BLU has established itself as one of the top and most recognizable brands



Mr. Jason Chuan

March 1, 2013

Page 2

of electronic cigarettes in the market. The existence of blue-formative marks in IC 034 in connection with products other than electronic cigarettes does not weaken the strength of Lorillard's BLU Family of Marks. Electronic cigarettes are a distinct class of goods from cigarettes, lighters, ashtrays and other goods lumped together in IC 034. Starbuzz's use of the BLUE MIST mark on electronic cigarettes—identical goods as those provided by Lorillard under its BLU Family of Marks—is likely to cause confusion and constitutes infringement.

Lorillard further disagrees with your assertion that the manner in which the BLUE MIST mark is used in the marketplace significantly alters the likelihood of confusion analysis. Consumers encountering these marks separately in the marketplace (not comparing the marks side-by-side as set out in your Exhibit A) will understand that Starbuzz is promoting a BLU brand of cigarette and are likely to be confused. The use of the Starbuzz name does not mitigate such confusion. First, the Starbuzz name is not universally used in association with the BLUE MIST mark. Second, it is not uncommon in the marketplace for electronic cigarettes to be sold through affiliate sales outlets or other distribution channels. For example, Starbuzz's electronic cigarettes are sold online at the Hookah Company, Xhale and Square. Accordingly, the use of a separate brand name would not automatically diminish consumer confusion. Moreover, Starbuzz has applied for BLUE MIST as a word mark. Any decorative or ornamental aspects of Starbuzz's mark or characteristics of Starbuzz's marketing are not relevant to the USPTO's likelihood of confusion analysis.<sup>1</sup>

Finally, Lorillard is not estopped from enforcing and protecting its marks. As trademark rights are based on use and the monopoly concerns associated with patent prosecution are not applicable to the trademark context, the USPTO has consistently held that "file wrapper estoppel" is not a defense in the trademark setting. See, e.g., *Watercare Corp. v. Midwesco-Enterprise, Inc.*, 171 U.S.P.Q. 696, 700 (TTAB 1971) (specifically emphasizing that "a mark can increase in stature and what was originally descriptive and weak can become distinctive and strong and the scope of protection afforded thereto greater, rather than limited"). Lorillard has strong rights in its BLU Family of Marks and such rights are only getting stronger through Lorillard's extensive use and promotion of the marks. Lorillard will not be prohibited from demonstrating the strength of its marks. Starbuzz's estoppel arguments are wrong as a matter of law.

In light of the above, we repeat our demand that Starbuzz immediately: 1) cease all use of the Infringing Mark; 2) file a request with the Trademark Office for the express abandonment of its application to register the Infringing Mark (U.S. Ser. No. 85/812,403); and 3) enter into a settlement agreement to resolve this matter.

---

<sup>1</sup> We further note that Starbuzz is engaged in marketplace fraud by using a ® in connection with the BLUE MIST mark on electronic cigarettes. Starbuzz does not own a federal registration for the BLUE MIST mark in connection with electronic cigarettes and is intentionally deceiving consumers by asserting more expansive rights than it has.



Mr. Jason Chuan

March 1, 2013

Page 3

Lorillard makes the above demands without prejudice to any other remedies available to it under the law, including its rights to actual damages, statutory damages, treble damages, Starbuzz's wrongfully-derived profits and attorneys' fees.

Please contact me at your earliest convenience to discuss your client's compliance with Lorillard's demands and to negotiate a reasonable phase out of Starbuzz's use of the BLUE MIST mark. I look forward to hearing from you.

Sincerely yours,

**MCGUIREWOODS LLP**



George R. Spatz

cc: Chris Howard (Lorillard Tobacco Company)

# EXHIBIT J

## The Patel Law Firm

A Professional Corporation

2532 Dupont Drive, Irvine, California 92612

Tel: (949) 955-1077 - Fax: (949) 955-1877

NPatel@thePatelLawFirm.com

March 8, 2013

**Via E-Mail & Priority Mail**

gspatz@mcguirewoods.com

George R. Spatz, Esq.  
McGuire Woods LLP  
77 West Wacker Drive, Suite 4100  
Chicago, IL 6061-1818

**RE: Starbuzz Tobacco, Inc. v. Lorillard, Inc., et al.**  
**Case No. SACV 13-00411 CJC (ANx)**

Dear Mr. Spatz:

This is in response to your March 1, 2012 letter. We have reviewed the letter and disagree with Lorillard's allegations.

We are disappointed that Lorillard has taken such an aggressive position against Starbuzz, when there is no likelihood of consumer confusion between the parties' products. Additionally, Lorillard's position that Starbuzz is intentionally deceiving consumers by placing the ® symbol on its electronic cigarettes is untenable. A common reason why allegedly improper use of the federal registration symbol does not indicate fraud is registration of the mark for other goods. *See* TMEP § 906.02, *citing Duffy-Mott Co., Inc. v. Cumberland Packing Co.*, 424 F.2d 1095, 165 U.S.P.Q. 422 (C.C.P.A. 1970), *aff'd* 154 U.S.P.Q. 498 (TTAB 1967); *Meditron Co. v. Meditronic, Inc.*, 137 U.S.P.Q. 157 (TTAB 1963). The following facts demonstrate that there was no deceptive intent:

- 1) Starbuzz registered the BLUE MIST ® trademark (Reg. No. 3619407) for tobacco products in Class 034 years before selling electronic cigarettes under the BLUE MIST mark.
- 2) Starbuzz has expanded its use of the BLUE MIST ® trademark internationally by obtaining foreign trademark registrations in over ten (10) countries, including the entire European Union, and has pending applications in various other countries.
- 3) Starbuzz is also the owner of the registered BLUE MIST ® trademark for candles (Reg. No. 4091743).

George R. Spatz, Esq.

RE: Objection to Use and Application to Register BLUE MIST

SUBJECT TO FRE 408 - SETTLEMENT COMMUNICATION - NOT SUBJECT TO DISCOVERY

March 8, 2013

4) Starbuzz has taken steps to ensure that, going forward, the ® is omitted from new labels for BLUE MIST electronic cigarettes.

Based upon the foregoing facts, Lorillard's position is without merit.

Because of Lorillard's unreasonable position, Starbuzz has no choice but to seek a declaratory relief action in the Central District of California. Attached is a courtesy copy of the Complaint. Even though we have filed the Complaint, we are open to an amicable resolution if Lorillard is also open to the same.

Should you have any questions, or wish to discuss this matter further, please feel free to call me.

Very truly yours,  
THE PATEL LAW FIRM, P.C.



Natu J. Patel

Enclosures  
NJP/CF/dn

## Name &amp; Address:

Natu J. Patel (SBN 188618)  
 THE PATEL LAW FIRM, P.C.  
 2532 Dupont Drive, Irvine, California 92612  
 Tel.: (949) 955-1077 Fax: (949) 955-1877  
 NPatel@thePatelLawFirm.com

UNITED STATES DISTRICT COURT  
 CENTRAL DISTRICT OF CALIFORNIA

STARBUZZ TOBACCO, INC., a California  
 corporation,

PLAINTIFF(S)

v.

LORILLARD, INC., a Delaware corporation, and  
 LORILLARD TECHNOLOGIES, INC., a North  
 Carolina corporation,

DEFENDANT(S).

CASE NUMBER

SACV 13 - 00411 CJC (ANx)

SUMMONS

TO: DEFENDANT(S):

A lawsuit has been filed against you.

Within 21 days after service of this summons on you (not counting the day you received it), you must serve on the plaintiff an answer to the attached ☒ complaint ☐ \_\_\_\_\_ amended complaint ☐ counterclaim ☐ cross-claim or a motion under Rule 12 of the Federal Rules of Civil Procedure. The answer or motion must be served on the plaintiff's attorney, Natu J. Patel, whose address is The Patel Law Firm, P.C., 2532 Dupont Drive, Irvine, California 92612. If you fail to do so, judgment by default will be entered against you for the relief demanded in the complaint. You also must file your answer or motion with the court.

Clerk, U.S. District Court

Dated: 3/8/13By: DENISE VO  
Deputy Clerk

(Seal of the Court)

[Use 60 days if the defendant is the United States or a United States agency, or is an officer or employee of the United States. Allowed 60 days by Rule 12(a)(3)].

UNITED STATES DISTRICT COURT CENTRAL DISTRICT OF CALIFORNIA  
CIVIL COVER SHEET**I. (a) PLAINTIFFS** ( Check box if you are representing yourself ☐ )

STARBUZZ TOBACCO, INC., a California corporation,

**DEFENDANTS** ( Check box if you are representing yourself ☐ )

LORILLARD, INC., a Delaware corporation, and LORILLARD TECHNOLOGIES, INC., a North Carolina corporation,

(b) Attorneys (Firm Name, Address and Telephone Number. If you are representing yourself, provide same.)

Natu J. Patel (SBN 188618)  
THE PATEL LAW FIRM, P.C.  
2532 Dupont Drive, Irvine, CA 92612  
Telephone: (949) 955-1077 Facsimile: (949) 955-1877

(b) Attorneys (Firm Name, Address and Telephone Number. If you are representing yourself, provide same.)

**II. BASIS OF JURISDICTION** (Place an X in one box only.)

- ☐ 1. U.S. Government Plaintiff
- ☒ 3. Federal Question (U.S. Government Not a Party)
- ☐ 2. U.S. Government Defendant
- ☐ 4. Diversity (Indicate Citizenship of Parties in Item III)

**III. CITIZENSHIP OF PRINCIPAL PARTIES-For Diversity Cases Only**  
(Place an X in one box for plaintiff and one for defendant)

- |   |                                |                                |   |                                |                                |
|---|--------------------------------|--------------------------------|---|--------------------------------|--------------------------------|
| Citizen of This State                   | PTF <input type="checkbox"/> 1 | DEF <input type="checkbox"/> 1 | Incorporated or Principal Place of Business in this State     | PTF <input type="checkbox"/> 4 | DEF <input type="checkbox"/> 4 |
| Citizen of Another State                | <input type="checkbox"/> 2     | <input type="checkbox"/> 2     | Incorporated and Principal Place of Business in Another State | <input type="checkbox"/> 5     | <input type="checkbox"/> 5     |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3     | <input type="checkbox"/> 3     | Foreign Nation  | <input type="checkbox"/> 6     | <input type="checkbox"/> 6     |

**IV. ORIGIN** (Place an X in one box only.)

- ☒ 1. Original Proceeding
- ☐ 2. Removed from State Court
- ☐ 3. Remanded from Appellate Court
- ☐ 4. Reinstated or Reopened
- ☐ 5. Transferred from Another District (Specify)
- ☐ 6. Multi-District Litigation

**V. REQUESTED IN COMPLAINT: JURY DEMAND:** ☒ Yes ☐ No (Check "Yes" only if demanded in complaint.)**CLASS ACTION under F.R.Cv.P. 23:** ☐ Yes ☒ No **MONEY DEMANDED IN COMPLAINT:** \$ To be determined at trial**VI. CAUSE OF ACTION** (Cite the U.S. Civil Statute under which you are filing and write a brief statement of cause. Do not cite jurisdictional statutes unless diversity.)**VII. NATURE OF SUIT** (Place an X in one box only.)

OTHER STATUTES	CONTRACT	REAL PROPERTY CONT.	IMMIGRATION	PRISONER PETITIONS	PROPERTY RIGHTS
<input type="checkbox"/> 375 False Claims Act	<input type="checkbox"/> 110 Insurance	<input type="checkbox"/> 240 Torts to Land	<input type="checkbox"/> 462 Naturalization Application	<input type="checkbox"/> 463 Alien Detainee	<input type="checkbox"/> 820 Copyrights
<input type="checkbox"/> 400 State Reapportionment	<input type="checkbox"/> 120 Marine	<input type="checkbox"/> 245 Tort Product Liability	<input type="checkbox"/> 465 Other Immigration Actions	<input type="checkbox"/> 510 Motions to Vacate Sentence	<input type="checkbox"/> 830 Patent
<input type="checkbox"/> 410 Antitrust	<input type="checkbox"/> 130 Miller Act	<input type="checkbox"/> 290 All Other Real Property	<b>TORTS</b>	<input type="checkbox"/> 530 General	<input checked="" type="checkbox"/> 840 Trademark
<input type="checkbox"/> 430 Banks and Banking	<input type="checkbox"/> 140 Negotiable Instrument	<b>PERSONAL INJURY</b>	<b>PERSONAL PROPERTY</b>	<input type="checkbox"/> 535 Death Penalty	<b>SOCIAL SECURITY</b>
<input type="checkbox"/> 450 Commerce/ICC Rates/Etc.	<input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment	<input type="checkbox"/> 310 Airplane	<input type="checkbox"/> 370 Other Fraud	<b>Other:</b>	<input type="checkbox"/> 861 HIA (1395ff)
<input type="checkbox"/> 460 Deportation	<input type="checkbox"/> 151 Medicare Act	<input type="checkbox"/> 315 Airplane Product Liability	<input type="checkbox"/> 371 Truth in Lending	<input type="checkbox"/> 540 Mandamus/Other	<input type="checkbox"/> 862 Black Lung (923)
<input type="checkbox"/> 470 Racketeer Influenced & Corrupt Org.	<input type="checkbox"/> 152 Recovery of Defaulted Student Loan (Excl. Vet.)	<input type="checkbox"/> 320 Assault, Libel & Slander	<input type="checkbox"/> 380 Other Personal Property Damage	<input type="checkbox"/> 550 Civil Rights	<input type="checkbox"/> 863 DIWC/DIWW (405 (g))
<input type="checkbox"/> 480 Consumer Credit	<input type="checkbox"/> 153 Recovery of Overpayment of Vet. Benefits	<input type="checkbox"/> 330 Fed. Employers' Liability	<input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 555 Prison Condition	<input type="checkbox"/> 864 SSID Title XVI
<input type="checkbox"/> 490 Cable/Sat TV	<input type="checkbox"/> 160 Stockholders' Suits	<input type="checkbox"/> 340 Marine	<b>BANKRUPTCY</b>	<input type="checkbox"/> 560 Civil Detainee Conditions of Confinement	<input type="checkbox"/> 865 RSI (405 (g))
<input type="checkbox"/> 850 Securities/Commodities/Exchange	<input type="checkbox"/> 190 Other Contract	<input type="checkbox"/> 345 Marine Product Liability	<input type="checkbox"/> 422 Appeal 28 USC 158	<b>FORFEITURE/PENALTY</b>	<b>FEDERAL TAX SUITS</b>
<input type="checkbox"/> 890 Other Statutory Actions	<input type="checkbox"/> 195 Contract Product Liability	<input type="checkbox"/> 350 Motor Vehicle	<input type="checkbox"/> 423 Withdrawal 28 USC 157	<input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881	<input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant)
<input type="checkbox"/> 891 Agricultural Acts	<input type="checkbox"/> 196 Franchise	<input type="checkbox"/> 355 Motor Vehicle Product Liability	<b>CIVIL RIGHTS</b>	<input type="checkbox"/> 690 Other	<input type="checkbox"/> 871 IRS-Third Party 26 USC 7609
<input type="checkbox"/> 893 Environmental Matters	<b>REAL PROPERTY</b>	<input type="checkbox"/> 360 Other Personal Injury	<input type="checkbox"/> 440 Other Civil Rights	<b>LABOR</b>	
<input type="checkbox"/> 895 Freedom of Info. Act	<input type="checkbox"/> 210 Land Condemnation	<input type="checkbox"/> 362 Personal Injury-Med Malpractice	<input type="checkbox"/> 441 Voting	<input type="checkbox"/> 710 Fair Labor Standards Act	
<input type="checkbox"/> 896 Arbitration	<input type="checkbox"/> 220 Foreclosure	<input type="checkbox"/> 365 Personal Injury-Product Liability	<input type="checkbox"/> 442 Employment	<input type="checkbox"/> 720 Labor/Mgmt. Relations	
<input type="checkbox"/> 899 Admin. Procedures Act/Review of Appeal of Agency Decision	<input type="checkbox"/> 230 Rent Lease & Ejectment	<input type="checkbox"/> 367 Health Care/Pharmaceutical Personal Injury Product Liability	<input type="checkbox"/> 443 Housing/Accommodations	<input type="checkbox"/> 740 Railway Labor Act	
<input type="checkbox"/> 950 Constitutionality of State Statutes		<input type="checkbox"/> 368 Asbestos Personal Injury Product Liability	<input type="checkbox"/> 445 American with Disabilities-Employment	<input type="checkbox"/> 751 Family and Medical Leave Act	
			<input type="checkbox"/> 446 American with Disabilities-Other	<input type="checkbox"/> 790 Other Labor Litigation	
			<input type="checkbox"/> 448 Education	<input type="checkbox"/> 791 Employee Ret. Inc. Security Act	

FOR OFFICE USE ONLY: Case Number: SACV 13 - 00411 CJC (ANx)

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Natu J. Patel, SBN 188618  
 Jason Chuan, SBN 261868  
 Carla A. Federis, SBN 266611  
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Attorneys for Plaintiff,  
 Starbuzz Tobacco, Inc.,  
 a California corporation

**UNITED STATES DISTRICT COURT  
 CENTRAL DISTRICT OF CALIFORNIA**

STARBUZZ TOBACCO, INC., a  
 California corporation,

Plaintiff,

vs.

LORILLARD, INC., a Delaware  
 corporation, and LORILLARD  
 TECHNOLOGIES, INC., a North  
 Carolina corporation,

Defendants.

) Case No.:

) SACV 13 - 00411 CJC (ANx)

) **COMPLAINT FOR:**

) **1. DECLARATORY**  
 ) **JUDGMENT FOR NON-**  
 ) **INFRINGEMENT OF**  
 ) **TRADEMARKS; AND**

) **2. DECLARATORY**  
 ) **JUDGMENT FOR NON-**  
 ) **DILUTION OF**  
 ) **TRADEMARKS**

) **DEMAND FOR JURY TRIAL**

# EXHIBIT K





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# BLUE MIST

<b>Word Mark</b>	<b>BLUE MIST</b>
<b>Goods and Services</b>	IC 034. US 002 008 009 017. G & S: Tobacco substitute. FIRST USE: 20130328. FIRST USE IN COMMERCE: 20130328
<b>Standard Characters Claimed</b>	
<b>Mark Drawing Code</b>	(4) STANDARD CHARACTER MARK
<b>Serial Number</b>	86111155
<b>Filing Date</b>	November 5, 2013
<b>Current Basis</b>	1A
<b>Original Filing Basis</b>	1A
<b>Owner</b>	(APPLICANT) Starbuzz Tobacco, Inc. CORPORATION CALIFORNIA 10871 Forbes Ave Garden Grove CALIFORNIA 92843
<b>Type of Mark</b>	TRADEMARK
<b>Register</b>	PRINCIPAL
<b>Live/Dead Indicator</b>	LIVE

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**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*( Use the "Back" button of the Internet Browser to return to TESS)***BLUE MIST****Word Mark** BLUE MIST**Goods and Services** IC 001. US 001 005 006 010 026 046. G & S: Cartridges sold filled with propylene glycol for electronic cigarettes; Cartridges sold filled with vegetable glycerin for electronic cigarettes. FIRST USE: 20130712. FIRST USE IN COMMERCE: 20130712**Standard Characters Claimed****Mark****Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 86111645**Filing Date** November 6, 2013**Current Basis** 1A**Original Filing Basis** 1A**Owner** (APPLICANT) Starbuzz Tobacco, Inc. CORPORATION CALIFORNIA 10871 Forbes Ave Garden Grove CALIFORNIA 92843**Type of Mark** TRADEMARK**Register** PRINCIPAL**Live/Dead Indicator** LIVE

Exhibit L, Page 80

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**Record 1 out of 1**[TSDR](#)[ASSIGN Status](#)[TTAB Status](#)*( Use the "Back" button of the Internet Browser to return to TESS)***BLUE MIST****Word Mark** BLUE MIST**Goods and Services** IC 030. US 046. G & S: Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges. FIRST USE: 20130712. FIRST USE IN COMMERCE: 20130712**Standard Characters Claimed****Mark Drawing Code** (4) STANDARD CHARACTER MARK**Serial Number** 86111093**Filing Date** November 5, 2013**Current Basis** 1A**Original Filing Basis** 1A**Owner** (APPLICANT) Starbuzz Tobacco, Inc. CORPORATION CALIFORNIA 10871 Forbes Ave Garden Grove CALIFORNIA 92843**Type of Mark** TRADEMARK**Register** PRINCIPAL**Live/Dead Indicator** LIVE[TESS HOME](#) | [NEW USER](#) | [STRUCTURED](#) | [FREE FORM](#) | [BROWSE DICT](#) | [SEARCH OG](#) | [TOP](#) | [HELP](#)[HOME](#) | [SITE INDEX](#) | [SEARCH](#) | [eBUSINESS](#) | [HELP](#) | [PRIVACY POLICY](#)





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# MELON BLUE

**Word Mark** MELON BLUE

**Goods and Services** IC 030. US 046. G & S: Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges. FIRST USE: 20131108. FIRST USE IN COMMERCE: 20131108

**Standard Characters Claimed**

**Mark**

**Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 86113590

**Filing Date** November 8, 2013

**Current Basis** 1A

**Original Filing Basis** 1A

**Owner** (APPLICANT) Starbuzz Tobacco, Inc. CORPORATION CALIFORNIA 10871 Forbes Ave Garden Grove CALIFORNIA 92843

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead** LIVE

Indicator

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# BLUE SURFER

**Word Mark** BLUE SURFER

**Goods and Services** IC 030. US 046. G & S: Chemical flavorings in liquid form used to refill electronic cigarette cartridges; Electronic cigarette liquid (e-liquid) comprised of flavorings in liquid form used to refill electronic cigarette cartridges. FIRST USE: 20131108. FIRST USE IN COMMERCE: 20131108

**Standard Characters Claimed**

**Mark**

**Drawing Code** (4) STANDARD CHARACTER MARK

**Serial Number** 86113657

**Filing Date** November 8, 2013

**Current Basis** 1A

**Original Filing Basis** 1A

**Owner** (APPLICANT) Starbuzz Tobacco, Inc. CORPORATION CALIFORNIA 10871 Forbes Ave Garden Grove CALIFORNIA 92843

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead** LIVE

Indicator

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# **EXHIBIT F**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**

Natu J. Patel, SBN 188618  
 Jason Chuan, SBN 261868  
 Carla A. Federis, SBN 266611  
**THE PATEL LAW FIRM, P.C.**  
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 Phone: 949.955.1077  
 Facsimile: 949.955.1877  
 NPatel@thePatelLawFirm.com

Attorneys for Plaintiff and Counter-Defendant,  
 Starbuzz Tobacco, Inc.

**UNITED STATES DISTRICT COURT  
 CENTRAL DISTRICT OF CALIFORNIA**

STARBUZZ TOBACCO, INC., a	)	Case No.: 8:13-cv-00411-CJC-(ANx)
California corporation,	)	<b>Honorable Cormac J. Carney</b>
	)	
Plaintiff,	)	
	)	
vs.	)	<b>STARBUZZ TOBACCO, INC.'S</b>
	)	<b>ANSWER TO LOEC, INC.'S</b>
	)	<b>COUNTERCLAIMS;</b>
LOEC, INC., a Delaware corporation,	)	<b>AFFIRMATIVE DEFENSES</b>
	)	
Defendant.	)	
	)	
	)	
And Related Counterclaims.	)	
	)	
	)	
	)	



1 Plaintiff and Counter-Defendant Starbuzz Tobacco, Inc. (“Starbuzz”) hereby  
2 answers Defendant and Counterclaimant LOEC, Inc.’s (“LOEC”) Counterclaims  
3 (“Counterclaims”) on file herein and admits, denies, and avers as follows:  
4

5 **NATURE OF THE ACTION**

6 1. With respect to the allegations of paragraph 1 of the Counterclaims,  
7  
8 Starbuzz denies that its trademarks employing the term “BLUE” are likely to cause  
9 consumer confusion with LOEC’s BLU CIGS, BLU, and BLU (design) marks.  
10  
11 Starbuzz further denies that it has violated federal unfair competition law, that it  
12 has committed California common law trademark infringement, and that it has  
13 violated California unfair competition laws. Starbuzz admits that an action on  
14 these allegations has been filed.  
15

16 2. With respect to the allegations of paragraph 2 of the Counterclaims,  
17  
18 Starbuzz denies that LOEC has created an association and substantive goodwill  
19 with its marks. As to the other allegations, Starbuzz is without information  
20 sufficient to form a belief as to the truth of falsity of the allegations thereof and  
21 therefore denies the same.  
22

23 3. With respect to the allegations of paragraph 3 of the Counterclaims,  
24  
25 Starbuzz admits that its business includes the manufacturing and selling tobacco  
26 and hookah products, and that it has used the marks “BLUE MIST,” “MELON  
27  
28

1 BLUE,” and “BLUE SURFER.” Starbuzz denies the remaining allegations of  
2 paragraph 3 of the Counterclaims.

3 4. Starbuzz admits the allegations of paragraph 4 of the Counterclaims.

5 5. Starbuzz admits the allegations of paragraph 5 of the Counterclaims.

6 6. With respect to the allegations of paragraph 6 of the Counterclaims,  
7  
8 Starbuzz admits that this Court has personal jurisdiction over Starbuzz. Starbuzz  
9 denies the remaining allegations of paragraph 6 of the Counterclaims.

#### 10 **THE PARTIES**

11  
12 7. With respect to the allegations of paragraph 7 of the Counterclaims,  
13  
14 Starbuzz is without information sufficient to form a belief as to the truth or falsity  
15 of the allegations thereof and therefore denies the same.

16 8. Starbuzz admits the allegations of paragraph 8 of the Counterclaims.

#### 17 **GENERAL ALLEGATIONS**

##### 18 **LOEC’s Well-Known BLU Family of Marks**

19  
20 9. With respect to the allegations of paragraph 9 of the Counterclaims,  
21  
22 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
23 of the allegations thereof and therefore denies the same.

24  
25 10. With respect to the allegations of paragraph 10 of the Counterclaims,  
26  
27 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
28 of the allegations thereof and therefore denies the same.

1           11. With respect to the allegations of paragraph 11 of the Counterclaims,  
2 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
3 of the allegations thereof and therefore denies the same.  
4

5           a. With respect to the allegations of paragraph 11(a) of the  
6 Counterclaims, Starbuzz is without sufficient information to form a  
7 belief as to the truth or falsity of the allegations thereof and therefore  
8 denies the same.  
9

10           b. With respect to the allegations of paragraph 11(b) of the  
11 Counterclaims, Starbuzz is without sufficient information to form a  
12 belief as to the truth or falsity of the allegations thereof and therefore  
13 denies the same.  
14

15           c. With respect to the allegations of paragraph 11(c) of the  
16 Counterclaims, Starbuzz is without sufficient information to form a  
17 belief as to the truth or falsity of the allegations thereof and therefore  
18 denies the same.  
19  
20  
21

22           12. With respect to the allegations of paragraph 12 of the Counterclaims,  
23 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
24 of the allegations thereof and therefore denies the same.  
25  
26  
27  
28

1           13. With respect to the allegations of paragraph 13 of the Counterclaims,  
2 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
3 of the allegations thereof and therefore denies the same.  
4

5           14. With respect to the allegations of paragraph 14 of the Counterclaims,  
6 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
7 of the allegations thereof and therefore denies the same.  
8

9           15. With respect to the allegations of paragraph 15 of the Counterclaims,  
10 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
11 of the allegations thereof and therefore denies the same.  
12

13           16. With respect to the allegations of paragraph 16 of the Counterclaims,  
14 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
15 of the allegations thereof and therefore denies the same.  
16

17           17. With respect to the allegations of paragraph 17 of the Counterclaims,  
18 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
19 of the allegations thereof and therefore denies the same.  
20

21           18. With respect to the allegations of paragraph 18 of the Counterclaims,  
22 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
23 of the allegations thereof and therefore denies the same.  
24  
25  
26  
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1           19. With respect to the allegations of paragraph 19 of the Counterclaims,  
2 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
3 of the allegations thereof and therefore denies the same.  
4

5           20. With respect to the allegations of paragraph 20 of the Counterclaims,  
6 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
7 of the allegations thereof and therefore denies the same.  
8

9           21. With respect to the allegations of paragraph 21 of the Counterclaims,  
10 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
11 of the allegations thereof and therefore denies the same.  
12

13           22. With respect to the allegations of paragraph 22 of the Counterclaims,  
14 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
15 of the allegations thereof and therefore denies the same.  
16  
17

18 **Starbuzz's Infringement of LOEC's Well-Known BLU Family of Marks**

19           23. With respect to the allegations of paragraph 23 of the Counterclaims,  
20 Starbuzz admits that its business has for years included the manufacture and sale of  
21 tobacco, hookah, and related products. Starbuzz denies that its business was  
22 limited to these activities.  
23

24           24. With respect to the allegations of paragraph 24 of the Counterclaims,  
25 Starbuzz admits that it has entered the electronic cigarette market and is selling  
26  
27  
28

1 products under its BLUE MIST Mark. Starbuzz denies the remaining allegations  
2 of paragraph 24 of the Counterclaims.

3         25. With respect to the allegations of paragraph 25 of the Counterclaims,  
4 Starbuzz admits that it has manufactured, marketed, and sold electronic cigarettes  
5 and/or components thereof under the BLUE MIST Mark. Starbuzz denies the  
6 remaining allegations of paragraph 25 of the Counterclaims.  
7

8  
9         26. Starbuzz admits the allegations of paragraph 26 of the Counterclaims.  
10

11         27. Starbuzz admits the allegations of paragraph 27 of the Counterclaims.

12         28. With respect to the allegations of paragraph 28 of the Counterclaims,  
13 Starbuzz admits that it responded to Lorillard's letter. Starbuzz denies the  
14 remaining allegations of paragraph 28 of the Counterclaims.  
15

16         29. Starbuzz admits the allegations of paragraph 29 of the Counterclaims.  
17

18         30. With respect to the allegations of paragraph 30 of the Counterclaims,  
19 Starbuzz admits that it responded to Lorillard's letter. Starbuzz denies the  
20 remaining allegations of paragraph 30 of the Counterclaims.  
21

22         31. With respect to the allegations of paragraph 31 of the Counterclaims,  
23 Starbuzz admits that it has used its registered MELON BLUE and BLUE MIST  
24 Marks on electronic cigarette products and components thereof, and has filed U.S.  
25 trademark applications for the same. Starbuzz denies the remaining allegations of  
26 paragraph 31 of the Counterclaims.  
27  
28

- 1           a. Starbuzz admits the allegations of paragraph 31(a) of the
- 2           Counterclaims.
- 3           b. Starbuzz admits the allegations of paragraph 31(b) of the
- 4           Counterclaims.
- 5           c. Starbuzz admits the allegations of paragraph 31(c) of the
- 6           Counterclaims.
- 7           d. Starbuzz admits the allegations of paragraph 31(d) of the
- 8           Counterclaims.
- 9           e. Starbuzz admits the allegations of paragraph 31(e) of the
- 10          Counterclaims.
- 11          32. Starbuzz admits the allegations of paragraph 32 of the Counterclaims.
- 12          33. Starbuzz denies all allegations of paragraph 33 of the Counterclaims.
- 13           a. Starbuzz denies all allegations of paragraph 33(a) of the
- 14           Counterclaims.
- 15           b. Starbuzz denies all allegations of paragraph 33(b) of the
- 16           Counterclaims.
- 17           c. Starbuzz denies all allegations of paragraph 33(c) of the
- 18           Counterclaims.
- 19           d. Starbuzz denies all allegations of paragraph 33(d) of the
- 20           Counterclaims.
- 21           e. Starbuzz denies all allegations of paragraph 33(e) of the
- 22           Counterclaims.
- 23           f. Starbuzz denies all allegations of paragraph 33(f) of the
- 24           Counterclaims.
- 25           g. Starbuzz denies all allegations of paragraph 33(g) of the
- 26           Counterclaims.
- 27           h. Starbuzz denies all allegations of paragraph 33(h) of the
- 28           Counterclaims.

1 e. Starbuzz denies all allegations of paragraph 33(e) of the  
2 Counterclaims.

3  
4 34. Starbuzz denies all allegations of paragraph 34 of the Counterclaims.

5 **FIRST CLAIM**

6 **FEDERAL UNFAIR COMPETITION**

7 **(15 U.S.C. § 1125(a); Lanham Act § 43(a))**

8  
9 35. With respect to the allegations of paragraph 35 of the Counterclaims,  
10 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
11 of the allegations thereof and therefore denies the same.  
12

13 36. Starbuzz denies all allegations of paragraph 36 of the Counterclaims.  
14

15 37. With respect to the allegations of paragraph 37 of the Counterclaims,  
16 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
17 of the allegations thereof and therefore denies the same.  
18

19 38. With respect to the allegations of paragraph 38 of the Counterclaims,  
20 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
21 of the allegations thereof and therefore denies the same.  
22

23 39. Starbuzz denies all allegations of paragraph 39 of the Counterclaims.  
24

25 40. Starbuzz denies all allegations of paragraph 40 of the Counterclaims.

26 41. Starbuzz denies all allegations of paragraph 41 of the Counterclaims.

27 42. Starbuzz denies all allegations of paragraph 42 of the Counterclaims.  
28



1           43.   Starbuzz denies all allegations of paragraph 43 of the Counterclaims.

2           44.   Starbuzz denies all allegations of paragraph 44 of the Counterclaims.

3           45.   Starbuzz denies all allegations of paragraph 45 of the Counterclaims.

4  
5                           **SECOND COUNTERCLAIM**

6                           **CALIFORNIA TRADEMARK INFRINGEMENT**

7  
8                           **(California Common Law Trademark Infringement)**

9           46.   With respect to the allegations of paragraph 46 of the Counterclaims,  
10 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
11 of the allegations thereof and therefore denies the same.

12  
13           47.   With respect to the allegations of paragraph 47 of the Counterclaims,  
14 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
15 of the allegations thereof and therefore denies the same.

16  
17           48.   With respect to the allegations of paragraph 48 of the Counterclaims,  
18 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
19 of the allegations thereof and therefore denies the same.

20  
21           49.   With respect to the allegations of paragraph 49 of the Counterclaims,  
22 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
23 of the allegations thereof and therefore denies the same.

24           50.   Starbuzz denies all allegations of paragraph 50 of the Counterclaims.

25           51.   Starbuzz denies all allegations of paragraph 51 of the Counterclaims.  
26  
27  
28

1           52.   Starbuzz denies all allegations of paragraph 52 of the Counterclaims.

2           53.   Starbuzz denies all allegations of paragraph 53 of the Counterclaims.

3           54.   Starbuzz denies all allegations of paragraph 54 of the Counterclaims.

4           55.   Starbuzz denies all allegations of paragraph 55 of the Counterclaims.

5  
6                           **THIRD CLAIM**

7  
8                           **CALIFORNIA UNFAIR COMPETITION**

9                           **(CAL. BUS. & PROF. CODE § 17200)**

10  
11           56.   With respect to the allegations of paragraph 56 of the Counterclaims,  
12 Starbuzz is without sufficient information to form a belief as to the truth or falsity  
13 of the allegations thereof and therefore denies the same.

14  
15           57.   Starbuzz denies all allegations of paragraph 57 of the Counterclaims.

16           58.   Starbuzz denies all allegations of paragraph 58 of the Counterclaims.

17  
18                           **PRAYER FOR RELIEF**

19           1.    With respect to the allegations of paragraph 1 of the Prayer for Relief,  
20 Starbuzz denies that LOEC is entitled to the relief claimed therein.

21  
22           2.    With respect to the allegations of paragraph 2 of the Prayer for Relief,  
23 Starbuzz denies that LOEC is entitled to the relief claimed therein.

24  
25           3.    With respect to the allegations of paragraph 3 of the Prayer for Relief,  
26 Starbuzz denies that LOEC is entitled to the relief claimed therein.

1 a. With respect to the allegations of paragraph 3a of the Prayer for  
2 Relief, Starbuzz denies that LOEC is entitled to the relief claimed  
3 therein.  
4

5 b. With respect to the allegations of paragraph 3b of the Prayer for  
6 Relief, Starbuzz denies that LOEC is entitled to the relief claimed  
7 therein.  
8

9 c. With respect to the allegations of paragraph 3c of the Prayer for  
10 Relief, Starbuzz denies that LOEC is entitled to the relief claimed  
11 therein.  
12

13 d. With respect to the allegations of paragraph 3d of the Prayer for  
14 Relief, Starbuzz denies that LOEC is entitled to the relief claimed  
15 therein.  
16

17 e. With respect to the allegations of paragraph 3e of the Prayer for  
18 Relief, Starbuzz denies that LOEC is entitled to the relief claimed  
19 therein.  
20

21  
22 4. With respect to the allegations of paragraph 4 of the Prayer for Relief,  
23 Starbuzz denies that LOEC is entitled to the relief claimed therein.  
24

25 5. With respect to the allegations of paragraph 5 of the Prayer for Relief,  
26 Starbuzz denies that LOEC is entitled to the relief claimed therein.  
27  
28

1           6.       With respect to the allegations of paragraph 6 of the Prayer for Relief,  
2 Starbuzz denies that LOEC is entitled to the relief claimed therein.

3           7.       With respect to the allegations of paragraph 7 of the Prayer for Relief,  
4 Starbuzz denies that LOEC is entitled to the relief claimed therein.

5           8.       With respect to the allegations of paragraph 8 of the Prayer for Relief,  
6 Starbuzz denies that LOEC is entitled to the relief claimed therein.

7           9.       With respect to the allegations of paragraph 9 of the Prayer for Relief,  
8 Starbuzz denies that LOEC is entitled to the relief claimed therein.

9           10.      With respect to the allegations of paragraph 10 of the Prayer for  
10 Relief, Starbuzz denies that LOEC is entitled to the relief claimed therein.

11           11.      With respect to the allegations of paragraph 11 of the Prayer for  
12 Relief, Starbuzz denies that LOEC is entitled to the relief claimed therein.

13  
14  
15  
16  
17  
18                   **AFFIRMATIVE DEFENSES**

19           Without admitting any allegations of the Counterclaims not otherwise  
20 admitted, Starbuzz avers and asserts affirmative defenses as follows:

21  
22                   **FIRST AFFIRMATIVE DEFENSE**  
23                   (Waiver and Estoppel)

24           AS A FIRST SEPARATE AND AFFIRMATIVE DEFENSE TO EACH  
25 AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC, by conduct,  
26 representations, and/or omissions, has waived, relinquished, and/or abandoned its  
27  
28

1 rights, and is equitably stopped from asserting, any claim for relief against  
2 Starbuzz with respect to each purported cause of action therein.

3  
4 **SECOND AFFIRMATIVE DEFENSE**

(No Injury)

5  
6 AS A SECOND SEPARATE AND AFFIRMATIVE DEFENSE TO EACH  
7 AND EVERY CAUSE OF ACTION, Starbuzz alleges that: because Starbuzz's  
8 allegedly infringing marks do not cause confusion with LOEC's marks, LOEC has  
9 not suffered and could not have suffered any injury from Starbuzz's use of the  
10 allegedly infringing marks.  
11

12  
13 **THIRD AFFIRMATIVE DEFENSE**

(No Damages)

14  
15 AS A THIRD SEPARATE AND AFFIRMATIVE DEFENSE TO EACH  
16 AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC has suffered no  
17 damages and/or has failed to mitigate damages, if any.  
18

19 **FOURTH AFFIRMATIVE DEFENSE**

(Laches)

20  
21 AS A FOURTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH  
22 AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC's claims are  
23 barred, in whole or in part, by the equitable doctrine of laches.  
24

25 //

26 //

27 //

**FIFTH AFFIRMATIVE DEFENSE**

(Justification)

AS A FIFTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: as to each cause of action, Starbuzz was justified in doing, or refraining from performing, the acts alleged in the Counterclaims.

**SIXTH AFFIRMATIVE DEFENSE**

(Adequate Remedy at Law)

AS A SIXTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC's claims for equitable relief are barred to the extent that there is an adequate remedy at law.

**SEVENTH AFFIRMATIVE DEFENSE**

(Trademark Unenforceability)

AS AN SEVENTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC's trademarks are unenforceable because they are descriptive and lack secondary meaning.

**EIGHT AFFIRMATIVE DEFENSE**

(Prior Use/Registration)

AS A EIGHT SEPARATE AND AFFIRMATIVE DEFENSE TO EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC's claims are

1 barred, in whole or in part, by Starbuzz's prior use and/or registration of the BLUE  
2 MIST, MELON BLUE, and BLUE SURFER marks.

3  
4 **NINTH AFFIRMATIVE DEFENSE**

(Failure to Protect Rights)

5  
6 AS A NINTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH  
7 AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC failed to protect  
8 and/or enforce its alleged rights against Starbuzz, because LOEC knew of  
9 Starbuzz's use of its marks, yet failed to timely object.  
10

11 **TENTH AFFIRMATIVE DEFENSE**

(No Irreparable Harm)

12  
13 AS AN TENTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH  
14 AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC has suffered no  
15 harm and/or irreparable harm.  
16

17 **ELEVENTH AFFIRMATIVE DEFENSE**

(Invalidity of Trademark on the Basis of Descriptiveness)

18  
19 AS A ELEVENTH SEPARATE AND AFFIRMATIVE DEFENSE TO  
20 EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC's  
21 trademarks, if any, are invalid. LOEC has alleged that its electronic cigarettes  
22 have a blue-colored LED tip that lights up, and that the blue-colored LED is an  
23 important and distinguishable part of the BLU Marks. If LOEC's allegations are  
24 true, then LOEC has admitted that its BLU mark describes a distinguishable  
25  
26  
27  
28

1 feature of its products. Therefore, LOEC's marks lack inherent distinctiveness and  
2 are not protectable without a showing of acquired distinctiveness.

3  
4 **TWELFTH AFFIRMATIVE DEFENSE**  
5 (Priority and Non-Infringement of Trademark)

6 AS A TWELFTH SEPARATE AND AFFIRMATIVE DEFENSE TO  
7 EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC's  
8 trademark infringement claims fail since Starbuzz used its BLUE MIST and  
9  
10 MELON BLUE marks in commerce before LOEC and its predecessor(s) in interest  
11 began using the BLU Marks in commerce. In addition, Starbuzz is informed and  
12  
13 believes, and thereon alleges, that LOEC's BLU Marks are descriptive and did not  
14  
15 acquire distinctiveness, if any, until after Starbuzz began use of its BLUE MIST,  
16  
17 MELON BLUE, and BLUE SURFER marks for tobacco products.

17 **THIRTEENTH AFFIRMATIVE DEFENSE**  
18 (No Unfair Competition)

19 AS A THIRTEENTH SEPARATE AND AFFIRMATIVE DEFENSE TO  
20 EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: Starbuzz has  
21  
22 not engaged in unfair competition under California Common Law and California  
23  
24 Business and Professions Code § 17200 et seq.

25 //

26 //

27  
28 //



**FOURTEENTH AFFIRMATIVE DEFENSE**

(No Attorneys' Fees)

AS A FOURTEENTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: This is not an exceptional case because Starbuzz had no intent to infringe upon the BLU Marks.

**FIFTEENTH AFFIRMATIVE DEFENSE**

(No Profits)

AS A FIFTEENTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: California Bus. & Prof. Code § 17200 et seq. does not entitle LOEC to non-restitutionary disgorgement of Starbuzz's profits.

**SIXTEENTH AFFIRMATIVE DEFENSE**

(Lack of Proximate Cause)

AS A SIXTEENTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: the Counterclaims are barred because any loss, injury, damage or detriment purportedly incurred by LOEC was not proximately caused by the actions or omissions of Starbuzz.

**SEVENTEENTH AFFIRMATIVE DEFENSE**

(De Minimis)

AS AN SEVENTEENTH SEPARATE AND AFFIRMATIVE DEFENSE TO EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: Starbuzz is

1 not liable for LOEC's alleged damages since such damages, if any, were de  
2 minimis when Starbuzz acted in good faith and was in substantial compliance with  
3 the law.  
4

5 **EIGHTEENTH AFFIRMATIVE DEFENSE**  
6 (Uncertain/Unmanageable Damages)

7 AS A EIGHTEENTH SEPARATE AND AFFIRMATIVE DEFENSE TO  
8 EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: LOEC's  
9 requested monetary relief is too speculative, remote, and/or impossible to prove  
10 and/or allocate.  
11

12 **NINETEENTH AFFIRMATIVE DEFENSE**  
13 (Reservation)  
14

15 AS A NINETEENTH SEPARATE AND AFFIRMATIVE DEFENSE TO  
16 EACH AND EVERY CAUSE OF ACTION, Starbuzz alleges that: Starbuzz  
17 currently has insufficient knowledge or information on which to form a belief as to  
18 whether it may have additional, as yet unstated, affirmative defenses available.  
19 Starbuzz reserves the right to assert additional affirmative defenses in the event  
20 that discovery indicates it would be appropriate.  
21

22 DATED: February 3, 2014

23 Respectfully Submitted,  
24 **THE PATEL LAW FIRM, P.C.**

25 s/Natu J. Patel  
26 Natu J. Patel  
27 Attorneys for Plaintiff and  
28 Counter-Defendant,  
Starbuzz Tobacco, Inc.

**DEMAND FOR TRIAL BY JURY**

Counter-Defendant, Starbuzz Tobacco, Inc. hereby demands a trial by jury  
on all issues raised in LOEC, Inc.'s Counterclaims.

Dated: February 3, 2014

Respectfully Submitted,  
**THE PATEL LAW FIRM, P.C.**

s/Natu J. Patel  
Natu J. Patel  
Attorneys for Plaintiff and  
Counter-Defendant,  
Starbuzz Tobacco, Inc.



# **EXHIBIT G**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**

## Combined Declaration of Use and Incontestability under Sections 8 & 15

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The table below presents the data as entered.

Input Field	Entered
REGISTRATION NUMBER	3619407
REGISTRATION DATE	05/12/2009
SERIAL NUMBER	77619104
MARK SECTION	
MARK	BLUE MIST
CORRESPONDENCE SECTION (current)	
NAME	Martin Jerisat
FIRM NAME	Starbuzz Tobacco, Inc.
INTERNAL ADDRESS	10871 Forbes Ave
STREET	10871 Forbes Ave
CITY	Garden Grove
STATE	California
POSTAL CODE	92843
COUNTRY	United States
PHONE	7149954119
EMAIL	Martin@starbuzztobacco.com;Jay@starbuzztobacco.com
AUTHORIZED TO COMMUNICATE VIA E-MAIL	Yes
CORRESPONDENCE SECTION (proposed)	
NAME	Starbuzz Tobacco, Inc.
STREET	10871 Forbes Ave
CITY	Garden Grove
STATE	California
POSTAL CODE	92843

<b>COUNTRY</b>	United States
<b>PHONE</b>	714-995-4119
<b>EMAIL</b>	jay@starbuzztobacco.com;martin@starbuzztobacco.com
<b>AUTHORIZED TO COMMUNICATE VIA E-MAIL</b>	Yes
<b>GOODS AND/OR SERVICES SECTION</b>	
<b>INTERNATIONAL CLASS</b>	034
<b>GOODS OR SERVICES</b>	Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco
<b>SPECIMEN FILE NAME(S)</b>	<a href="\\TICRS\EXPORT16\IMAGEOUT16\776\191\77619104\xml2\ 8150002.JPG">\\TICRS\EXPORT16\IMAGEOUT16\776\191\77619104\xml2\ 8150002.JPG</a>
<b>SPECIMEN DESCRIPTION</b>	Product as used in commerce.
<b>OWNER SECTION (current)</b>	
<b>NAME</b>	Starbuzz Tobacco, Inc.
<b>STREET</b>	Unit #A
<b>CITY</b>	Fullerton
<b>STATE</b>	California
<b>ZIP/POSTAL CODE</b>	92833
<b>COUNTRY</b>	United States
<b>PHONE</b>	714-871-6132
<b>OWNER SECTION (proposed)</b>	
<b>NAME</b>	Starbuzz Tobacco, Inc.
<b>STREET</b>	10871 Forbes Ave
<b>CITY</b>	Garden Grove
<b>STATE</b>	California
<b>ZIP/POSTAL CODE</b>	92843
<b>COUNTRY</b>	United States
<b>PHONE</b>	714-995-4119
<b>EMAIL</b>	jay@starbuzztobacco.com
<b>AUTHORIZED TO COMMUNICATE VIA E-MAIL</b>	Yes
<b>LEGAL ENTITY SECTION (current)</b>	

<b>TYPE</b>	corporation
<b>STATE/COUNTRY OF INCORPORATION</b>	California
<b>PAYMENT SECTION</b>	
<b>NUMBER OF CLASSES</b>	1
<b>NUMBER OF CLASSES PAID</b>	1
<b>SUBTOTAL AMOUNT</b>	300
<b>TOTAL FEE PAID</b>	300
<b>SIGNATURE SECTION</b>	
<b>SIGNATURE</b>	/Martin E. Jerisat/
<b>SIGNATORY'S NAME</b>	Martin E. Jerisat
<b>SIGNATORY'S POSITION</b>	Counsel
<b>DATE SIGNED</b>	05/23/2014
<b>PAYMENT METHOD</b>	CC
<b>FILING INFORMATION</b>	
<b>SUBMIT DATE</b>	Fri May 23 15:14:06 EDT 2014
<b>TEAS STAMP</b>	USPTO/S08N15-108.228.228. 81-20140523151406896174-3 619407-500d282c8237445f77 e5dfeae6d9dea4e4957a2e8c3 529a1f92e25685563d33e7-CC -1638-2014052314535851832 4

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**Combined Declaration of Use and Incontestability under Sections 8 & 15  
To the Commissioner for Trademarks:**

**REGISTRATION NUMBER:** 3619407

**REGISTRATION DATE:** 05/12/2009

**MARK:** BLUE MIST

The owner, Starbuzz Tobacco, Inc., a corporation of California, having an address of  
10871 Forbes Ave  
Garden Grove, California 92843  
United States

is filing a Combined Declaration of Use and Incontestability under Sections 8 & 15.

For International Class 034, the mark is in use in commerce on or in connection with **all** of the goods or services listed in the existing registration for this specific class: Pipe Tobacco, Tobacco, Smoking Tobacco, Flavored Tobacco, Molasses Tobacco; **and** the mark has been continuously used in commerce for five (5) consecutive years after the date of registration, or the date of publication under Section 12(c), and is still in use in commerce on or in connection with **all** goods or services listed in the existing registration for this class. Also, no final decision adverse to the owner's claim of ownership of such mark for those goods or services exists, or to the owner's right to register the same or to keep the same on the register; and, no proceeding involving said rights pending and not disposed of in either the U.S. Patent and Trademark Office or the courts exists.

The owner is submitting one(or more) specimen(s) for this class showing the mark as used in commerce on or in connection with any item in this class, consisting of a(n) Product as used in commerce..

[Specimen File1](#)

The registrant's current Correspondence Information: Martin Jerisat of Starbuzz Tobacco, Inc.  
10871 Forbes Ave  
10871 Forbes Ave  
Garden Grove, California (CA) 92843  
United States

The registrant's proposed Correspondence Information: Starbuzz Tobacco, Inc.  
10871 Forbes Ave  
Garden Grove, California (CA) 92843  
United States

The phone number is 714-995-4119.

The email address is jay@starbuzztobacco.com;martin@starbuzztobacco.com.

A fee payment in the amount of \$300 will be submitted with the form, representing payment for 1 class(es), plus any additional grace period fee, if necessary.

### **Declaration**

*The mark is in use in commerce on or in connection with the goods/services identified above, as evidenced by the attached specimen(s) showing the mark as used in commerce. The mark has been in continuous use in commerce for five consecutive years after the date of registration, or the date of publication under 15 U.S.C. Section 1062(c), and is still in use in commerce on or in connection with all goods/services listed in the existing registration. There has been no final decision adverse to the owner's claim of ownership of such mark for such goods/services, or to the owner's right to register the same or to keep the same on the register; and there is no proceeding involving said rights pending and not disposed of either in the United States Patent and Trademark Office or in a court.*

The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements and the like may jeopardize the validity of this submission, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

Signature: /Martin E. Jerisat/      Date: 05/23/2014

Signatory's Name: Martin E. Jerisat

Signatory's Position: Counsel

Serial Number: 77619104

Internet Transmission Date: Fri May 23 15:14:06 EDT 2014

TEAS Stamp: USPTO/S08N15-108.228.228.81-201405231514

06896174-3619407-500d282c8237445f77e5dfe

ae6d9dea4e4957a2e8c3529a1f92e25685563d33

e7-CC-1638-20140523145358518324



**ROUTING SHEET TO POST REGISTRATION (PRU)****Registration Number:** 3619407**Serial Number:** 77619104**RAM Sale Number:** 3619407**RAM Accounting Date:** 20140527**Total Fees:** \$300

Note: Process in accordance with Post Registration Standard Operating Procedure (SOP)

<u>Transaction</u>	<u>Fee Code</u>	<u>Transaction Date</u>	<u>Fee per Class</u>	<u>Number of Classes</u>	<u>Number of Classes Paid</u>	<u>Total Fee</u>
\$8 affidavit	7205	20140523	\$100	1	1	\$100
\$15 affidavit	7208	20140523	\$200	1	1	\$200

Physical Location: MADCD- ALEX. CENTRAL DOCKET

Lost Case Flag: False

In TICRS (AM-FLG-IN-TICRS): True

**Transaction Date:** 20140523

# **EXHIBIT H**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**

UNITED STATES DISTRICT COURT  
CENTRAL DISTRICT OF CALIFORNIA

Starbuzz Tobacco Inc.

CASE NUMBER:

8:13-cv-00411-CJC-AN

v.

PLAINTIFF(S)

Lorillard Inc., et al.

DEFENDANT(S)

NOTICE OF APPEARANCE OR  
WITHDRAWAL OF COUNSEL

**INSTRUCTIONS**

**Appearance of Counsel:**

Attorneys may use this form to enter an appearance in a case, or to update the docket of a case to reflect a prior appearance. To do so, complete Sections I, II, and IV of this form, then file and serve the form in the case. (Using an attorney's CM/ECF login and password to file this form will expedite the addition of that attorney to the docket as counsel of record.)

**Withdrawal of Counsel:**

This form may be used to terminate an attorney's status as counsel of record for a party in three situations: (1) the attorney being terminated has already been relieved by the Court, but the docket does not yet reflect that fact; (2) at least one member of the attorney's firm or agency will continue to represent that party and the withdrawing attorney is not the only member of the Bar of this Court representing that party; or (3) the represented party has been dismissed from the case, but the attorneys are still receiving notices of electronic filing. For any of these situations, complete Sections I, III, and IV of this form, then file and serve the form in the case.

**Note:** In situations not covered above, attorneys seeking to withdraw from a case must first obtain permission from the Court. In such circumstances, attorneys should complete and file a "Request for Approval of Substitution or Withdrawal of Counsel" (Form G-01) rather than this "Notice of Appearance or Withdrawal of Counsel" (Form G-123). See Form G-01 for further information.

**SECTION I - IDENTIFYING INFORMATION**

Please complete the following information for the attorney you wish to add or remove (if removing an attorney, provide the information as it currently appears on the docket; if appearing pro hac vice, enter "PHV" in the field for "CA Bar Number"):

Name: Martin E. Jerisat

CA Bar Number: 273770

Firm or agency: Starbuzz Tobacco Inc.

Address: 10871 Forbes Ave., Garden Grove, CA 92843

Telephone Number: 714.995.4119

Fax Number:

Email: Martin@Starbuzztobacco.com

Counsel of record for the following party or parties: Starbuzz Tobacco Inc.

**SECTION II - TO ADD AN ATTORNEY TO THE DOCKET**

*Please select one of the following options:*

- ☐ The attorney listed above has already appeared as counsel of record in this case and should have been added to the docket. The date of the attorney's first appearance in this case: \_\_\_\_\_.
- ☐ The filing of this form constitutes the first appearance in this case of the attorney listed above. Other members of this attorney's firm or agency have previously appeared in the case.
- ☒ The filing of this form constitutes the first appearance in this case of the attorney listed above. No other members of this attorney's firm or agency have previously appeared in the case.

**SECTION III - TO REMOVE AN ATTORNEY FROM THE DOCKET**

*Please select one of the following options:*

- ☐ The attorney named above has already been relieved by the Court as counsel of record in this case and should have been removed from the docket. Date of the order relieving this attorney: \_\_\_\_\_.
- ☐ Please remove the attorney named above from the docket of this case; at least one member of the firm or agency named above, and at least one member of the Bar of this Court, will continue to serve as counsel of record for the party or parties indicated.  
*(Note: if you are removing yourself from the docket of this case as a result of separating from a firm or agency, you should consult Local Rules 5-4.8.1 and 83-2.4 and Form G-06 ("Notice of Change of Attorney Business or Contact Information"), concerning your obligations to notify the Clerk and parties of changes in your business or contact information.)*
- ☐ The represented party has been dismissed from the case, but the attorneys are still receiving notices of electronic filing. Date party was dismissed: \_\_\_\_\_.

**SECTION IV - SIGNATURE**

I request that the Clerk update the docket as indicated above.

Date: 11.04.13

Signature: /Martin E. Jerisat/

Name: Martin E. Jerisat

# **EXHIBIT I**

**Petition for Cancellation**

**BLUE MIST Mark**

**U.S. Registration No. 3619407**



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**From:** TMOfficialNotices@USPTO.GOV  
**Sent:** Tuesday, June 10, 2014 11:00 PM  
**To:** jay@starbuzztobacco.com  
**Cc:** martin@starbuzztobacco.com  
**Subject:** Official USPTO Notice of Acceptance/Acknowledgement Sections 8 and 15: U.S. Trademark RN 3619407: BLUE MIST

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**Serial Number:** 77619104  
**Registration Number:** 3619407  
**Registration Date:** May 12, 2009  
**Mark:** BLUE MIST  
**Owner:** Starbuzz Tobacco, Inc.

Jun 10, 2014

## **NOTICE OF ACCEPTANCE UNDER SECTION 8**

The declaration of use or excusable nonuse filed for the above-identified registration meets the requirements of Section 8 of the Trademark Act, 15 U.S.C. §1058. **The Section 8 declaration is accepted.**

## **NOTICE OF ACKNOWLEDGEMENT UNDER SECTION 15**

The declaration of incontestability filed for the above-identified registration meets the requirements of Section 15 of the Trademark Act, 15 U.S.C. §1065. **The Section 15 declaration is acknowledged.**

**The registration will remain in force for the class(es) listed below for the remainder of the ten-year period, calculated from the registration date, unless canceled by an order of the Commissioner for Trademarks or a Federal Court.**

**Class(es):**  
034

TRADEMARK SPECIALIST  
POST-REGISTRATION DIVISION  
571-272-9500

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## **REQUIREMENTS FOR MAINTAINING REGISTRATION**

**WARNING:** Your registration will be canceled if you do not file the documents below during the specified time periods.

### **Requirements in the First Ten Years**

**What and When to File:** You must file a declaration of use (or excusable nonuse) **and** an application for renewal between the 9th and 10th years after the registration date. See 15 U.S.C. §§1058, 1059.

### **Requirements in Successive Ten-Year Periods**

**What and When to File:** You must file a declaration of use (or excusable nonuse) **and** an application for renewal between

every 9th and 10th-year period, calculated from the registration date. See 15 U.S.C. §§1058, 1059.

#### **Grace Period Filings**

The above documents will be considered as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**\*\*\*The USPTO WILL NOT SEND ANY FURTHER NOTICE OR REMINDER OF THESE REQUIREMENTS. THE REGISTRANT SHOULD CONTACT THE USPTO ONE YEAR BEFORE THE EXPIRATION OF THE TIME PERIODS SHOWN ABOVE TO DETERMINE APPROPRIATE REQUIREMENTS AND FEES.\*\*\***

To view this notice and other documents for this application on-line, go to <http://tdr.uspto.gov/search.action?sn=77619104>.

NOTE: This notice will only be available on-line the next business day after receipt of this e-mail.